

1 - VOLUME F - Page 973

2 IN THE UNITED STATES DISTRICT COURT

3 IN AND FOR THE DISTRICT OF DELAWARE

4 - - -

5 ARTHROCARE CORPORATION, : CIVIL ACTION

6 Plaintiff : :

7 vs. : :

8 SMITH & NEPHEW, INC., : :

9 Defendant : : NO. 01-504 (SLR)

10 - - -

11 Wilmington, Delaware

12 Wednesday, May 7, 2003

13 9:32 o'clock, a.m.

14 - - -

15 BEFORE: HONORABLE SUE L. ROBINSON, Chief Judge, and a jury

16 - - -

17 APPEARANCES:

18 MORRIS, NICHOLS, ARSHY & TUNNELL

19 BY: JACK B. BLUMENFELD, ESQ. and

20 KAREN JACOBS LOUDEN, ESQ.

21 -and-

22

23 Official Court Reporters

24

25

1 APPEARANCES (Continued): Page 974

2

3 WEIL, GOTSHAL & MANGES

4 BY: JARED BOBROW, ESQ.,

5 TIMOTHY DeMAST, ESQ. and

6 PERRY R. CLARK, ESQ.

7 (Redwood Shores, California)

8 Counsel for Plaintiff

9

10 -and-

11 FISH & RICHARDSON P.C.

12 BY: WILLIAM J. MARSDEN, JR., ESQ.,

13 KEITH A. WALTER, ESQ. and

14 EUGENE B. JOSWICK, ESQ.

15 -and-

16 FISH & RICHARDSON

17 BY: MARK I. HEBERT, ESQ.,

18 (Boston, Massachusetts)

19 -and-

20 FISH & RICHARDSON

21 BY: KURTIS D. MacFERRIN, ESQ. and

22 KAREN I. BOYD, ESQ.

23 (Redwood City, California)

24 Counsel for Defendant

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2 PROCEEDINGS

3

4 (Proceedings commenced in the courtroom,

5 beginning at 9:32 a.m., and the following occurred without

6 the presence of the jury.)

7

8 THE COURT: All right. I understand we had an

9 issue. We don't have that issue any more. But do we have

10 any others before we bring the jury in?

11 MS. BOYD: No, your Honor.

12 THE COURT: All right. Terrific.

13 MR. BLUMENFELD: Your Honor, we don't have any

14 issues, but Dr. Goldberg is back today. I think we've

15 agreed on an order. He'll be resuming the stand today.

16 Smith & Nephew has been kind enough to agree

17 that he can be in the courtroom while other witnesses are

18 testifying today, which is -- I just wanted to alert your

19 Honor to that.

20 THE COURT: Okay. Great. Thank you very much.

21 (Pause.)

22 (At this point the jury entered the courtroom

23 and took their seats in the box.)

24 THE COURT: Good morning, ladies and gentlemen.

25 We should proceed. I'm not quite sure where we are. Oh,

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2 we have a witness on the stand.

3 MR. MacFERRIN: That's correct.

4 THE COURT: If she could come forward please,

5 I'd appreciate it.

6 - - -

7 DEFENDANT'S TESTIMONY

8 CONTINUED...

9 ... KATE KNUDSEN, having been

10 previously duly sworn as a witness,

11 was examined and testified as

12 follows ...

13 DIRECT EXAMINATION

14 CONTINUED

15 BY MR. MacFERRIN:

16 Q. Good morning, Mrs. Knudsen.

17 A. Good morning.

18 Q. You realize you're still under oath?

19 A. Yes.

20 Q. I would like to pick up where we left off yesterday

21 and ask you about one other feature of the Saphyre

22 design that you worked on. And that feature is a fluid

23 supply. Does the Saphyre probe do the fluid supply?

24 A. No, it does not provide fluid.

25 Q. Does the Saphyre electrosurgical system include a

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1 were used in angioplasty means have the purpose and
 2 function of limiting current to each electrode.
 3 Similarly, that need was seen in arthroscopy applications,
 4 so we just used the idea because the end need was similar.
 5 "Question: And what is that end need?
 6 "Answer: The end need in angioplasty
 7 application is to work on the tissue inside the artery.
 8 The end need in arthroscopic application is work in the
 9 tissue of the joint. So we are working on tissues. The
 10 end need is similar, so extending the ballasting idea
 11 from angioplasty to arthroscopy seemed like the extension,
 12 the natural extension."

13 MR. JOHNSTON: That is all we have. Thank
 14 you very much, ladies and gentlemen.

15 THE COURT: All right. Ladies and gentlemen,
 16 let's take a 15-minute afternoon break and then we'll
 17 conclude with whatever testimony that counsel have.

18 (At this point the jury was excused for a short
 19 recess.)

20 THE COURT: All right. 15 minutes.
 21 (Short recess taken.)
 22 ---
 23
 24
 25

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1
 2 (Court resumed after the recess.)
 3

4 THE COURT: Can we bring our jury in?

5 MR. MARSDEN: I'm not sure what your preference
 6 is in admitting the exhibits outside the jury or outside
 7 the presence of the jury or in front of the jury. I moved
 8 some exhibits that Mr. Blumenfeld didn't have an
 9 opportunity to review. He has reviewed them and does
 10 not have an objection.

11 THE COURT: Let's bring the jury in because if
 12 we're going to finish early, this is a long day for them
 13 and we can do that at the end of the day.

14 MR. MARSDEN: We can do that outside the
 15 presence of the jury?

16 THE COURT: Yes. I don't think your reading
 17 off numbers is going to make a big impression on them.

18 (At this point the jury entered the courtroom
 19 and took their seats in the box.)

20 THE COURT: Mr. Marsden?

21 MR. MARSDEN: Thank you, your Honor.

22 Ladies and gentlemen of the jury, we next call
 23 Dr. Kenneth B. Taylor.
 24 ---
 25

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1 DEFENDANT'S TESTIMONY CONTINUED
 2 ... KENNETH BOYLE TAYLOR, having
 3 been duly sworn as a witness, was examined
 4 and testified as follows ...
 5 MR. MARSDEN: Ladies and gentlemen of the jury,
 6 Dr. Taylor is not a medical doctor, but he has a Ph.D. in
 7 biomedical engineering. We are calling him as an expert
 8 in the design and use of electrosurgical systems. He will
 9 be offering opinions on the issues of infringement and
 10 invalidity and he'll be explaining the basis for his
 11 opinions.

12 DIRECT EXAMINATION

13 BY MR. MARSDEN:

14 Q. Good afternoon, Dr. Taylor.

15 A. Good afternoon.

16 Q. Could you introduce yourself to the jury, please?

17 A. Sure. Hi. High name is Ken Taylor. Good to meet
 18 you all.

19 Q. Dr. Taylor, where do you live?

20 A. I live in Broomfield, Colorado.

21 Q. Are you married?

22 A. Yes, I am.

23 Q. Do you have any children?

24 A. I have one son.

25 Q. How long have you been married?

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1 A. I've been married 30 years.

2 Q. How old is your son?

3 A. He's 23.

4 Q. Do you have any experience or training in
 5 electrosurgery?

6 A. One might say so, yes.

7 Q. Have you prepared a resume that outlines your
 8 educational and work experience?

9 A. Yes, I have.

10 Q. Could I ask you to turn to DTX-418 in the binder
 11 that you have in front of you?

12 A. Yes.

13 Q. Does that show your experience or training in
 14 electrosurgery?

15 A. Yes, it does.

16 Q. Can you describe your educational background for the
 17 jury?

18 A. Sure. I have a B.S. in electrical engineering from
 19 the University of Connecticut. I have a Master's degree
 20 in biomedical engineering as well as a Ph.D. in biomedical
 21 engineering, also from the University of Connecticut.

22 And I have an MBA from Rennselear Polytechnic Institute.
 23 Q. Did you work while you were pursuing your graduate
 24 degrees?

25 A. Yes. Once I got my B.S. degree, I worked

1 continuously.
 2 Q. Where did you work while you were getting your
 3 graduate degrees?
 4 A. I started working after my Bachelor's degree at St.
 5 Francis Hospital in Connecticut. I was the Manager. At
 6 some point I was the Manager of the Research Laboratory
 7 as well as a perfusionist. A perfusionist is a person
 8 that runs a heart/lung machine during open-heart surgery.
 9 Q. Did you have any exposure to electrosurgical systems
 10 during that job at St. Francis?
 11 A. Yes, I did. As Manager of the Research Laboratory
 12 there, we did a number of different types of animal
 13 surgery for clinical practice as well as for testing
 14 various devices and we had an old, what's known as a
 15 Bovie unit, that we used during the course of those
 16 surgeries for cutting and coagulation.
 17 Q. Did you work at any other companies or locations
 18 while you were pursuing your graduate degrees?
 19 A. Yes. When I left the hospital, I went to work for
 20 United Technologies, which was a company that's in East
 21 Hartford, Connecticut.
 22 Q. Did your work involve any medical research?
 23 A. Actually, it did. A lot of you know United
 24 Technologies is a company that makes things like
 25 elevators, air-conditioners and such. They also have

1 a research center that on occasion does some
 2 philanthropic projects and I developed an automated
 3 gait analysis laboratory for Children's Hospital in
 4 Hartford during the course of my tenure at that job.
 5 And as a matter of fact, during the course of
 6 this trial, there's been a conference, automated gait
 7 analysis, which is being partially sponsored by A. I.
 8 DuPont Hospital, which is the hospital that we consulted
 9 with after we had built the Gait Lab for the Children's
 10 Hospital.
 11 Q. And when you say gait, is that gate like a fence or
 12 is that a different kind of gate?
 13 A. Walking analysis. Gait Analysis Lab is designed
 14 to diagnose walking disorders, particularly in children,
 15 children with cerebral palsy and such.
 16 Q. Have you done any teaching in the field of
 17 electrosurgery?
 18 A. Yes, I have. I've taught courses in introduction
 19 to biomedical engineering at the University of Connecticut
 20 as well as Trinity College, Hartford Graduate Center.
 21 Those courses involve teaching by low electric surgery.
 22 Q. Do you have any work experience in the field of
 23 electrosurgery?
 24 A. Yes, I have. I've got a number of different job
 25 opportunities where I worked with electrosurgery.

1 First off, when I worked at Pfizer, I did
 2 work at Pfizer for about three years, running a group
 3 that was involved with technology assessment as well as
 4 a group that did technical resource types of activities
 5 and sponsored research project that involved
 6 electrosurgery.
 7 I was also a Vice President of R&D for
 8 Valleylab and developed a number of electrosurgery systems,
 9 generators, including the generator that is on the table
 10 there, Force FX and also other devices related to that.
 11 And my most recent position, we worked on -- and developed
 12 a device that incorporates an electrosurgery generator
 13 within it.
 14 Q. Thank you.
 15 Can you describe for the jury what Valleylab
 16 is?
 17 A. Valley -- Valleylab is a company that basically has
 18 two product lines. One of them is electrosurgery systems
 19 and the other product line is ultrasurgical aspirators.
 20 It focuses on tissue ablation, using those types of systems.
 21 Q. And what was your position at Valleylab?
 22 A. I was the Vice President of Research and Development
 23 there.
 24 Q. How long did you hold that position?
 25 A. Five years.

1 Q. During your work at Valleylab, did you have -- use or
 2 evaluate any electrosurgical devices?
 3 A. Yes. A fair number of them. Our own products as
 4 well as competitive products.
 5 Q. Dr. Taylor, are you a physician?
 6 A. No, I am not.
 7 Q. Are you a surgeon?
 8 A. No, I'm not.
 9 Q. In the course of your work experience, have you had an
 10 opportunity to observe electrosurgery?
 11 A. Probably observed the use of electrosurgery in well
 12 over 3,000 operations.
 13 Q. Do you have any understanding as to whether Dr.
 14 Goldberg is a surgeon?
 15 A. My understanding is he's a radiologist; he's not a
 16 surgeon.
 17 Q. Where did you work next after Valleylab?
 18 A. I worked for a company called Medlogic Global
 19 Corporation. It's a company that -- a startup company
 20 that focused on tissue adhesives.
 21 Q. Okay. And did you -- what was your next position
 22 where you worked with electrosurgical devices?
 23 A. I worked most recently worked at a company called
 24 Colorado Medtech. And Colorado Medtech is a company
 25 that does outsource product developing, manufacturing.

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1 We basically develop products for other companies and
 2 manufacture products for other companies and during the
 3 course of my tenure there, we have worked on at least
 4 one project that incorporates electrosurgery generator.
 5 Q. Are you still employed by Colorado Medtech?
 6 A. No. We sold my division of the company at the end
 7 of January.
 8 Q. By whom are you currently employed?
 9 A. I'm employed by myself. I have a company called
 10 Taylor Medical Technology Consulting.
 11 Q. What is the business of Taylor Medical Technology and
 12 Consulting?
 13 A. My business is to do medical device technology
 14 planning and business development for small medical device
 15 companies.
 16 Q. Do you have any patents or publications in the field
 17 of electrosurgery?
 18 A. Yes, I have two patents. In electrosurgery. I have
 19 a total of five patents.
 20 Q. And have you published in the field of electrosurgery?
 21 A. Yes. I have a number of papers in that area.
 22 Q. Are those publications listed in your resume?
 23 A. Yes, they are.
 24 MR. MARSDEN: Your Honor, I move the admission
 25 of DTX-418, Dr. Taylor's resume.

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1 MR. BOBROW: No objection, your Honor.
 2 THE COURT: Thank you.
 3 *** (Defendant's Exhibit No. 418 was received into
 4 evidence.)
 5 BY MR. MARSDEN:
 6 Q. When did you first become involved in this case, Dr.
 7 Taylor?
 8 A. It was about a year ago.
 9 Q. Do you recall how you were contacted?
 10 A. Yes. Kurtis MacFerrin called me up and asked to meet
 11 with me.
 12 Q. What were you asked to do?
 13 A. He asked me to review the patents in suit, '536,
 14 the '882 and the '592 patents, to basically analyze them,
 15 to take a look at the prior art, to take a look at the
 16 devices that are in question here and to make a
 17 determination as to whether or not the devices infringe --
 18 infringed, whether or not the patents were valid.
 19 Q. And what did you do to determine whether or not
 20 the patents are infringed and whether the patents are
 21 valid.
 22 A. Well, first, obviously, I read the patents several
 23 times. I read their file wrapper, so I guess what we
 24 would call file histories?
 25 I looked at prior art publications and patents.

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1 I studied the devices. When I say I studied the devices,
 2 basically I received products from Smith & Nephew. That
 3 included the instruction sleeves. I -- those products
 4 included the generator.
 5 I also looked at the design history files for
 6 the products. At least parts of them, not the whole file.
 7 And I reviewed a whole host of depositions from a variety
 8 of people, both at Smith & Nephew and ArthroCare,
 9 including the deposition for -- for Mr. Eggers, the
 10 deposition for Dr. Thapliyal, Mrs. Knudsen's deposition,
 11 Mrs. Drucker's deposition, and a long list of others.
 12 Q. Did you review --
 13 A. I also went to Smith & Nephew's bioscope lab and
 14 had an opportunity to use the Control RF and Saphyre and
 15 the ElectroBlade on a cadaver shoulder. That was fun.
 16 I enjoyed that.
 17 Q. Did you also review Knudsen's deposition testimony?
 18 A. Yes, I did.
 19 Q. Are you being compensated for your time in this
 20 case?
 21 A. Yes, I am.
 22 Q. At what rate are you being compensated?
 23 A. I am being compensated at my standard, what -- time,
 24 my standard consulting rate of \$150 an hour.
 25 Q. Have you ever served as an expert in litigation

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1 before?
 2 A. No, I haven't.
 3 Q. As a result of the study that you performed, have
 4 you reached any opinions regarding infringement and
 5 validity?
 6 A. Yes, I have.
 7 Q. What are those opinions?
 8 A. My opinion is that the products, the accused
 9 products, the Saphyre, the ElectroBlade and the Control
 10 RF, do not infringe the ArthroCare patents. And also
 11 that the ArthroCare patents are invalid.
 12 Q. Okay. Let's turn first to the issue of
 13 noninfringement and we'll take patents one at a time, if
 14 that makes sense to you.
 15 A. That's fine.
 16 Q. Okay. Let's start with the '536 patent, Dr. Taylor.
 17 Can you describe for the jury what the '536
 18 patent is about?
 19 A. The '536 patent is what -- what I call and what we
 20 call an utility patent. It describes a product or an
 21 apparatus that is an electrosurgical system that contains
 22 or has an electrosurgical probe which has an electrically
 23 conductive fluid supply.
 24 Those are the essential parts of it.
 25 Q. How do you know that the system claimed in the '536

1 patent includes an electrosurgical -- I'm sorry -- an
 2 electrically conductive fluid supply?
 3 A. Well, if you go look at the actual patent itself,
 4 it pretty much states that in the claims. If you look at
 5 the figures, at least some of the figures in the patent,
 6 it pretty much states that.
 7 And there are some other aspects that includes.
 8 Q. Did you consider the Court's claim construction on
 9 that issue?
 10 A. Oh, yes, I certainly did.
 11 Q. Have you prepared any graphics to help explain to
 12 the jury how you reached your conclusions in connection
 13 with the '536 patent?
 14 A. Yes, I have.
 15 Q. All right.
 16 MR. MARSDEN: Gary, could we have DDTX-406,
 17 please?
 18 BY MR. MARSDEN:
 19 Q. I think you answered earlier that one of the ways
 20 that you determined that an electrically conducting fluid
 21 supply was required by the claims of the '536 patent was
 22 by looking at the claims themselves?
 23 A. Yes.
 24 Q. Could you use this graphic to explain to the jury
 25 how you reached this conclusion?

1 A. Sure. If you look at the top there, you've got
 2 an electrosurgical system, which is -- which has been
 3 highlighted, comprising, among other things, down the
 4 bottom here, an electrically conducting fluid supply, so
 5 that's in the claim. And then if you go over to Figure 1,
 6 you see that there's an IV bag (indicating). You actually
 7 have the text of the claim, it's more evident, but there's
 8 an IV bag that goes by a tube into the actual device.
 9 Q. And there's this word comprising that you've
 10 highlighted on this slide. Does that have any special
 11 meaning in the field of patent law?
 12 A. Yes, it does, and actually you guys explained that
 13 to me very well. Basically, it says that the system has
 14 to include these elements and it just lists the elements
 15 here.
 16 Q. Okay.
 17 A. It has to contain those elements.
 18 Q. It's like including?
 19 A. Yes. It has to include those elements.
 20 Q. Do you have other slides that you prepared?
 21 A. Yes.
 22 The next, Gary, I won't call you Chris --
 23 Gary, the next one, please.
 24 Here's a series of four figures which show the
 25 electrically conductive fluid supply coming in from a

1 number of different perspectives.
 2 And figure -- in Figure 2A, the fluid is being
 3 supplied through the center of the device and that's shown
 4 there.
 5 ---
 6 A. (Continuing) Figure 6, the fluid supply is coming in
 7 from the bottom and flowing in that direction.
 8 Figure 7 is a different embodiment. You have
 9 the return electrode and fluid supply are one part of the
 10 probe, a separate element of the probe and the active
 11 electrode is over here. The fluid supply is being
 12 supplied through the return electrode in this secondary
 13 shaft, if you will.

1
 2 A. (Continuing) And in the case of Figure 8, the fluid
 3 supply is on the outside of the structure there.
 4 So we've got essentially four different ways to
 5 get it there. One is through the center of the probe, one
 6 is through the bottom of the probe, if you will, one is
 7 through a separate return electrode and fluid supply and
 8 the other is on the outside of the shaft.
 9 Q. If I could just direct your attention to Figure 7
 10 again, why is this not a separate fluid supply -- I'm
 11 sorry. Why is this not a separate fluid supply system
 12 apart from the electrode -- electrosurgical system?
 13 A. Well, because if you go back to the original claim,
 14 the claim requires that you have a return electrode as
 15 well as an electrically conductive fluid supply. In this
 16 particular case, the return electrode is actually separate
 17 from the active electrode shaft. But it does contain the
 18 electrically conducting fluid supply.
 19 Q. And where exactly is the return electrode in the
 20 embodiment or the example given in Figure 7?
 21 A. Figure 7, the return electrode is right there.
 22 Q. Do you consider that to be part of the
 23 electrosurgical system?
 24 A. Yes, I do.
 25 Q. Were you just in the courtroom when the testimony

1 of Dr. Thapliyal was read?
 2 A. Yes, I was.
 3 Q. Did you hear Dr. Thapliyal describe the differences
 4 between the '909 patent and the '536 patent that we've
 5 been discussing?
 6 A. Yes, I did.
 7 Q. Do you recall what the difference was that he called
 8 out in his testimony?
 9 A. I believe the difference was that the '506 patent
 10 includes an electrically conductive fluid supply.
 11 Q. You said you considered the Court's claim
 12 construction in evaluating infringement of the '536
 13 patent; is that correct?
 14 A. That's correct.
 15 MR. MARSDEN: Could we put up the Court's
 16 claim construction, PTX-365 and go to Page 14, please?
 17 BY MR. MARSDEN:
 18 Q. Dr. Taylor, did you use this claim construction
 19 in reaching your conclusions of the no infringement of
 20 the --
 21 A. Yes.
 22 Q. Would this definition help you in reaching that?
 23 A. Yes.
 24 Q. How did it assist you?
 25 A. Well, as shown there, the term system shall be

1 construed to mean an assemblage or combination of things
 2 or parts forming an unitary whole, so therefore it means
 3 that all the things that are in that system or that
 4 Claim 1 have to be present in the electrosurgical system
 5 in order for it to be consistent with the claim.
 6 Q. Okay. Now, there are particular claims of the ' 536
 7 patent that have been asserted against the products that
 8 Smith & Nephew makes; correct?
 9 A. Correct.
 10 Q. Have you formed an opinion as to whether the Smith &
 11 Nephew Saphyre infringes Claims 46, 47 and 56 of the 536
 12 patent?
 13 A. Yes, I have.
 14 Q. What is your opinion?
 15 A. My opinion is they do not -- those products do not
 16 infringe those claims.
 17 Q. Why not?
 18 A. Well, I did an analysis of the claims, those three
 19 claims, and in order to do an analysis of those claims,
 20 you have to go back to the independent claim those
 21 claims reference, which is Claim 45.
 22 Q. Did you analyze the products to determine whether
 23 they had a -- a -- an electrically conductive fluid
 24 supply?
 25 A. Yes, I did. And they do not.

1 Q. Can you tell the jury how you do an infringement
 2 analysis when evaluating a patent claim?
 3 A. Essentially, what you do is you look at all the
 4 elements of the claims to determine whether or not the
 5 product that you are evaluating contains all the elements
 6 of those claims. And that's what I did.
 7 Q. And what happens if one of the elements is missing?
 8 A. If one of the elements is missing, this is like
 9 baseball. We have to have a batting average of a thousand
 10 in order to win. If one of the elements is missing, then
 11 the product does not infringe.
 12 Q. Okay. Do you have a slide to help describe for the
 13 jury the particular claims that are asserted in the '536
 14 patent?
 15 A. Yes, I do.
 16 MR. MARSDEN: Gary, could we call up DDTX-409,
 17 please?
 18 BY MR. MARSDEN:
 19 Q. And, Dr. Taylor, which claims are asserted against
 20 the Smith & Nephew products?
 21 A. Claims 46, 47 and 56, as shown on the right-hand
 22 column there.
 23 Q. Are those claims independent claims or dependent
 24 claims?
 25 A. Those are dependent claims.

1 Q. Can you describe for the jury what the difference is
 2 between an independent claim and a dependent claim?
 3 A. Sure. A dependent claim depends upon another claim
 4 in order for it to be active. If you take a look at
 5 Claim 46, for example, it says an electrosurgical system
 6 as in Claim 45. If you look at Claim 47, it says an
 7 electrosurgical system as in Claim 46. Therefore, it
 8 depends on Claim 46.
 9 If you look at 56, it says the electrosurgical
 10 system of Claim 45. Therefore, it depends on Claim 45.
 11 Q. What does that mean in practical terms in terms of
 12 how you evaluate whether there's infringement?
 13 A. What it means is, practically speaking, you have to
 14 take a look first at Claim 45 to see whether or not the
 15 product contains all the elements and infringes Claim 45.
 16 If it doesn't infringe Claim 45, then it can't infringe,
 17 in this case, 46 or 56, and also 47 due to the fact that
 18 47 is dependent on 46.
 19 Q. So that means that you had to look at Claim 45 even
 20 though Claim 45 is not asserted against these products;
 21 correct?
 22 A. That's correct.
 23 Q. Are all of the elements of independent Claim 45
 24 found in the accused Smith & Nephew products?
 25 A. No, they're not. They're missing -- okay. The

1 product is missing, electrically conducting fluid supply.
 2 Q. Have you prepared any slides to assist you in
 3 illustrating that to the jury?
 4 A. Yes, I have.
 5 MR. MARSDEN: Gary, could we pull up DDTX-408,
 6 please?
 7 BY MR. MARSDEN:
 8 Q. Can you use this slide, Dr. Taylor, to explain your
 9 opinion?
 10 A. Yes.
 11 As you see on the right-hand side, there's the
 12 claim, Claim 45, the independent Claim 45. Then on the
 13 left-hand side, what I'm showing is what the claim system
 14 must include. And as I mentioned previously, the claim,
 15 the products, the Saphyre, the Control RF and the
 16 ElectroBlade, do not have an electrically conducting
 17 fluid supply. And since all of the '536 claims require or
 18 are dependent upon, if you will, Claim 45, which requires
 19 an electrically conducting fluid supply, therefore none of
 20 those products infringe.
 21 Q. And did you look at the Smith & Nephew products and
 22 how they are used in determining whether or not there was
 23 an electrically conducting fluid supply as claimed in the
 24 '536 patent?
 25 A. Yes, I did.

1 Q. Have you prepared another slide to demonstrate that?
 2 A. Yes.
 3 MR. MARSDEN: Could we call up DDTX-410, please,
 4 Gary?
 5 BY MR. MARSDEN:
 6 Q. Can you use this slide to describe to the jury your
 7 opinion that the '536 patent does not infringe?
 8 A. Yes. This overhead shows the various components,
 9 actually that Mr. Sparks was demonstrating yesterday, but
 10 what you have here is on the left-hand side, more or less,
 11 you've got the fluid supply, electrically conductive
 12 fluid supply, which is an IV bag going through the fluid
 13 system, eventually ending up in a cannula that goes into
 14 the patient.
 15 You've got a light source that powers the --
 16 the arthroscope and eventually the image of the
 17 arthroscope is shown on a TV monitor.
 18 And then you have the RF generator and
 19 whichever Smith & Nephew probe we're talking about, which
 20 goes into a separate port. Therefore, when you take a
 21 look at this overall arthroscopy sweet system, the
 22 electrically conducting fluid supply is separate from the
 23 RF probes.
 24 Q. Where is the electrosurgery system in this figure?
 25 A. The electrosurgery system is the RF generator and

1 the probe (indicating).
 2 Q. So essentially the right-hand side?
 3 A. The right-hand side. That's correct.
 4 Q. And where is the electrically conducting fluid
 5 supply system?
 6 A. The electrically conducting fluid supply is this IV
 7 bag, fluid management system, the box there, and the tube
 8 that's going into the cannula.
 9 Q. Now, I think you may have used the expression an
 10 arthroscopy suite or system in describing what you've
 11 drawn here in this figure.
 12 Explain how, is the '536 patent directed
 13 towards an arthroscopy system?
 14 A. No.
 15 Q. What is the claim term that the Judge has construed?
 16 I'm sorry. What is the term that you were considering in
 17 determining infringement of the '536 patent?
 18 A. An electrosurgical system.
 19 Q. An electrosurgical system -- can it be part of a
 20 larger arthroscopy system?
 21 A. It's can be part of one, yes.
 22 ---
 23 Q. Were you here when Dr. Choti testified earlier this
 24 week?
 25 A. Yes, I was.

1 Q. Is Dr. Choti a surgeon?
 2 A. Yes, he is.
 3 Q. Do you recall whether Dr. Choti opined on the
 4 infringement of the '536 patent?
 5 A. Yes.
 6 ---
 7 Q. And what do you recall that Dr. Choti's opinion was?
 8 A. He agreed with me.
 9 MR. BOBROW: Your Honor, I object. It's beyond
 10 the scope of his report, what Dr. Choti did and said, what
 11 he opined on, et cetera is beyond the scope.
 12 THE COURT: Is this what was presented here in
 13 court or presented through reports?
 14 MR. MARSDEN: It was simply the testimony that
 15 was given from the stand by Dr. Choti, your Honor, and
 16 we're not going to go any further with it.
 17 THE COURT: I will allow it.
 18 BY MR. MARSDEN:
 19 Q. Thank you, Dr. Taylor.
 20 I'd like to turn next to the '882 patent.
 21 Can you describe for the jury what the '882
 22 patent is all about?
 23 A. The '882 patent is a method patent and it's basically
 24 a method for describing how to carry out a particular
 25 process. That's what a method patent is. And it's a

1 method basically for applying electrosurgical energy to a
 2 point on the body or place on the body using an
 3 electrosurgical probe. General description.
 4 Q. I think we've put up on the screen JTX-2, which is
 5 the '882 patent. Would that assist you in providing your
 6 testimony on the '882 patent?
 7 A. That basically describes it pretty well right there.
 8 Q. Okay. And what we've put up on the screen is Claim 1
 9 of the '882 patent; correct?
 10 A. Correct.
 11 Q. Is Claim 1 of the '882 patent asserted against the
 12 Smith & Nephew products?
 13 A. No, it is not.
 14 Q. Okay. Why did you look at Claim 1?
 15 A. Can you repeat the question?
 16 Q. Sure. Why did you look at Claim 1 if it's not one
 17 of the asserted claims?
 18 A. Oh. It's the -- the dependent claims are asserted
 19 against these products referenced Claim 1.
 20 Q. So this is a little bit like Claim 45 was in the
 21 '536 patent?
 22 A. That's correct.
 23 Q. Okay. Now, I believe Mr. Bobrow a little bit
 24 earlier was questioning a witness about whether or not
 25 the ElectroBlade has two electrodes or maybe three

1 electrodes.
 2 Do you recall that?
 3 A. Yes, I do.
 4 Q. And that was in connection with the '882 patent?
 5 A. That's correct.
 6 Q. The '882 patent, is it even asserted against the
 7 ElectroBlade products?
 8 A. According to my understanding, it is not.
 9 Q. Okay. What products is the '882 patent asserted
 10 against?
 11 A. It's asserted against the Saphyre and the Control
 12 RF.
 13 Q. What claims are asserted against the Saphyre?
 14 A. The Saphyre has Claim 13, 17 and 54.
 15 Q. And how about -- is it also asserted against Control
 16 RF?
 17 A. Yes. And Control RF, it's only 17 and 54.
 18 Q. Are those asserted claims independent claims or
 19 dependent claims?
 20 A. Those are dependent claims.
 21 Q. And how do you know that?
 22 A. If you actually show me the claim, I can show you.
 23 But they're -- all three of them are dependent upon
 24 Claim 1.
 25 MR. MARSDEN: Gary, can we go to the page

1 where we have Claims 13 and 17?
 2 BY MR. MARSDEN:
 3 Q. How do you know that claim 13 is a dependent claim?
 4 A. If you look at the claim language here, it starts
 5 off as similar to what was happening in the prior patent.
 6 The method of Claim 1.
 7 Q. All right. And how about Claim 17?
 8 A. Similarly starts off as the method of Claim 1.
 9 Q. And, finally, Claim 54.
 10 A. Also the method of Claim 1.
 11 Q. So how do you determine whether any of these
 12 dependent claims is infringed?
 13 A. You have to go back and take a hard look at Claim 1.
 14 Q. Okay. Now, turning back to Claim 1, you've heard
 15 some testimony, at least some reference during the course
 16 of this trial to a certificate of correction.
 17 A. That's correct.
 18 Q. And is it your understanding that that dispute
 19 relates to Claim 1 of the '882 patent?
 20 A. Yes.
 21 Q. Do you have an understanding of how many electrodes
 22 Claim 1 required when it was allowed and published by the
 23 Patent Office?
 24 A. As originally published, it had four electrodes.
 25 Q. And do you understand that there has been a

1 certificate of correction filed that would reduce that
 2 number of electrodes to two?
 3 A. Yes, I do.
 4 Q. In conducting your infringement analysis of the
 5 '882 patent, did you make any assumptions regarding the
 6 certificate of correction?
 7 A. I made an assumption that the certificate of
 8 correction was invalid and conducted my analysis, assuming
 9 that there were four electrodes.
 10 Q. Okay. And you understand that the issue of whether
 11 or not the certificate of correction is invalid will be
 12 something that will be decided by the Court or the jury
 13 in this case?
 14 A. Yes, I understand.
 15 Q. But for purposes of your infringement analysis you
 16 assumed that it was invalid and that the claim, therefore,
 17 required four electrodes as originally published?
 18 A. That's correct.
 19 Q. And have you -- with that assumption, have you formed
 20 an opinion as to whether the Saphyre product infringes
 21 Claims 13, 17 and 54 of the '882 patent?
 22 A. Yes, I have.
 23 Q. What is that opinion?
 24 A. It does not infringe.
 25 Q. Why not?

1 A. It doesn't infringe because it doesn't have four
 2 electrodes.
 3 Q. How many electrodes does it have?
 4 A. It has two.
 5 Q. Again, using the same assumption about the
 6 certificate of correction, have you reached a conclusion
 7 as to whether the Control RF product infringes Claims 17
 8 and 54 of the '882 patent?
 9 A. Yes, I have.
 10 Q. What is that opinion?
 11 A. That it does not infringe.
 12 Q. Why not?
 13 A. It only has two electrodes instead of the four
 14 required by the patent, or the claim.
 15 Q. Okay. I think we're ready to move on to the '592
 16 patent.
 17 A. All right.
 18 Q. Can you describe briefly for the jury what the '592
 19 patent is about?
 20 A. Once again, the -- the '592 patent is a method
 21 patent. It's a -- basically, a patent that describes the
 22 process for doing something. And it's a method patents
 23 applying electrical energy to a target site on the body
 24 while you're spacing away or not allowing the contact,
 25 the return electrode to the body.

1 Q. I'm sorry. Before I launch into the '592, I did
 2 want to ask you one other question about the '882. Does
 3 Dr. Goldberg dispute that the Saphyre and the Control RF
 4 have only two electrodes?
 5 A. I don't believe so, no.
 6 Q. So that your real dispute over the '882 patent in
 7 infringement is over whether or not the certificate of
 8 correction is valid or not?
 9 A. That's correct.
 10 Q. And if it is valid, then it would require only two;
 11 is that right?
 12 A. Yes. However, there is, I think there's an issue in
 13 that. If it only has two, then there would be a lot of
 14 other products that infringe.
 15 Q. Okay. Well, we'll talk about that when we get to
 16 the invalidity portion of the case.
 17 A. Okay.
 18 Q. Probably tomorrow, at the pace we're going.
 19 Let's turn back now to the '592 patent.
 20 Have you prepared a slide to assist you in
 21 explaining to the jury the opinions you've reached on
 22 the '592 patent?
 23 A. Yes, I have.
 24 MR. MARSDEN: Could we call up DDTX-450, please?
 25

1 BY MR. MARSDEN:
 2 Q. Can you tell the jury which claims of the '592
 3 patent are asserted against the Smith & Nephew products?
 4 A. Well, there are two sets of claims. One set is
 5 shown here on the right, right-hand side, which are
 6 Claims 3, 4, 11 and 21. And as shown here, they're all
 7 dependent on Claim 1.
 8 Q. Okay. Now, in this case, has ArthroCare also
 9 asserted the independent Claim 1?
 10 A. I don't believe so.
 11 Q. All right.
 12 A. I could be wrong. I have to admit, there have been
 13 so many claim changes during the course of this particular
 14 case that it's hard to keep track.
 15 Q. Okay. In any event, as you know from the testimony
 16 on the '882 and the '536, you need to look at Claim 1 in
 17 any event; correct?
 18 A. Right. You do.
 19 Q. All right. And have you reviewed Claim 1 and the
 20 dependent claims? First of all, can you tell the jury
 21 again how you know Claims 3, 4, 11 and 21 are dependent
 22 claims?
 23 A. Once again, they start off with the method of Claim
 24 1 in both Claims 3, 4, 11 and 21.
 25 Q. And how did you go about analyzing whether Smith &

1 Nephew's products infringed any of these asserted claims?
 2 A. Once again, I started off with the independent
 3 claim and looked at whether or not the Smith & Nephew
 4 products meet all of the elements of the independent
 5 Claim 1 and it does not or they do not.
 6 Q. What element did they not meet?
 7 A. They do not meet the highlighted element, which is
 8 positioning a return electrode within the electrically
 9 conducting fluid such that the return electrode is not
 10 in contact with the body structure.
 11 Q. Did you also consider the Court's claim construction
 12 in evaluating whether or not the '592 patent is infringed?
 13 A. Yes, I did.
 14 MR. MARSDEN: Gary, can we call up the Court's
 15 claim construction, please, and specifically the Court's
 16 claim construction of these terms. And that's PTX-675 at
 17 Paragraph 4, I believe.
 18 BY MR. MARSDEN:
 19 Q. Did you use the Court's definition as set forth here
 20 in PTX-975 in determining whether or not the accused
 21 products infringe the '592 patent?
 22 A. Yes, I did. And basically I looked at the
 23 highlighted sentence there: Claim limitation. The return
 24 electrode is not in contact with the body structure is
 25 clear -- the return electrode is not to contact the body

1 at all during the performance of the claimed method.
 2 And my interpretation and analysis would
 3 indicate that the products in suit here do contact the
 4 body during the course of the claim method.
 5 Q. How did you determine that?
 6 A. Based on the video, actually, based on my own
 7 personal experience, but also on the videos, training
 8 videos that were produced to me.
 9 Q. What do you mean by your own personal experience?
 10 A. Well, I had the opportunity to play with, I shouldn't
 11 say play -- for an engineer, it's play. Experiments with
 12 the cadaver shoulders at Smith & Nephew and had an
 13 opportunity to use the devices in a cadaver shoulder, and
 14 it was obvious that it would be very difficult to perform
 15 these procedures without contacting, having the return
 16 electrode contact the body structures at some point
 17 during the course of the procedure.
 18 Q. Did you also review videos that Smith & Nephew has
 19 prepared to train its sales force?
 20 A. Yes, I did. I looked at the training videos and
 21 those training videos actually are conducted by people
 22 that know what they're doing in terms of arthroscopy.
 23 And there -- it was obvious that during the course of
 24 those training videos, that the return electrode was
 25 contacting tissue during the course of the procedure.

1 Q. Now, I believe through the course of the trial we've
 2 actually seen several of those videos and I believe we've
 3 already seen videos of the Saphyre and the ElectroBlade
 4 in operation.
 5 Do you recall that?
 6 A. Yes, I do.
 7 Q. But do you know whether the jury has seen a video
 8 yet of the Control RF product in operation?
 9 A. To my knowledge, they have not.
 10 Q. Okay. And did you consider the video or a video of
 11 the Control RF product in operation in determining whether
 12 or not there was infringement of the claims of the '592
 13 patent?
 14 A. Yes, I did.
 15 Q. Okay. And do you have a clip to show the jury?
 16 A. Yes.
 17 Q. Okay. Was this a video that was prepared again by
 18 Smith & Nephew to train its sales force on how this
 19 product would be used?
 20 A. Yes, it was.
 21 Q. Okay.
 22 MR. MARSDEN: Gary, can we play DTX-897,
 23 please?
 24 BY MR. MARSDEN:
 25 Q. Dr. Taylor, if you would go ahead and describe for

1 the jury what we're seeing.
 2 A. Okay.
 3 (Pause.)
 4 (Video played.)
 5 THE WITNESS: What you can see here is the
 6 Control RF, the active electrode is somewhat buried in
 7 the tissue, but the return electrode is obviously
 8 touching -- touching tissue at various points during the
 9 procedure. Actually, it's obscured here, but -- in
 10 essence, the return electrode is contacting tissue during
 11 a large portion of the procedure, right there (indicating).
 12 MR. MARSDEN: Could I approach, your Honor?
 13 THE COURT: Yes, you may.
 14 BY MR. MARSDEN:
 15 Q. Let me hand you, Dr. Taylor, the Control RF product
 16 that was marked earlier in this case. I wonder if you
 17 could remind the jury where the return electrode is on
 18 that device (handing exhibit to the witness).
 19 A. Sure. A little difficult to see, but the tip of my
 20 finger is the start of the return electrode and it extends
 21 up to the tip of this white structure here (indicating).
 22 So it's a fairly large electrode relative to the active
 23 electrodes, which are very tiny.
 24 Q. Okay.
 25 MR. MARSDEN: You can stop the video. Thank

1 you.
 2 MR. MARSDEN: Your Honor, I move the admission
 3 of DTX-897, the video that was just played.
 4 MR. BOBBROW: No objection.
 5 THE COURT: All right. Thank you.
 6 *** (Defendant's Exhibit No. 897 was received into
 7 evidence.)
 8 BY MR. MARSDEN:
 9 Q. Dr. Taylor, if we can go back to the claims, we
 10 talked about Claim 1 and the dependent claims that depend
 11 from Claim 1, correct?
 12 A. Yes.
 13 Q. Did you prepare a slide to show the other claims of
 14 the '592 that are asserted?
 15 A. Yes, I did.
 16 MR. MARSDEN: Could we call that up, please,
 17 Gary? Okay.
 18 BY MR. MARSDEN:
 19 Q. And this is headed ArthroCare also asserts Claims
 20 23, 26, 27, 32 and 42 of the '592 patent; correct?
 21 A. That's correct.
 22 Q. Okay. Are these claims also asserted against the
 23 Smith & Nephew Saphyre ElectroBlade and Control RF
 24 products?
 25 A. Yes, they are.

1 Q. Can you describe to the jury how this set of claims
2 works?
3 A. Once again, on the right-hand side, right column,
4 we have Claims 26, 27, 32 and 42. As you can see, they
5 all start off with the method of Claim 23 at the beginning
6 of each claim. On the other side we have Claim 23.
7 So it requires, in order to analyze it, that
8 you examine whether or not the products infringe Claim 23.
9 Q. Have you analyzed whether the three accused products
10 infringe Claim 23?
11 A. Yes, I did.
12 Q. And did you determine whether all of the elements
13 that are required by Claim 23 are present in the accused
14 devices?
15 A. No, they're not. The -- the accused devices do not
16 meet the second element there, the one that's highlighted,
17 saying spacing a return electrode away from the body
18 structure.
19 Q. And did you, again, use the Court's claim
20 construction in reaching that conclusion?
21 A. Yes, I did.
22 Q. Did you rely on the videos that we've seen here in
23 court in reaching that conclusion?
24 A. Yes.
25 Q. And did you also rely on your own experimentation

1 with the devices?
2 A. Yes.
3 Q. In summary, then, Dr. Taylor, have you formed an
4 opinion as to whether the Saphyre, ElectroBlade and
5 Control RF products infringe Claims 1, 3, 4, 11, 21, 23,
6 26, 27, 32 and 42 of the '592 patent?
7 A. I've reached an opinion.
8 Q. What is your opinion?
9 A. They do not infringe.
10 Q. Do you recall whether Dr. Choti expressed an opinion
11 on the '592 patent with respect to infringement?
12 A. He agreed with me.
13 MR. MARSDEN: Your Honor, that concludes our
14 presentation on noninfringement for today. It might be a
15 logical breaking point.
16 THE COURT: All right. Members of the jury,
17 we will conclude for the day.
18 We kept you late today. We're going to let you
19 come in later tomorrow because we've got some business we
20 have to take care of, so if you will report -- and I think
21 I'm going to make it at 10:30 tomorrow morning.
22 In the meantime, however, you're not to discuss
23 the case among yourselves or with anyone else. You're not
24 to read or listen to anything touching on the case or
25 perform any independent investigation.

1 Have a safe trip home, a wonderful evening and
2 we'll see you tomorrow morning at 10:30.
3 (At this point the jury was excused for the
4 evening recess, and the following occurred without the
5 presence of the jury.)
6 THE COURT: All right. I have a plea at 4:30,
7 so we're not going to do anything yet this afternoon.
8 We'll meet tomorrow morning at 9:30, go over these
9 demonstratives and the other evidentiary issues and charge.
10 If you can hang around for just a few minutes, I will have
11 my Clerk copy my first draft of the jury instructions so
12 you have the evening to look over them.
13 Oh, we need a verdict form. Take a look at
14 the jury instructions and then prepare a verdict form,
15 depending on what you think about what's going on in the
16 case at this point. All right?
17 Thank you.
18 (Court recessed at 4:23 p.m., to reconvene on
19 Thursday, May 8, 2003, at 9:30 a.m.)
20 ---
21
22
23
24
25

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1 - VOLUME G - Page 1229

2 IN THE UNITED STATES DISTRICT COURT

3 IN AND FOR THE DISTRICT OF DELAWARE

4

5 ARTHROCARE CORPORATION, : CIVIL ACTION

6 Plaintiff : :

7 vs. : :

8 SMITH & NEPHEW, INC., : :

9 Defendant : NO. 01-504 (SLR)

10

11 Wilmington, Delaware

12 Thursday, May 8, 2003

13 9:03 o'clock, a.m.

14 BEFORE: HONORABLE SUE L. ROBINSON, Chief Judge, and a jury

15

16 APPEARANCES:

17

18 MORRIS, NICHOLS, ARSBY & TUNNELL

19 BY: JACK B. BLUMENFELD, ESQ. and

20 KAREN JACOBS-LOUDEN, ESQ.

21

22 -and-

23

24 Official Court Reporters

25

1 APPEARANCES (Continued): Page 1230

2

3 WEIL, GOTSHAL & MANGES

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8 Counsel for Plaintiff

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11 FISH & RICHARDSON P.C.

12 BY: WILLIAM J. MARSDEN, JR., ESQ.,

13 KEITH A. WALTER, ESQ. and

14 EUGENE B. JOSWICK, ESQ.

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16 -and-

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18 FISH & RICHARDSON

19 BY: MARK J. HEBERT, ESQ.,

20 (Boston, Massachusetts)

21

22 -and-

23

24 FISH & RICHARDSON

25 BY: KURTIS D. MacFERRIN, ESQ. and

KAREN L. BOYD, ESQ.

(Redwood City, California)

Counsel for Defendant

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2 PROCEEDINGS

3

4 (Proceedings commenced in the courtroom,

5 beginning at 9:03 a.m., and the following occurred without

6 the presence of the jury.)

7

8 THE COURT: All right. Generally, how I go

9 through the jury instructions is basically page by page.

10 I will holler out the page. If there is an objection, a

11 correction, a typographical error, whatever, you can holler

12 out. If I don't hear anything I will assume there is

13 nothing to be corrected or changed or amended.

14 We will start with Page 2, the introduction.

15 Page 3, the jurors' duties.

16 Page 4, evidence defined.

17 Page 5, more evidence defined.

18 Page 6, consideration of evidence.

19 Page 7, circumstantial evidence and direct.

20 And I have got money out there for someone who gives me

21 a different example some day, because I am so sick of

22 this example. Think about it.

23 Page 8, credibility of witnesses.

24 Page 9, more credibility of witnesses.

25 Page 10, expert witnesses.

1 Page 1232

2 Page 11, deposition testimony.

3 Page 12, number of witnesses.

4 Page 13, demonstrative exhibits.

5 Page 14, burdens of proof.

6 MS. BOYD: Your Honor, Smith & Nephew would

7 like to request that the last sentence of the paragraph

8 regarding clear and convincing evidence be deleted, this

9 sentence read this burden remains with Smith & Nephew

10 throughout the case, it never changes or shifts to

11 ArthroCare.

12 This is in addition to the Delaware Model

13 Instruction, and we would ask that it be deleted. In the

14 alternative, we would ask that a parallel statement be

15 added to the end of the preponderance of the evidence

16 paragraph.

17 MS. JACOBS-LOUDEN: Your Honor, this is a correct

18 statement of the law. We cited case law for it. It has

19 appeared in other instructions before this Court. The

20 modern rules, of course, haven't been amended since 1993.

21 So it is not surprising that there would be some additions

22 since the 1993 edition.

23 But it is what the law is, and we think it is

24 a correct statement that would be helpful to the jury.

25 THE COURT: well, is it not also true that

your burden on infringement remains with you throughout

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1 I'm going to correct it, he didn't -- I mean he corrected
2 it and he didn't have ordinary skill.

3 So I think it's unfair to have us judge it one
4 way when it was done in another way. So without knowing
5 the history of this, I'm not confident, regardless of what
6 the technical standard is, I'm not sure whether it should
7 be applied in this case, depending on the facts.

8 MS. JACOBS-LOUDEN: But I think what would be
9 unfair is if Mr. Raffle would be questioned, well, wouldn't
10 one reading this think X? Wouldn't one reading this think
11 Y? He prosecuted the patent. He can give what information
12 he can about the prosecution of the patent, but to start
13 using him to make an argument about what one would
14 understand reading this would be inappropriate.

15 MR. MACFERRIN: Your Honor, Mr. Raffle submitted
16 a declaration earlier in this case about these very alleged
17 errors saying they were clerical, typographical errors.

18 THE COURT: And I think everyone is agreeing
19 that you can ask him what he did. I think the issue is
20 whether you can say, kind of make him more than a fact
21 witness, more of an expert witness, wouldn't one of
22 ordinary skill in the art understand X Y and Z? That's
23 not appropriate, I don't think.

24 MR. MACFERRIN: I don't think that necessarily
25 pertains to the demonstrative issue.

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1 THE COURT: No, no.

2 MR. MACFERRIN: Just having a slide.

3 MS. JACOBS-LOUDEN: The demonstratives we
4 provided do raise this issue. There were slides that say
5 that one could think this isn't an obvious error. One
6 could think the claims could be changed this way.

7 MR. BLUMENFELD: Your Honor, the
8 demonstratives -- and here is the first one. It's No. 411,
9 and the heading of it is, they show a change to the claim
10 and they say, the heading is Alleged Active Electrode
11 Error Fails The Test, Part 2. Even if active electrode
12 is an obvious error, it's not obvious how it should be
13 corrected. Other changes could have been made.

14 MR. MACFERRIN: We agree we will not use that
15 slide, your Honor.

16 MR. BLUMENFELD: If they're not going to use
17 that, they won't be able to use the other ones that follow
18 on it that say the same thing.

19 MR. MACFERRIN: Well, there is slides, your
20 Honor, which merely shows the changes that were made to
21 the claim by the certificate of correction.

22 MR. BLUMENFELD: That one, we don't have a
23 problem if they want to use that, but then they have
24 another slide that says here is what the legal test is.
25 The alleged error fails the test, part one, part one

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1 again, part two, part three. So if they're just going
2 to use the change, then I don't think we have an issue.
3 But if they're going to put slides up with the prosecuting
4 attorney, say here is the test and you failed, I don't
5 think they should be able to do that.

6 THE COURT: Yes. It seems to me that in this
7 case, both sides have missed the boat on important issues
8 because you weren't forthcoming in the first instance and
9 didn't let you get evidence in in the second instance, so
10 my warning to you is you better be forthcoming because
11 surprises, I'm not good at surprises. If you're trying
12 to get in evidence that is inappropriate or that was not
13 appropriately discovered, it's not going to come in and
14 you are not going to look good in the eyes of the jury
15 and you are not going to look good in the eyes of the
16 Court.

17 So maybe you need to hash this out. There
18 will be no argumentative demonstratives of the kind that
19 Mr. Blumenfeld has brought to my attention. All right?
20 That's not how we do things here.

21 All right. Let's take a few minutes. The
22 jury will be here at 10:30 and I want to get started on it.

23 Oh, verdict form. We still need something to
24 work from on a disk which would be helpful, and you still
25 haven't told me when you think this might go to a jury.

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1 Just the best estimate. It's not --

2 MS. BOYD: Well, that actually relates to
3 another issue that I wanted to raise with the Court.
4 Assuming that we do go to the jury, the jury starts its
5 charge at 2:30 on Friday afternoon.

6 THE COURT: No.

7 MS. BOYD: No?

8 THE COURT: No, it won't start at 2:30 Friday
9 afternoon. I mean the point is, I mean the way I had
10 given you time, it should make us be finishing up on
11 Friday morning, so the jury gets it well before the end
12 of the day on Friday.

13 MS. BOYD: Okay, your Honor.

14 THE COURT: Are you keeping track of your time,
15 everybody? And you still have inequitable conduct that is
16 included in that time?

17 MS. BOYD: There is, there is some confusion
18 about how details of time are being allocated with
19 deposition designations, but there is a running total that
20 we have been informed of.

21 THE COURT: All right.

22 MR. BOBROW: Your Honor, do you have an estimate
23 now of what the time is for both sides?

24 THE COURT: I'm sure Francesca does. Why don't
25 you talk to her about it because the time I gave you was

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1 for inequitable conduct as well. And this case was
2 supposed to be done by 3:00, everything. That means in my
3 mind if you have an inequitable conduct case, the jury
4 needs to get it well before 3:00. Otherwise, theoretically
5 you don't have time left.

6 MS. BOYD: Mr. Blumenfeld has proposed or
7 ArthroCare has proposed to Smith & Nephew that the
8 inequitable conduct case be addressed while the jury is
9 deliberating, so that would be, I guess, late Friday
10 morning or early Friday afternoon.

11 Will that work with the Court's schedule?

12 THE COURT: Yes, as long as you are within
13 your time. I'm not putting in extra time. What I'm doing
14 is putting in my trial time, which is your trial time. So
15 you need to work it out. And work out, before you put on
16 and use your last bit of time with these witnesses that
17 you proposed to put on, you better have a clear idea of
18 what you want left for inequitable conduct. All right?

19 Okay. Thank you, counsel.

20 MR. BLUMENFELD: Your Honor?

21 THE COURT: Yes.

22 MR. BLUMENFELD: Just to make clear, the 16
23 hours we got I assume includes closing arguments.

24 THE COURT: Yes, it includes everything. And
25 the more time -- I mean it doesn't include -- I have

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1 given you some time on this, not the evidentiary issues
2 but the jury instruction charge conference is on my time,
3 but all the evidentiary issues you've been having is your
4 time. That's your trial time that you are using on that
5 kind of discussion because you haven't been able to work
6 it out or you haven't given the other party enough notice
7 to work it out.

8 So keep that in mind when Francesca talks to
9 you about how much time, little time you have left.

10 (Court recessed at 10:24 a.m.)

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1
2 (Court resumed after the recess, and the
3 following occurred without the presence of the jury.)
4

5 THE COURT: I did want to note for the record
6 before we started that I am going to give Smith & Nephew a
7 half-hour because, quite frankly Mr. Hebert was much too
8 patient with some of the plaintiff's witnesses, who did
9 not answer questions directly and clearly. And we had to
10 go over the same questions time and again.

11 So for that reason, they get another half-hour.

12 All right. Let's bring the jury in.

13 MR. MARSDEN: Thank you, your Honor. While we
14 are bringing the jury in, can I move those five exhibits.

15 THE COURT: Yes.

16 MR. MARSDEN: PX-478, PX-672, DTX-912, DTX-121,
17 DTX-600, and DTX-791.

18 THE COURT: Any objection to those exhibits?

19 MR. BLUMENFELD: No, your Honor.

20 THE COURT: Thank you.

21 *** (Above-referenced exhibits were received into
22 evidence.)

23 (At this point the jury entered the courtroom
24 and took their seats in the box.)

25 THE COURT: Mr. Marsden, you may proceed.

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1 MR. MARSDEN: Thank you, your Honor. Good
2 morning, ladies and gentlemen of the jury.

3 ---

4 DEFENDANT'S TESTIMONY
5 CONTINUED

6

7 ... KENNETH TAYLOR, having been
8 previously duly sworn as a witness, was
9 resumed and testified further as follows ...

10 DIRECT EXAMINATION

11 BY MR. MARSDEN:

12 Q. Good morning, Dr. Taylor.

13 A. Good morning.

14 Q. Dr. Taylor, before we move to the issue of invalidity,
15 I wanted to touch on a couple of cleanup matters related to
16 the noninfringement opinions you provided yesterday.
17 Yesterday, I asked you whether you considered or used the
18 Court's claim constructions in reaching your opinions on
19 noninfringement.

20 Do you recall that?

21 A. Yes, I do.

22 Q. Just to clarify, when did the Court provide its
23 claim constructions to the parties?

24 A. In about a month.

25 Q. Did you review the Court's claim constructions?

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1 A. Yes, I did.
 2 Q. Did you consider them in offering the opinions you
 3 have offered here in court?
 4 A. Yes, I have.
 5 Q. Do you believe the opinions you have offered here
 6 in court are consistent with the Court's claim
 7 constructions?
 8 A. Yes.
 9 Q. Turning to another brief cleanup issue on
 10 noninfringement, yesterday, when we were discussing the
 11 '592 patent, the not touching the body patent, you
 12 discussed I believe having the opportunity to use the
 13 probes in a cadaver's shoulder?
 14 A. Yes.
 15 Q. I think you used the word procedure when you
 16 described that. What did you mean by procedure?
 17 A. I meant that I was performing the method that was
 18 similar to the steps in the claim.
 19 Q. What is the method of '592, what are those steps?
 20 A. Summarily speaking, you position an active
 21 electrode either touching the tissue or in proximity to
 22 the tissue.
 23 Q. That's step one?
 24 A. That's step one. And step two is you position the
 25 return electrode, so it's not touching the tissue -- not

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1 touching the body, I should say. That's step two.
 2 And step three is you apply the energy to
 3 the active electrode.
 4 Q. How do you know that those are the three steps of
 5 the '592 method?
 6 A. That's basically what is in the claims.
 7 Q. Has the Court provided us any additional guidance
 8 since yesterday about the meaning of those claim terms?
 9 A. Yes.
 10 MR. MARSDEN: Gary, can we put up the Court's
 11 jury instruction on this?
 12 MR. BOBROW: Your Honor, I don't believe this
 13 is your jury instruction, in the sense that I thought
 14 those were still under consideration. I don't know that
 15 it is appropriate to show that though this witness.
 16 THE COURT: My jury instruction is going to
 17 be consistent with my memorandum opinion. So none of
 18 this should be different. If this is consistent with my
 19 memorandum opinion, then this is fine.
 20 MR. MARSDEN: Thank you, your Honor.
 21 Gary, if you could zoom in on Paragraph No. 3...
 22 BY MR. MARSDEN:
 23 Q. Dr. Taylor, I believe we discussed the first sentence
 24 of this paragraph several times during the course of the
 25 trial?

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1 A. That's correct.
 2 Q. Not touching, not contacting the body at all. Do
 3 the additional sentences that appear in Paragraph 3 change
 4 your opinion regarding whether or not there is infringement
 5 of the '592 patent?
 6 A. No, it does not. It basically strengthens my
 7 opinion.
 8 Q. Why does it strengthen your opinion?
 9 A. Well, I think I meant makes it abundantly clear
 10 that the claim construction doesn't have any time
 11 limitations. That's number one. That's in the second
 12 sentence, the claimed method does not contain any time
 13 limitations.
 14 And the last sentence says that the claimed
 15 method is performed when each of the three steps has
 16 been completed. So I think that also strengthens my
 17 position.
 18 Q. Thank you very much.
 19 MR. MARSDEN: Ladies and gentlemen of the jury,
 20 we are now going to turn to the issue of invalidity. I
 21 will apologize in advance that we are going to be moving
 22 through this very quickly. You will have these
 23 references with you in the jury room for your deliberations.
 24 Fortunately, many of the arguments relate to pictures or
 25 figures that are in the patents. So I think you will be

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1 able to find them relatively easily when you are in the
 2 jury room.
 3 But I do apologize in advance, because we have
 4 time limits and we are going to move through this material
 5 quite quickly this morning with Dr. Taylor.
 6 BY MR. MARSDEN:
 7 Q. Dr. Taylor, now turning to this question of
 8 invalidity of the asserted claims, do you have an opinion
 9 as to whether the asserted claims of the ArthroCare patents
 10 are invalid?
 11 A. Yes, I do.
 12 Q. What is your opinion?
 13 A. My opinion is that the claims are invalid.
 14 Q. What is the basis for your opinion?
 15 A. The basis for my opinion is that there is prior art
 16 or prior information that was published prior to these
 17 patents that contains all the essential elements of the
 18 claims.
 19 Q. Does that mean someone else did it first?
 20 A. Yes. That's another way of putting it.
 21 Q. I think we also heard the term anticipation in
 22 this trial. Is that another word for this?
 23 A. That is another way of putting that. The prior
 24 art anticipates the claims that are asserted.
 25 Q. How do you determine for purposes of validity

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1 whether someone else did it first?

2 A. Essentially, you -- I guess you can consider it to

3 be an infringement analysis in reverse. Yesterday, I

4 went through all the different elements of each of the

5 claims, and described how the Smith & Nephew products did

6 not infringe. In essence, what I did is an analysis in

7 reverse, by the fact that I looked at all the different

8 prior art to see whether or not the prior art taught the

9 various elements of the claims that are being asserted.

10 Q. Did you consider what level of proof is required

11 to prove anticipation?

12 A. Yes. I was looking for proof in the prior art that

13 the prior art actually taught all the essential elements

14 in a very highly probable, very clear and convincing

15 manner, so it would be evident to me, someone that is

16 skilled in the art, and evident to almost anybody that

17 the prior art taught that essential element.

18 Q. You mentioned there are several references that you

19 relied on. What are those references?

20 A. Actually, those references are shown right there on

21 that board. There are six references?

22 If you take a look, since it is a timeline as

23 well as a pictorial of the various references, you will

24 see that the earliest date of the ArthroCare invention is

25 around 1993. Then there are six references going back

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1 in time. Dr. Manwaring's patent, which is in 1992, the

2 '138 patent. 1987, the Pao '499 patent. 1985, the

3 Slager articles. 1983, the Doss '007 patent. 1983 the

4 Roos '198 patent. And 1976 the Elsasser and Roos articles.

5 Q. Let's turn first to your analysis of the '536, the

6 fluid supply patent. Can you first, maybe Ms. Prescott

7 can assist us here. Do you have a board to discuss the

8 '536 patent claims?

9 A. Yes. That is the first board on the right of the

10 board I just referenced.

11 Q. With reference to that board can you remind the jury

12 which claims are at issue in the '536 patent?

13 A. Yes. The claims that are at issue in the '536

14 patent are the dependent Claims 46, 47 and 56. As I

15 mentioned yesterday, in order to analyze those claims,

16 you have to first analyze the independent claim, which is

17 Claim 45.

18 Q. Let's start with Claim 45, then. Have you formed

19 an opinion as to the validity of Claim 45?

20 A. Yes, I have.

21 Q. What is that opinion?

22 A. My opinion is that Claim 45 is invalid.

23 Q. What is the basis for your opinion?

24 A. The basis for my opinion is that I analyzed the

25 prior art, the four articles that are referenced there on

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1 the board. Typically what we are doing is showing on the

2 left-hand side the claims, and then the articles or

3 patents that are applied on the right-hand side of the

4 board. In this case, it is the Elsasser and Roos article,

5 the Roos '198 patent, the Doss '007 patent and the Pao

6 '499 patent.

7 Q. Let's start with the Elsasser and Roos article then.

8 If you could turn to DTX-59-A and 59-B in your notebook,

9 can you identify those for the record?

10 A. Okay. DTX-59A is the original German publication.

11 DTX-59B is the English translation of that publication.

12 MR. MARSDEN: Your Honor, I move the admission

13 of DTX-59-A and 59-B.

14 MR. BOBROW: No objection.

15 THE COURT: Thank you.

16 *** (Defendant's Exhibits No. DTX-59-A and 59-B

17 was received into evidence.)

18 BY MR. MARSDEN:

19 Q. Can you tell the jury first just generally what the

20 Elsasser and Roos article describes and have you prepared

21 a slide for this?

22 A. Yes, I have.

23 Gary, can I have that slide?

24 The Elsasser and Roos article describes a

25 bipolar electrosurgical device for the treatment of

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1 prostate and bladder tissue, commonly known as the

2 procedure of a T-U-R-P or a TURP.

3 Q. Now, have you performed an element-by-element

4 comparison of the teachings of the Elsasser and Roos

5 article to the asserted claims of the '536 patent?

6 A. Yes.

7 Q. Have you prepared any slides to assist you in

8 illustrating to the jury what that analysis was?

9 A. Yes, I do. There is a series of slides.

10 Gary, if you can go to the next one?

11 Essentially what I did here, as I mentioned

12 before, I started with the independent Claim 45. The way

13 these things are laid out, on the left-hand side of the

14 screen we have the claim, and we will highlight the

15 particular element that I was analyzing for that

16 particular slide.

17 On the right-hand side we will have a figure, *

18 generally some text that is in the actual article, and

19 generally at the top of that column will be the actual

20 location of that text.

21 So in this case, the element that is being

22 analyzed is the high-frequency power supply. The article

23 specifically mentioned we connected the cutting loop and

24 the neutral electrode to a high frequency surgical unit.

25 That element is satisfied.

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1 Q. Before you go any further, Dr. Taylor...

2 MR. MARSDEN: Let me just tell the jury that

3 these slides that you are seeing are demonstrative

4 evidence and you will not have those in the jury room.

5 If there is any information on these slides that you think

6 is important or want to make a note of, you might want to

7 do it as we go you. You will have the Elsasser and Roos

8 article, but not these slides in the jury room.

9 THE WITNESS: Actually, before I go through

10 the next sequence, the resectroscope consists of four

11 elements. There is an outer sheath which is generally

12 where the irrigation comes in. There is a telescope.

13 Mr. Sparks showed you an arthroscope. Basically the

14 telescope is a longer version of that. It is an

15 endoscope.

16 There is a working element which is actually

17 used to remove the cutting electrode, so it actually uses

18 the working element, sort of a pistol grip mechanism, you

19 move your thumb up and down, and that moves the electrode.

20 And the electrode is shown right there, right at the tip.

21 So we can go to the next overhead.

22 The next element there is an electrosurgical

23 probe comprising a shaft having a proximal and distal end.

24 That is highlighted there. The article specifically

25 mentions using a conventional resectroscope, which is what

Page 1298

1 I just described to you.

2 BY MR. MARSDEN:

3 Q. Just to complete the process here --

4 A. Katie -- I am sorry, I ignored her. She is actually

5 doing the checkmark, so you understand that each of the

6 elements have been identified in the article, or patent.

7 Q. Thank you.

8 A. So in this case, this element has been satisfied by

9 this reference as part, this part of the article.

10 Next, please.

11 The next settlement is an electrode terminal

12 disposed near the distal end. That is satisfied by the

13 resectroscope's cutting loop.

14 Q. It is there?

15 A. Right there, right.

16 So that element is satisfied.

17 Next. A connector near the proximal end of

18 the shaft electrically coupling the electrode terminal to

19 the electrosurgical power supply. Actually, there is two

20 connectors, the one that is shown is right there. There

21 is another one that you can't see that would be right

22 about there.

23 So that element is satisfied.

24 Next.

25 The next element is a return electrode

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1 electrically coupled to the electrosurgical supply. The

2 return electrode is this little metal band here, and we

3 have already mentioned that is coupled to the high-

4 frequency surgical unit. So that element is satisfied.

5 Next.

6 The last element is an electrically conducting

7 fluid supply directed at the target tissue, which allows

8 current flow path between the return electrode and the

9 electrode terminal. The article specifically has quotes

10 in it that indicates that that is the case. So that

11 element is satisfied.

12 Q. On Claim 45, to sum up, do you have an opinion as

13 to whether Claim 45 of the '536 patent is anticipated by

14 the Elsasser and Roos article?

15 A. Yes, I have an opinion, and it is anticipated.

16 Q. Can you move onto the next claim, please?

17 Next.

18 The next claim is a dependent claim, as I

19 mentioned before. It requires that it satisfies all the

20 elements of Claim 45. And additionally, the return

21 electrode forms a portion of the electrosurgical shaft.

22 And that is the case, given the text there, indicating

23 that the neutral electrode, which is another word for

24 return electrode, is incorporated into the end of the

25 resectroscope shaft. So that element is satisfied.

Page 1300

1 Q. Do you have an opinion as to whether Claim 46 of

2 '536 patent is anticipated by the Elsasser and Roos

3 article?

4 A. Yes, I do, and it is anticipated.

5 Q. Did you consider the Elsasser and Roos article in

6 connection with any other claims of the '536 patent?

7 A. Yes. The next claim is Claim 47. Next, please.

8 Q. That is Claim 56; correct?

9 A. I am sorry. 56.

10 And this claim, you have to have all the

11 elements of Claim 45, plus you have to satisfy one of the

12 target roots, which is body locations there, including

13 the abdominal cavity, thoracic cavity, et cetera. The

14 resectroscope is used in resections of the prostate or

15 bladder, which is in the abdominal cavity.

16 Q. Do you have an opinion as to whether Claim 56 of

17 the '536 patent is anticipated by the Elsasser and Roos

18 article?

19 A. Yes, I do. And it is.

20 Q. Thank you. We skipped over Claim 47. Are there

21 other references that you discuss that anticipate Claim

22 47?

23 A. Yes, there are.

24 Q. I think you have said you also relied on the Roos

25 '198 patent; is that correct?

1 A. That's correct.
 2 Q. First of all, can you turn in your book to DTX-11
 3 and identify that, please?
 4 A. DTX-11 is the Roos '198 patent.
 5 MR. MARSDEN: Your Honor, I move the admission
 6 of DTX-11.
 7 MR. BOBROW: No objection.
 8 THE COURT: Thank you.
 9 *** (Defendant's Exhibit No. 11 was received into
 10 evidence.)
 11 BY MR. MARSDEN:
 12 Q. Dr. Taylor, have you prepared a slide to tell the
 13 jury what the Roos '198 patent is about?
 14 A. Yes, I have.
 15 Gary? Thank you.
 16 The Roos '198 patent basically follows up on
 17 the work that Doctors Elsasser and Roos did in their
 18 article and it's a bipolar electrosurgical device for the
 19 treatment of prostate and bladder tissue, commonly known
 20 as TURP.
 21 Q. What does TURP stand for?
 22 A. Transurethro resection of the prostate.
 23 Q. Have you done an element-by-element comparison of
 24 the teachings of the Roos '198 with the claims of the
 25 '536 patent?

1 A. Yes, I have.
 2 Q. Have you prepared some slides to illustrate that?
 3 A. Yes, I have. Gary?
 4 Thank you.
 5 Using the same format that we have used in
 6 prior slides, a high-frequency power supply is indicated
 7 in the patent. Column 7, Lines 5 through 7. It
 8 basically says the device is connected to a high-frequency
 9 generator, which is not shown in these figures. So that
 10 element is satisfied.
 11 Next.
 12 The next element is an electrosurgical probe
 13 having a shaft, a proximal and distal end. That is
 14 diagrammatically shown in Figures 7 and 8. That element
 15 is satisfied.
 16 Next. The next element is an electrode terminal
 17 disposed near the distal end. The electrical terminal is
 18 basically the cutting loop. That is described in Column 6,
 19 Lines 67 and 68 and also in these figures. So that element
 20 is satisfied.
 21 Next.
 22 A connector, requires a connector, coupling
 23 the shaft to the electrosurgical power supply.
 24 And that element is satisfied by Figure 7 and
 25 the text in Column 7, Lines 1 through 5. And also in

1 Claim 1, as described here in this text.
 2 So that element is satisfied.
 3 Next.
 4 It requires a return electrode electrically
 5 coupled to the generator. We already described that. The
 6 return electrode, or the neutral electrode is indicated by
 7 this yellow area. So that element is satisfied.
 8 Next.
 9 It also requires an electrically conducting
 10 fluid supply, directed to the target site and generating
 11 current, flow path between the active and return electrode.
 12 That is diagrammatically shown here in Figures 7 and 8 and
 13 also specifically called out in Claim 1, basically the
 14 last line in Claim 1. So that element is satisfied.
 15 Q. Just to pause on this one for a moment, that
 16 language that is quoted below the drawing comes from Claim
 17 1 of the Roos '198 patent?
 18 A. That's correct.
 19 Q. That is where you found support for the electrically
 20 conducted fluid limitation?
 21 A. Yes.
 22 Q. To sum up, on Claim 45, do you have an opinion, Dr.
 23 Taylor, as to whether Claim 45 of the '536 patent is
 24 anticipated by the Roos '198 patent?
 25 A. Yes, I do. And it is.

1 ---
 2 Q. Did you look at the '198 patent to see if the '536
 3 patent is anticipated by the Roos '198 patent?
 4 A. Yes, I did. That's indicated in the next overhead.
 5 Claims 46 is anticipated. Claim 46 requires all the
 6 elements of Claim 45. Additionally, the return electrode
 7 forms a portion of the shaft of the probe and, as I
 8 previously indicated, my Figure 7 and Figure 8, that is
 9 the case. So that element is satisfied.
 10 Q. Do you have an opinion as to whether Claim 46 of
 11 the '536 patent is anticipated by the Roos '198 patent?
 12 A. Yes, I do. And it is.
 13 Q. Did you look at any other claims of the '536?
 14 A. Yes, and the next overhead shows that. Claim 47
 15 requires all the elements of Claim 46, which is dependent
 16 on Claim 45, and requires that you have an insulating
 17 member circumscribing the electrode. Insulating member
 18 is shown there. That is identified as 35.
 19 And is there an overhead? The next one, Gary?
 20 Go back. Go back. Sorry.
 21 It also requires that return electrode is
 22 sufficiently spaced from the electrode terminal, between
 23 the return electrode and the patient's tissue. That's the
 24 case. So all the elements are satisfied.
 25 Q. Do you have an opinion as to whether Claim 47 of

Page 1305

1 the '536 patent is anticipated by the Roos '198 patent?
 2 A. Yes, I do. And it is.
 3 Q. Did you look at any other claims of the '536?
 4 A. Yes, and I guess I already tipped my hand here. I
 5 looked at Claim 56 and Claim 56 requires all the elements
 6 of Claim 45 and, in addition, it has to have a target site
 7 at the various locations indicated -- abdominal cavity,
 8 thoracic cavity, et cetera. Once again, this device is to
 9 be used for the resection of bladder and prostate tissue,
 10 and, therefore, satisfies that element.
 11 Q. Thank you, sir.
 12 Do you have an opinion as to whether Claim 56
 13 of the '536 patent is anticipated by the Roos '198 patent?
 14 A. Yes, I do, and it is.
 15 Q. I believe you also considered the Doss '007 in
 16 connection with the '536 patent; is that correct?
 17 A. That's correct.
 18 Q. Can you turn to DTX-17 in your book, please, and
 19 identify that?
 20 A. DTX-17 is a patent, the Doss '007 patent.
 21 MR. MARSDEN: We move the admission of DTX-17,
 22 please.
 23 MR. BOBROW: No objection.
 24 THE COURT: Thank you.
 25 THE DEPUTY CLERK: So marked.

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1 *** (Defendant's Exhibit No. 17 was received into
 2 evidence.).
 3 BY MR. MARSDEN:
 4 Q. Dr. Taylor, had you prepared a graphic to describe
 5 what the Doss '007 is about?
 6 A. Yes, I have. Thank you, Gary.
 7 The Doss '007 patent is a bipolar
 8 electrosurgical probe which includes an integrated supply
 9 of saline for the treatment of corneal tissue.
 10 Q. Have you done an element-by-element comparison of
 11 the teachings of the Doss '007 patent to the claims of
 12 the '536 patent?
 13 A. Yes I have.
 14 Q. Have you prepared slides to illustrate your opinions?
 15 A. Yes, I have. And, once again, looking at the claims
 16 of the patent, Claim 45 requires as one of the elements a
 17 high-frequency power supply. Column 3, Lines 29 to 38,
 18 specifically mentions a high-frequency power supply.
 19 Q. So that is element satisfied?
 20 A. That element is satisfied, sir.
 21 Moving to the next overhead, this element
 22 requires an electrosurgical probe, having a shaft having
 23 a proximal end and distal end. As you can see, there
 24 is a shaft, there is a distal and a proximal end. And
 25 that is described by the text, Column 5, Lines 27 to

Page 1307

1 through 31. Therefore, that element is satisfied.
 2 Next.
 3 The next element is an electrode terminal
 4 disposed near the distal end. And this is the active
 5 electrode or electrical terminal. It's described by the
 6 text indicated there and is shown in the red there. So
 7 that element is satisfied.
 8 Also, requires a connector connecting the
 9 electrode terminal to the electrosurgical power supply.
 10 The text indicated in Column 3, Lines 30 through 34,
 11 indicates that that is the case. So that element is
 12 satisfied.
 13 Next.
 14 Requires a return electrode electrically
 15 coupled to the electrosurgical power supply. This diagram
 16 shows the return electrode indicated highlighted in yellow.
 17 And it's specifically referenced in the text in Column 5,
 18 Lines 27 through 31. Therefore, that element is satisfied.
 19 Next.
 20 The last element is an electrically conducting
 21 fluid supply for generating a current flow path between the
 22 return electrode and the electrode terminal.
 23 The blue indicates the flow of saline solution
 24 into the device. The text reference is here, Column 3,
 25 Lines 48 through 54. So that element is satisfied.

Page 1308

1 Q. Before you leave this, so the record is clear, was
 2 this coloring in the original figures?
 3 A. No, it was not. It was coloring that was added by
 4 me.
 5 Q. Was that to illustrate?
 6 A. That was basically to illustrate -- we tried to be
 7 consistent, so blue is water. I guess blue looks like
 8 water, right? So that's what we used here.
 9 Q. Do you have an opinion, then, as to whether Claim 45
 10 of the '536 patent is anticipated by the Doss '007 patent?
 11 A. Yes, I do. And it is.
 12 Q. Did you consider the Doss reference in connection
 13 with any other claims of the '536 patent?
 14 A. Yes, and the next overhead shows that.
 15 Basically, Claim 46, as I indicated before,
 16 requires that you have all the elements of Claim 45 and
 17 also that the return electrode forms a portion of the
 18 shaft of the electrosurgical probe. And that is indicated
 19 in Column 5, Lines 27 through 31. So that element is
 20 satisfied.
 21 Q. Do you have an opinion as to whether Claim 46 of
 22 the '536 patent is anticipated by the Doss '007 patent?
 23 A. Yes, I do. And it is.
 24 Q. And did you look at any other claims of the '536?
 25 A. Yes. The next overhead shows Claim 47 which, once

Page 1309

1 again, requires that all the elements of Claim 46 and all
 2 the elements of Claim 45 are also satisfied. And further
 3 that you have an insulating member circumscribing the
 4 return electrode, and that insulating member is the housing
 5 here which is shown in blew.
 6 Q. We just violating our color-coding?
 7 A. Yes, we did. I'm wrong. Sorry.
 8 I think the next one, next overhead shows the
 9 return electrode once again in yellow. And so the elements
 10 of this claim are also satisfied.
 11 Q. Do you have an opinion as to whether Claim 47 of
 12 the '536 patent is anticipated by the Doss '007 patent?
 13 A. Yes, I do. And it is.
 14 Q. Did you look at any other claims of the '536?
 15 A. Yes, I did.
 16 And the next overhead. Oops.
 17 Q. Actually, maybe that is it on Doss.
 18 A. That may be it on Doss. I'm sorry.
 19 Q. Sorry. Okay. You mentioned also the Paul (phonetic)
 20 or Pao '449 patent. Did you consider that in your
 21 analysis of the '536 patent?
 22 A. Yes, I did.
 23 Q. Can you turn to -- find the right exhibit number.
 24 I'm ahead of myself.
 25 A. I think it's DTX-21.

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1 Q. Yes. DTX-21 in your notebook. Can you identify
 2 that, please?
 3 A. Yes. This is the Pao '449 patent.
 4 MR. MARSDEN: Move the admission of DTX-21,
 5 your Honor.
 6 MR. BOBROW: No objection.
 7 THE COURT: Thank you.
 8 *** (Defendant's Exhibit No. 21 was received into
 9 evidence.)
 10 BY MR. MARSDEN:
 11 Q. Have you prepared a summary slide? Can you describe
 12 to the jury the Pao '449 patent?
 13 A. Yes. The Pao '499 patent describes a bipolar
 14 electrosurgical probe with an integrated saline supply
 15 for the treatment of eyes, ears, noses and other
 16 microsurgical applications.
 17 Q. Have you prepared or did you conduct an element-by-
 18 element comparison of the teachings of the Pao '499 patent
 19 with the claims of the '536 patent?
 20 A. Yes, I have.
 21 Q. Did you prepare slides to illustrate that?
 22 A. Yes, the next one starts off the sequence. Once
 23 again, the high-frequency power supply is referenced in
 24 the Pao patent in Columns 7, Lines 35/36, basically
 25 saying connected to the output of a high-frequency

Page 1311

1 bipolar power supply. So that element is anticipated or
 2 satisfied. Sorry.
 3 The next element is electrosurgical probe
 4 comprising a shaft having a proximal end and a distal
 5 end. This is the distal end. I guess you consider the
 6 handle to be the proximal end and that specifically
 7 references in Column 7, Lines 6 to 9 and 13 to 30. So
 8 that element is satisfied.
 9 The next element is an electrode terminal
 10 disposed near the distal end. That is the active
 11 electrode shown in red here and described in the text in
 12 Column 7, Lines 15 to 19. So that element is satisfied.
 13 Next element is a connector near the proximal
 14 end of the shaft. Connector is shown in green here.
 15 Those little two pins. Referred to in the text, Column
 16 7, Lines 13 to 19. And that is satisfied.
 17 Next.
 18 The return electrode is shown in yellow. It's
 19 the outer electrode. And the text reference is Column 7,
 20 Lines 13 to 19 and 25 to 37. So that element is satisfied.
 21 And, lastly, an electrically conducting fluid
 22 supply. The fluid supply comes in through this connector
 23 and flows down the lumen of the inner electrode of the
 24 active electrode, that is described in this text reference.
 25 So that element is satisfied.

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1 Q. Is that also described in the text as an electrolytic
 2 irrigating fluid such as saline?
 3 A. Yes, it is.
 4 Q. Do you then have an opinion as to whether Claim 45
 5 of the '536 patent is anticipated by the Pao '499 patent?
 6 A. Yes, I have an opinion. And it is anticipated.
 7 Q. Did you compare the Pao '499 patent teachings to any
 8 claims of the '536 patent?
 9 A. Yes, I did. Next slide, please.
 10 Claim 46 requires all the elements of Claim 45
 11 along with return electrode forms a portion of the shaft.
 12 And, as I previously indicated, that is the case of the
 13 return electrode, as shown here in yellow.
 14 Q. So did you have an opinion as to whether Claim 46
 15 of the '536 patent is anticipated by the Pao '499 patent?
 16 A. Yes, I have. And it is.
 17 Q. Did you consider any other claims?
 18 A. Yes.
 19 Next overhead, please.
 20 Claim 56 requires the elements of Claim 45,
 21 along with one of the body parts indicated in the list
 22 here, and this particular patent specifically mentions
 23 nasal passages and ear canals. So that element is
 24 satisfied.
 25 Q. So do you have an opinion as to whether Claim 56 of

1 the '536 patent is anticipated by the Pao '499 patent?
 2 A. Yes, I do. And it is.
 3 Q. I think that concludes our discussion of the '536
 4 patent.
 5 A. I believe so.
 6 Q. Okay. Can we turn now --
 7 A. I think we've done pretty well.
 8 Q. We'll turn now to the '882 patent. And did you
 9 prepare a board for the '882 patent?
 10 A. Yes, I did.
 11 Q. This is the compilation of multi-electrode patent?
 12 A. Yes.
 13 Q. First, with reference to the board, can you remind
 14 the jury which claims you analyzed for the '882 patent?
 15 A. Well, the asserted claims are Claims 13, 17 and 54,
 16 but they require that you further analyze or consider
 17 first Claim 1. So I basically considered four claims.
 18 Q. Do you have any opinion as to whether the asserted
 19 claims of the '882 patent are invalid?
 20 A. Yes, I do.
 21 Q. What is that opinion?
 22 A. That opinion is they're invalid.
 23 Q. What is the basis for your opinion?
 24 A. My basis for the opinion is there are two
 25 references, the Slager article and the Manwaring '138

1 patent, that anticipates those claims.
 2 Q. Were you here earlier this week when Dr. Manwaring
 3 testified?
 4 A. Yes.
 5 Q. Did you hear Dr. Manwaring's testimony that the '138
 6 patent discloses all the limitations of Claims 1, 13, and
 7 54 of the '882 patent?
 8 A. Yes, I did.
 9 Q. Do you agree with his analysis?
 10 A. Yes, I do.
 11 Q. Have you made your own element-by-element analysis?
 12 A. Yes, I have.
 13 Q. Have you prepared slides to illustrate that?
 14 A. Yes. And, Gary, the next sequence.
 15 Here we have what we call a rainbow slide, and
 16 it basically shows, this is the method patent. I hope
 17 everyone realizes this is a method patent. It basically
 18 outlines the steps required to perform the method, and
 19 the first step is providing an electrode terminal, which
 20 is shown here in red, and a return electrode electrically
 21 coupled to a high-frequency voltage source. Dr. Manwaring
 22 specifically mentioned in his testimony that the return
 23 electrode is on the outside of the patient. This is
 24 monopolar electrosurgery. So that is step number one.
 25 Step number two is positioning the active

1 electrode in close proximity to the target site in the
 2 presence of an electrically conducting fluid.
 3 Electrically conducting fluid is here, the tissue is here.
 4 The active electrode has been positioned close to the
 5 target site and the last step is applying a high-frequency
 6 voltage between the electrode terminal and the return
 7 electrode in such a manner you vaporize the fluid and
 8 that you induce a spark, discharge of energy to the
 9 target site. And that is indicated here by the cross-
 10 hatched yellow. So all the elements of this have been
 11 satisfied.
 12 Q. Did you also hear Dr. Manwaring's testimony about
 13 this element when he was here testifying earlier this
 14 week?
 15 A. Yes, I did.
 16 Q. Does that support your conclusion?
 17 A. Yes, it does.
 18 Q. Do you have an opinion of whether Claim 1 of the
 19 '882 patent is anticipated by the Manwaring '138 patent?
 20 A. Yes, my opinion is that it is.
 21 Q. You also mentioned I think that this is a monopolar
 22 device?
 23 A. Right.
 24 Q. Were you here when Mr. Eggers testified about this
 25 claim?

1 A. Yes.
 2 Q. And did you hear his testimony that this claim would
 3 cover a monopolar device?
 4 A. Yes.
 5 Q. Did you consider the Manwaring '138 patent in
 6 connection with any other claims of the '882 patent?
 7 A. Yes. Can we go to the next slide?
 8 Claim 13 requires that you practice the steps
 9 of Claim 1, but also that a portion of the energy is
 10 induced basically in the form of protons.
 11 Dr. Manwaring basically mentioned that when you
 12 have RF sparking, which is actually referenced in the text
 13 in Column 6, Lines 50 to 63, that you generate protons as
 14 well as other photons.
 15 Q. Do you have an opinion as to whether Claim 13 of the
 16 '882 patent is anticipated by the Manwaring '138 patent?
 17 A. Yes, I do and it is.
 18 Q. Did you consider any other claims of the '882 patent?
 19 A. Yes. Next, please.
 20 Claim 54 requires method of claims, Claim 1,
 21 and further basically suctioning fluid from the target site
 22 or having a suction lumen to be able to do that.
 23 The text in the patent Column 7, Lines 26 to
 24 31, indicates that there is an embodiment of his invention
 25 that does that.

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1 MR. MARSDEN: I'm sorry. Could you all see
2 that, the bottom of the slide?
3 JUROR NO. 4: Yes.
4 BY MR. MARSDEN:
5 Q. Is that here in the text?
6 A. Yes.
7 Q. Do you have an opinion as to whether Claim 54 of the
8 '882 patent is anticipated by the Manwaring '138 patent?
9 A. Yes, I do and it is.
10 Q. I think you indicated you also considered another
11 reference in connection with the '882 patent; is that
12 correct?
13 A. That's right. Excuse me. That's correct.
14 Q. Could you first turn to DTX-65 in your notebook and
15 identify that, please?
16 A. DTX-65 is an article written by Slager regarding
17 vaporization of tissue by spark.
18 MR. MARSDEN: Move the admission of DTX-65.
19 MR. BOBROW: No objection.
20 THE COURT: Thank you.
21 THE DEPUTY CLERK: So marked.
22 *** (Defendant's Exhibit No. 65 was received into
23 evidence.)
24 BY MR. MARSDEN:
25 Q. Have you prepared a summary slide to described what

Page 1318

1 the Slager article teaches?
2 A. Yes, I have.
3 Q. Gary is improvising here for us.
4 A. Okay. Basically, this article describes an
5 electrosurgical probe for vaporizing arterial tissue.
6 Q. Have you performed an element -- thank you, Gary.
7 Have you performed an element-by-element
8 analysis of the teachings of the Slager -- comparing the
9 teachings of the Slager article to the claims of the '882
10 patent?
11 A. Yes, I have.
12 Q. Have you prepared some slides to illustrate your
13 opinions?
14 A. Yes, I have.
15 MR. MARSDEN: Give Gary a second here.
16 THE WITNESS: Okay. Once again, the very
17 steps for performing this, this method were outlined on
18 the left and the first step is providing an electrode
19 terminal, shown here, coupled to a generator. And that
20 is shown by the diagram as well as the text here. So this
21 element or step is satisfied.
22 Next one is positioning the electrode terminal
23 in close proximity to the target site in the presence of
24 an electrically conducting fluid. That is described in
25 the article at Pages 1383 and 1384. Basically, the spark

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1 electrode with that surface area, immersed in saline. So
2 that element is satisfied.
3 The next element is applying high-frequency
4 voltage to vaporize the fluid and to induce the discharge
5 of energy and sparking. And that is very aptly described
6 in this particular diagram. We have the electrode, we have
7 steam, we have spark, we've got tissue. So that element is
8 satisfied.
9 BY MR. MARSDEN:
10 Q. I'm sorry. Before you leave that slide, do you have
11 an opinion as to whether Claim 1 of the '882 patent is
12 anticipated by the Slager article?
13 A. Yes, I do. And it is.
14 Gary, the next slide. Sorry.
15 The next claim is Claim 13. This claim
16 requires practice, method of Claim 1 and also, you have
17 protons. And, as I described in the prior reference,
18 sparks generate protons and this article specifically
19 mentions sparks jumping. I should say sparks in aqueous
20 solution, making protons.
21 Q. Do you have an opinion, then, as to whether Claim 13
22 of the '882 patent is anticipated by the Slager article?
23 A. Yes, I do. And it is.
24 Q. Did you consider any other claims of the '882 patent?
25 A. Yes. Next.

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1 Claim 17 requires practicing the method of
2 Claim 1, additionally having at least 200 volts, high-
3 frequency voltage. The reference on Page 1383
4 specifically mentions 1200 volts at that frequency. So
5 that element is satisfied.
6 Q. Do you have an opinion as whether Claim 17 of the
7 '882 patent is anticipated by the Slager article?
8 A. Yes, I do. And it is.
9 Q. Did you consider any other claims of the '882 patent?
10 A. Yes. Next.
11 Claim 54 requires the method of Claim 1 as
12 well as basically having the ability to suction at the
13 target site. And the reference in page 1386 specifically
14 mentions being able to suction the gas bubbles. So that
15 element is satisfied.
16 Q. Thank you. Dr. Taylor, do you have an opinion as
17 to whether Claim 54 of the '882 patent is anticipated by
18 the Slager article?
19 A. Yes, I do. And it is.
20 Q. Did you hear any testimony here at trial, during
21 trial, that supports or confirms your opinions of
22 anticipation of the claims of the '882 patent?
23 A. Yes.
24 Q. Did you see DTX-600, the manual of operations for
25 System 970 during this trial?

1 A. Oh, yes. It's not here, is it?

2 Q. I think we can call it up for you.

3 MR. MARSDEN: Gary, can you call up DTX-600
4 please?

5 MR. BOBROW: Your Honor, before we get into
6 this, I believe this is beyond the scope. I don't believe
7 there is any opinion that this witness has offered in his
8 expert report about the relationship between claims and
9 the 970 operator's manual.

10 MR. MARSDEN: Your Honor, his expert report
11 referred to the 510-K which included the manual and, of
12 course, also reserved the right to address any evidence
13 as it came up at trial. But he expressly referred to the
14 510-K in his expert report and the 510-K has included, as
15 part of the submission, this manual.

16 THE COURT: Well, I guess the point is if the
17 analysis he intend to give today wasn't included in his
18 report, it doesn't come in today.

19 MR. MARSDEN: Your Honor, I believe it is. I
20 can hand up his report.

21 (Documents passed forward.)

22 MR. BOBROW: What page?

23 MS. MACFERRIN: Page 11.

24 MR. BOBROW: Your Honor, there is a reference
25 there to the 970, but this is the question of enablement.

1 It has nothing to do with the question of anticipation.

2 Right now, what the witness is trying to do is show that
3 this is in some way anticipated, not on a question of
4 enablement. I believe it's clearly beyond the scope.

5 MR. MARSDEN: We will be relying on it for
6 both issues and we will be address the nonenablement issue
7 next.

8 THE COURT: I don't see that it's -- I don't
9 see in the report if it's limited to enablement. So I'll
10 allow the testimony.

11 MR. MARSDEN: Thank you, your Honor.
12 Gary, could you pull up Page 14, please?

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1

2 BY MR. MARSDEN:

3 Q. Were you in court when I asked Mr. Baker about this
4 description of the principle of operation of the System
5 970?

6 A. Yes, I was.

7 MR. MARSDEN: If you could blow up the first
8 paragraph, please, Gary...

9 BY MR. MARSDEN:

10 Q. Do you have any opinion as to whether ArthroCare's
11 description of the mode of operation or the principle of
12 operation of its System 970 is consistent with the
13 opinion that you have offered here in court in this
14 morning?

15 A. Yes. Essentially, the opinion that I have, I think
16 what is confirmed here in the text, is that the system
17 operates in the same manner as a conventional
18 electro-surgical system, use of arcing and such, that is
19 described by what is known as prior art, stuff that has
20 been known for a long time.

21 Q. Thank you, Dr. Taylor. Do you have any other
22 opinions regarding the validity of the '882 other than
23 anticipation, which we have discussed?

24 A. When you say other opinions, could you be more
25 specific?

1 Q. Right. Do you have any other basis for believing
2 that the Claims of the '882 patent are invalid?

3 A. I am sorry, I am blanking on this.

4 Q. Sure.

5 A. When you say other opinions, do you mean other facts?

6 Q. Do you understand that ArthroCare contends that what
7 is taught in the '882 patent is a new phenomenon?

8 A. I see what you mean. No, it is not a new phenomenon.
9 It's been anticipated, it's been described in the prior
10 art.

11 Q. If, in fact, it is a new phenomenon, do you believe
12 there is an additional basis for the '882 patent to be
13 found invalid?

14 A. Yes. One of the concerns I have -- I think I
15 expressed this yesterday -- is that if the '882 patent is
16 found to be invalid, then a large number of the devices
17 that I have developed and, for that matter, a large number
18 of the devices that have been developed in electro-surgery
19 will infringe, because of the fact that what they are
20 claiming is extremely broad.

21 Q. Does the '882 patent teach anything about how to
22 achieve a new phenomenon that is different than the
23 principle of operation of conventional electro-surgical
24 devices?

25 A. No, it doesn't. I was perplexed and, frankly, am

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1 still perplexed about the overall phenomenon of Coblation.
 2 Q. And is that defense also sometimes called
 3 nonenablement?
 4 A. Yes, it is.
 5 Q. Do you have an opinion as to whether the claims of
 6 the '882 patent are enabled to the extent it claims a new
 7 phenomenon?
 8 A. Yes, I have an opinion.
 9 Q. What is that opinion?
 10 A. That it is not.
 11 Q. Thank you.

12 Let's turn, then, to the '592 patent, the last
 13 of the three patents.

14 Can you first locate the '592 patent in your
 15 binder?

16 I misspoke. I got ahead of myself. Have you
 17 prepared a board for the '592 patent?

18 A. Yes, I have.

19 Q. And first, can you remind the jury what claims are
 20 at issue in connection with the '592 patent?

21 A. Yes. There are actually two sets of claims. The
 22 first set is shown on the board. It's on the easel. The
 23 second set Katie is holding. The first set, the
 24 independent claim is Claim 1 and the dependent claims are
 25 3, 4, 11 and 21. The second set of claims, the independent

Page 1326

1 claim is Claim 23. The dependent claims are 26, 27, 32
 2 and 42.

3 Q. Let's start with the first set of claims first.
 4 Have you performed any analysis or reached any conclusions
 5 as to whether those claims are valid?

6 A. Yes, I have.

7 Q. What is your opinion?

8 A. My opinion is they are not.

9 Q. Why not?

10 A. They are anticipated in this first set of claims by
 11 Doss '007, and as indicated there.

12 Q. Have you prepared a series of -- first of all, have
 13 you done an element-by-element comparison of the teachings
 14 of the Doss '007 patent to the asserted claims we have up
 15 on the board of the '592 patent?

16 A. Yes, I have.

17 Q. Have you prepared some slides to illustrate that?

18 A. Yes.

19 Gary.

20 This particular patent, Claim 1, also has three
 21 steps. The first step is positioning an electrode terminal
 22 into at least close proximity with the target site. The
 23 Doss '007 patent, the active electrode is shown in the red
 24 here, described in the text there. This has to be done in
 25 the presence of electrically conductive fluid. So that

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1 element is satisfied.

2 As I mentioned, it has to be done in the
 3 presence of electrically conductive fluid. And the inlet
 4 for that fluid is shown here. The fluid path is shown in
 5 the blue. So that element is satisfied.

6 The next element or next step is positioning
 7 a return electrode such that a return electrode is not in
 8 contact with the body structure, and generate a current
 9 flow path between the active electrode and electrode
 10 terminal and the return electrode. The return electrode
 11 is shown here in the yellow, as you can see, the eye is
 12 down here. It is not in contact with the eye. That is
 13 described in the text, in Column 5, Lines 27 to 31, and
 14 also Column 3.

15 Q. You see a series of these illustrations. Can you
 16 tell us what the relationship is of Figure 7 and Figure 8
 17 is?

18 A. Sure. Figure 7 is a side view, sort of a
 19 cross-sectional side-view, of the device. And you see
 20 here the active electrode, the return electrode, fluid
 21 inlet path -- actually, the fluid inlet path goes this way
 22 and comes out that way. And then Figure 8 is an end view,
 23 if you will, of the probe, and it shows, you go from
 24 outside to in. The housing, insulation, lumen, return
 25 electrode, insulation, active electrode, and then the

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1 lumen for that.

2 Q. Thank you. Can you proceed, please?

3 So moving on, that step of the method is
 4 satisfied.

5 Lastly, you have to apply a high-frequency
 6 voltage to the electrode terminal between the electrode
 7 terminal and return electrode to generate a current flow
 8 path. And that is specifically mentioned in Column 3 and
 9 Column 5. That basically describes that reference. So
 10 that element is satisfied.

11 Q. Do you have an opinion, then, as to whether Claim 1
 12 of the '592 patent is anticipated by the teachings of the
 13 Doss '007 patent?

14 A. Yes, I do. And it is.

15 Q. Did you compare the Doss '007 patent to any other
 16 claims?

17 A. Yes.

18 Next.

19 Claim 3 requires the method of Claim 1, and
 20 additionally, immersing the target site within a volume
 21 of electrically conductive fluid.

22 As I mentioned, the fluid flow path is here.
 23 Basically, there is a dam that prevents the fluid from
 24 leaking out past the cornea.

25 The cornea is immersed in electrically

Page 1329

1 conductive fluid. And that is satisfied.
 2 Q. Do you have an opinion as to whether Claim 3 of the
 3 '592 patent suspect anticipated by the teachings of the
 4 Doss '007 patent?
 5 A. Yes, I do. And it is.
 6 Q. Did you look at other claims?
 7 A. Next, Gary.
 8 The next claim is Claim 4, which requires the
 9 method of Claim 1, and additionally delivering electrically
 10 conductive fluid to the target site. I think I have already
 11 described that that is satisfied.
 12 Q. Do you have an opinion as to whether Claim 4 of the
 13 '592 patent is anticipated by the Doss '007 patent?
 14 A. Yes, it is.
 15 Q. Did you look at other claims?
 16 A. Next. Claim 11 requires the method of Claim 1.
 17 Additionally, that the electrically conductive fluid be
 18 isotonic saline. There is a reference in the text, Column
 19 3, Lines 65 and 66, that basically says the fluid should
 20 be preferably isotonic saline.
 21 Q. Do you have an opinion as to whether Claim 11 of
 22 the '592 is anticipated by the Doss '007 patent?
 23 A. Yes, I do. And it is.
 24 Q. Did you look at any other claims of the '592 patent
 25 in connection with Doss?

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1 A. Yes.
 2 Next.
 3 That is Claim 21, which requires the method of
 4 Claim 1 and additionally that the voltage be in the range
 5 of 500 to 1400 volts peak to peak.
 6 And Column 3, Lines 34 to 38, specifically
 7 mention voltage of 20 to 200 volts RMS. The conversion
 8 factor on a waveform for both RMS and peak to peak is
 9 2.83. When you do the arithmetic, it's 560 volts max.
 10 So that claim is satisfied.
 11 Q. Do you have an opinion as to whether Claim 21 of
 12 the '592 patent is anticipated by the Doss '007 patent?
 13 A. Yes, I do. And it is.
 14 Q. Are we done with this board?
 15 A. I think we are done with this set of claims, yes.
 16 Q. We will move to the last board, please.
 17 Did you perform an analysis of whether the
 18 additional claims, asserted claims of the '592 patent,
 19 are valid?
 20 A. Yes, I have.
 21 Q. What is your conclusion?
 22 A. My conclusion is they are not.
 23 Q. Why not?
 24 A. Based on the prior art of the Slager article, they
 25 are not. They are anticipated.

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1 Q. Did you do an element-by-element comparison of the
 2 teachings of the Slager article to the additional asserted
 3 claims of the '592 patent?
 4 A. Yes, I did.
 5 Q. Did you prepare some slides to show that?
 6 A. Yes. As I mentioned before, the dependent claims,
 7 26, 27, 32 and 42 are dependent on Claim 23. So I
 8 started with Claim 23. And Claim 23 requires contacting,
 9 as its first step, contacting an active electrode with
 10 the body structure in the presence of electrically
 11 conductive fluid. That is shown here in the diagram.
 12 It's on Page 1383 of the article.
 13 Next.
 14 Q. Is that element satisfied?
 15 A. Yes. I am sorry. That element was satisfied.
 16 Actually, it gets satisfied here.
 17 Part of the remainder of that element is in
 18 the presence of electrically conductive fluid. On Page
 19 1383 the article mentions it's immersed in saline solution.
 20 The rest is the return electrode away from the body
 21 structure in the presence of electrically conductive
 22 fluid. The article specifically mentions that the
 23 electrode is immersed in saline solution. So that element
 24 is satisfied.
 25 Next. Maybe you can highlight the last

Page 1332

1 paragraph there on the left-hand side. Regardless, the
 2 next step is applying a high-frequency voltage between the
 3 active electrode and the return electrode such that the
 4 electrical current flows from the active to the return
 5 electrode, using the electrically conductive path. That
 6 is shown here diagrammatically with the electrode and the
 7 steam layer and so forth.
 8 So that element is satisfied.
 9 Q. Do you have an opinion as to whether Claim 23 of the
 10 '592 is anticipated by the teachings of the Slager article?
 11 A. Yes, I do. And it is.
 12 Q. Let's move on. Did you consider additional claims
 13 that are dependent on Claim 23?
 14 A. Yes. And if we go to Claim 26, and this claim
 15 requires the method of Claim 23 and, in addition, immersing
 16 the target site within a volume of electrically conductive
 17 fluid, so forth and so on, it is indicated on the left-
 18 hand side. The article describes on Page 1383 that the
 19 aortic segment and return electrode were immersed in
 20 saline solution, and sparking occurred. So that element
 21 is satisfied.
 22 Q. Do you have an opinion as to whether Claim 26 of the
 23 '592 patent is anticipated by the teachings of the Slager
 24 article?
 25 A. Yes, I do, and it is.

1 Q. Can you continue?

2 A. The next claim is Claim 27. Claim 27 requires the

3 method of Claim 23. Additionally, delivering the

4 electrically conductive fluid to the target site. And

5 that had to happen, as referenced on Page 1383 of the

6 article.

7 Q. Do you have an opinion as to whether Claim 27 of the

8 '592 is anticipated by the teachings of the Slager article?

9 A. Yes, I do. And it is.

10 Q. Did you consider other claims?

11 A. Yes. Claim 32 requires the method of Claim 23 and,

12 additionally, that the electrically conductive fluid

13 consists of isotonic saline. The article specifically

14 references on Page 1383 return electrode immersed in

15 saline, 0.9 percent. That is the definition of isotonic

16 saline.

17 Q. Do you have an opinion as to whether Claim 32 of the

18 '592 is anticipated by the Slager article?

19 A. Yes, I do. And it is.

20 Q. And did you consider Claim 42 of the '592 patent?

21 A. Yes, I did. Claim 42 requires the method of Claim

22 23, wherein the voltage is in the range of 500 to 1400

23 volts peak to peak. And at Page 1383 of the Slager

24 article, they specifically mention that the voltage is

25 1200 volts peak to peak. So that is satisfied.

1 Q. Thank you, Dr. Taylor.

2 So do you have an opinion as to whether Claim

3 42 of the '592 patent is anticipated by the Slager article?

4 A. Yes, I do. And it is.

5 MR. MARSDEN: Thank you very much, Dr. Taylor.

6 I have no further questions.

7 THE COURT: All right. Why don't we take a

8 15-minute break before we go into cross-examination?

9 (At this point the jury then left the

10 courtroom.)

11 (Short recess taken.)

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2 (Court resumed after the recess, and the

3 following occurred without the presence of the jury.)

4

5 THE COURT: Let's bring the jury in.

6 MR. MARSDEN: Your Honor, while we are waiting

7 for the jury, we have made a request to the other side,

8 but we will make it directly to the Court. Now that these

9 prior-art references have been admitted, there are only

10 six of them, they are about a quarter of an inch, we would

11 like permission to add them to the jurors' binders so they

12 have the patents and the six references.

13 THE COURT: No, I don't think we will do that.

14 Thank you. They will have them in the jury room.

15 MR. MARSDEN: I thought for the convenience,

16 and the jury understanding they weren't there. There is

17 no argument.

18 THE COURT: I have never done that.

19 MR. HEBERT: Your Honor, if we have another

20 minute...

21 There is an issue with Mr. Raffle's testimony,

22 which will be the next witness.

23 THE COURT: I don't think we do.

24 MR. HEBERT: Okay.

25 THE COURT: The jurors' lunches are here, so

1 we can take an early lunch and discuss Mr. Raffle as soon

2 as this witness is done.

3 MR. HEBERT: I think it is only a two-minute

4 issue, your Honor.

5 (At this point the jury entered the courtroom

6 and took their seats in the box.)

7 THE COURT: All right. Mr. Bobrow.

8 MR. BOBROW: Thank you, your Honor. Good

9 morning, ladies and gentlemen.

10 CROSS-EXAMINATION

11 BY MR. BOBROW:

12 Q. Good morning, Dr. Taylor.

13 A. Good morning.

14 Q. Let me ask you, first of all, a couple of questions

15 about the re-examination of the '536 patent. You are

16 aware that the '536 patent is in re-examination right now; is

17 that right?

18 A. Yes.

19 Q. And you are aware that the Patent Office has issued

20 a notice of intent to issue a re-examination certificate.

21 Is that true?

22 A. Yes.

23 Q. And you are aware, are you not, that in connection

24 with that re-examination proceeding, that the Patent Office

25 considered the Roos '198 patent?

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1 A. Yes.
 2 Q. And you read in the file wrapper for the
 3 re-examination proceeding that there was a board that was
 4 convened, that three examiners looked at the Roos '198
 5 patent; correct?
 6 A. Yes.
 7 Q. And notwithstanding that, the Patent Office issued
 8 a notice of intent to issue a re-examination certificate,
 9 confirming the patentability of the '536 patent over the
 10 Roos '198 patent; is that right?
 11 A. I am aware of the notice of intent to issue -- what
 12 did you call it again?
 13 Q. A re-examination certificate?
 14 A. A re-examination certificate. I also understand --
 15 and you can correct me if I am wrong -- it's not over
 16 until it's over. And the certificate hasn't been issued
 17 yet.
 18 Q. The certificate has not been issued yet. But you
 19 are aware that the Patent Office wrote in an office action
 20 that the claims of the '536 are patentable over the Roos
 21 '198 patent, and that that was an office action that was --
 22 was the result of a board of three examiners that had
 23 convened to look at the issue; correct?
 24 A. I am aware of that.
 25 MR. BOBROW: May I approach, your Honor?

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1 THE COURT: Yes, you may.
 2 BY MR. BOBROW:
 3 Q. I have handed you PX-7. And PX-7 is the file
 4 history for the re-examination of the '536 patent. You
 5 have looked at at least portions of PX-7 before, have you
 6 not?
 7 A. I have looked at the file history of '536, which is
 8 this document. Is that what you are saying?
 9 Q. You have looked at the file history for the
 10 re-examination of the '536?
 11 A. Some parts of the file history of the '536 patent.
 12 Q. Including parts of the re-examination; is that right?
 13 A. Including parts of the re-examination, yes.
 14 Q. And you considered that information in connection
 15 with forming your opinions and giving your testimony;
 16 correct?
 17 A. I did.
 18 MR. BOBROW: Your Honor, at this time I move
 19 PX-7 into evidence.
 20 MR. MARSDEN: No objection, your Honor.
 21 *** (Plaintiff's Exhibit No. 7 was received into
 22 evidence.)
 23 BY MR. BOBROW:
 24 Q. Now, I would like to shift gears a little bit. I
 25 wanted to ask you some questions about electrically

1 conducting fluids. All right?
 2 A. Yes.
 3 Q. Now, one fluid that is an electrically conducting
 4 fluid is saline; correct?
 5 A. Yes.
 6 Q. And another one is Ringer's lactate; correct?
 7 A. Or lactate of Ringer's, yes.
 8 Q. Now, there are also fluids that are used in
 9 electrosurgery that are electrically nonconducting fluids;
 10 correct?
 11 A. Yes.
 12 Q. And glycine is one of those electrically
 13 nonconducting fluids; correct?
 14 A. Yes.
 15 Q. And although glycine is called an electrically
 16 nonconducting fluid, it nonetheless does conduct
 17 electricity, does it not?
 18 A. Yes.
 19 Q. And, in fact, glycine is a fluid that is commonly
 20 used in a procedure that you called a T-U-R-P procedure;
 21 correct?
 22 A. It's commonly used. It's not the only fluid. But,
 23 yes, yes, it's commonly used.
 24 Q. In fact, glycine conventionally has been used by
 25 doctors for the T-U-R procedure in the prostate; right?

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1 A. Can you repeat the question again?
 2 Q. Yes. I was saying that glycine conventionally has
 3 been the fluid that doctors have used in performing a
 4 TURP procedure, using electrosurgery?
 5 A. Yes.
 6 Q. Now, you had mentioned before that in using an
 7 electrically nonconductive fluid like glycine it will
 8 nonetheless conduct electricity when you put an
 9 electrosurgical instrument into that glycine; right?
 10 A. Yes.
 11 Q. Now, you had said on direct examination, you had
 12 mentioned a patent to reduce, the Roos '198 patent. Do
 13 you recall that?
 14 A. Yes.
 15 Q. Now, the Roos '198 patent described a device or
 16 devices that were to be used in TURP procedures; is that
 17 right?
 18 A. Yes. However, you have to keep in mind that when
 19 you reference TURP procedures, the way it's most often
 20 done is with a monopolar electrosurgical probe, and the
 21 Roos patent is a bipolar electrosurgical probe, and it
 22 does make a difference.
 23 ---
 24
 25

1
2 Q. Well, the Roos patent doesn't just talk about bipolar
3 probes, does it?
4 A. But the configurations we were describing in my direct
5 testimony were bipolar.
6 Q. That wasn't the question I asked you.
7 A. I just wanted to explain.
8 Q. Fair enough. The Roos '198 patent also discusses
9 monopolar uses for TRUP procedures; is that correct?
10 A. Yes, it does. Sorry.
11 MR. BOBROW: Why don't we put DTX-11 on the
12 screen, please? DTX-11 is the '198 patent. And let's go
13 to Column 1.
14 BY MR. BOBROW:
15 Q. DTX-11 is also in your binder if you care to look at
16 it, but in Column 1 of the '198 patent, if you take a look
17 at around Line 35 when it's discussing the background of
18 the invention...
19 A. This binder? I'm sorry. Okay. Yes. Column 1.
20 Q. And if you take a look at Line 35, it references a
21 neutral electrode applied externally to the patient's
22 body.
23 Do you see that?
24 A. Yes.
25 Q. And so by reference to a neutral electrode applied

1 externally to the patient's body, here in this paragraph
2 it's describing monopolar electrosurgery; correct?
3 A. Yes.
4 Q. And if you go down further to about Lines 52 through
5 56, there is a discussion there about washing water.
6 Do you see that? It's Line 54 refers to washing
7 water.
8 A. Yes.
9 Q. Now, it mentions here that there is some current
10 flows from the cutting loop via the washing water directly
11 to the metal parts of the endoscope shaft located in the
12 washing water flow and from there to the engaging tissue.
13 Do you see that?
14 A. Yes.
15 Q. Now, given that this is a monopolar electrosurgical
16 setup, you would agree with me, would you not, that the
17 washing water that is being described here is either
18 glycine or some other electrically nonconducting fluid;
19 correct?
20 A. Yes, it is.
21 Q. You have no reason to think it's not, do you? That's
22 how the monopolar procedures are done; correct?
23 A. Glycine, Glanitol (phonetic), something that you
24 would expect to be electrically nonconductive.
25 Q. And it says there is some current flow in that

1 electrically nonconductive fluid from the electrode to
2 the metal parts of the electrode; right?
3 A. Yes.
4 Q. All right. Now, in describing in the rest of the
5 patent, it describes some bipolar devices; correct?
6 A. Yes.
7 Q. And during your direct examination, you showed one
8 of those devices; correct?
9 A. Yes.
10 Q. Now, in the '198 patent, the '198 patent never uses
11 the word saline, does it?
12 A. Couldn't find it, no, it does not.
13 Q. It doesn't use the word Ringer's lactate or lactated
14 Ringers, does it?
15 A. It does not.
16 Q. And in describing the fluid that is used with the
17 bipolar embodiments, it uses, the phrase at Column 4, Line
18 54 is calling it a washing liquid; right?
19 A. Line 54, you said?
20 Q. Yes, at Column 4.
21 A. Okay. Yes, it does say washing liquid.
22 Q. It doesn't call it saline, it doesn't call it
23 lactated Ringer's; correct?
24 A. No.
25 Q. All right. In fact, wouldn't you agree with me that

1 in this '198 patent to Roos, there is really no difference
2 between the way that Mr. Roos talked about the washing
3 liquid that was used in the monopolar case versus the
4 bipolar case. He describes them as washing water or
5 washing liquid; right?
6 A. That's correct.
7 Q. Now, if you would, please, take a look at Figure 5
8 of the '198 patent.
9 MR. BOBROW: If you can highlight that,
10 Chris...
11 BY MR. BOBROW:
12 Q. And Figure 5 is a depiction of one of the bipolar
13 probes that is described here in this Roos '198 patent;
14 correct?
15 A. Yes, it's one of the embodiments. Yes.
16 Q. And as you look up there, you can see there is what
17 he calls a neutral electrode 11 and also number 12 he
18 calls the treatment electrode; right?
19 A. That's correct.
20 Q. Now, there is, what I'm circling there with this
21 light pen is the return electrode; correct?
22 A. And I also he calls it the neutral electrode in the
23 patent, but, yes.
24 Q. Now, if you take a look at Column 6 at Lines 51 to
25 53 of the Roos '198 patent, he talks about the neutral

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1 electrode in this embodiment, doesn't he?
 2 A. Hold on a second. I'm sorry. Which lines again?
 3 Q. This is at Column 6, Lines 51 to 53.
 4 A. Yes.
 5 Q. And it says there that the neutral electrode 11 in
 6 the form of the steel band rests on the tissue in large
 7 area form so that good electrical contact is insured.
 8 Do you see what I'm referring to there?
 9 A. Yes, I do.
 10 Q. Now, wouldn't you agree with me, sir, that if there
 11 were electrically conducting fluid that was filling the
 12 environment where the active electrode is and the return
 13 electrode is, you wouldn't need to have tissue contact
 14 to insure good electrical contact between the active
 15 electrode and the return electrode. That would be
 16 provided by the saline or the Ringer's lactate or the
 17 other electrically conducting fluid; right?
 18 A. From the specific embodiment, your interpretation
 19 is correct. However, this is not the embodiment that I
 20 talked about and it's not an embodiment that I described.
 21 Q. But for the embodiment I described, that's correct?
 22 A. Yes.
 23 Q. Now, why don't we take a look at the embodiment we
 24 did talk about which is Figures 7 and 8 were the ones you
 25 had up?

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1 A. That's correct.
 2 MR. BOBROW: So perhaps we can highlight those.
 3 BY MR. BOBROW:
 4 Q. I'm sorry. Dr. Taylor, are you there?
 5 A. Yes, I am.
 6 Q. Thank you. Now, Figures 7 and 8 you had testified
 7 about a little bit earlier and, as I see it there, there
 8 is a ring or a band that is called 11.
 9 Do you see that?
 10 A. Yes.
 11 Q. And that's what Mr. Roos is calling the return
 12 electrode here; correct?
 13 A. Yes.
 14 Q. All right. Or neutral, I guess. But that's what
 15 you are saying is the return electrode for purposes of
 16 these claims?
 17 A. Right.
 18 Q. And as I was looking at what you had checked off
 19 earlier, for Claim 47 in the Roos '198 patent, it appears
 20 that your testimony was that this embodiment of the Roos
 21 '198 patent satisfies Claims 47; right?
 22 A. Yes.
 23 Q. And specifically, you offered the opinion that this
 24 embodiment satisfied this language that says that the
 25 return electrode is sufficiently spaced from the electrode

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1 terminal to minimize direct contact between the return
 2 electrode and the patient's tissue.
 3 Do you see that?
 4 A. Yes.
 5 Q. And that's your testimony, even though the return
 6 electrode completely surrounds the probe shaft; right?
 7 A. Yes.
 8 Q. It's exposed for 360 degrees of that shaft; right?
 9 A. Yes.
 10 Q. And it's not spaced very far away from the active
 11 electrode, is it? It would be spaced a small distance;
 12 right?
 13 A. No.
 14 Q. How far away would it be spaced?
 15 A. Well, if you look at a standard resectoscope -- and
 16 I happen to know that in the Roos article what they did
 17 is they modified a Carl Storts (phonetic) resectoscope,
 18 the cutting loop which is indicated by 12 can move out
 19 about -- about an inch and could be retracted almost to
 20 the lip there, the plastic insulating member which is
 21 indicated by 35. So it has the ability to move in and
 22 out. So an inch is pretty far for an electrode.
 23 Q. So the loop isn't also positioned an inch away from
 24 the return electrode?
 25 A. It's not always, but it can be.

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1 Q. What you do is you retract the treatment electrode
 2 back in towards the return electrode; correct?
 3 A. Yes, you do.
 4 Q. That's the technique. It extends out and you pull
 5 it back towards the return electrode; right?
 6 A. Right.
 7 Q. And in the TRUP procedure, I take it that this device
 8 here is traveling a fairly tight, a tight lumen, as it
 9 were; right? It goes up to the urethra, doesn't it?
 10 That's the passageway into the body, isn't it?
 11 A. Oh, I see. I'm sorry. I thought you were back at
 12 the electrode again. Yes, the device does go into the
 13 urethra and it also can be used for treating the bladder,
 14 in which case the neutral electrical would be almost
 15 entirely or it could be almost entirely inside the
 16 bladder. The bladder, in order to operate on the bladder,
 17 you have to distend it, which means you put fluid into it
 18 and make it large. And the bladder distended is, oh, about
 19 the size of my fist. I guess it depends on how big your
 20 bladder is. But when you have the instrument all the way
 21 in the bladder, the return electrode is entirely, entirely
 22 engulfed by fluid.
 23 Q. Right. And in the conventional monopolar way, that
 24 would be in a glycine solution; right?
 25 A. That's correct. But, in this particular case, that's

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1 not what they used.
 2 Q. Right. All right. Instead, they used washing
 3 liquid; right?
 4 A. Yes.
 5 Q. That's what the patent says?
 6 A. Yes.
 7 Q. Now, let's take a look at Figure 1 of this patent.
 8 And Figure 1 is describing another bipolar embodiment of
 9 Roos, is it not?
 10 A. Yes, it is.
 11 Q. And there is a little hook there. That's the
 12 treatment electrode; right?
 13 A. Yes.
 14 Q. And here, there is a return electrode also; right?
 15 Or a neutral electrode as he calls it?
 16 A. Yes.
 17 Q. And that neutral electrode is within that endoscope.
 18 It's covered up by some sort of insulation there, isn't it?
 19 A. Yes.
 20 Q. So the neutral electrode is located within the
 21 endoscope; right?
 22 A. In this case, it is.
 23 Q. Now, let's go to Claim 1 of the Roos '198 patent.
 24 And do you see that, sir?
 25 A. I've got it right here.

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1 Q. Right. And this claim, Claim 1, actually has as a
 2 limitation that the return electrode is or it says the
 3 neutral electrode is located within said endoscope body.
 4 Do you see that? That's at about line --
 5 A. I know it's here. What line is it?
 6 Q. About Line 58.
 7 A. Yes. I'm sorry. Yes, I've got it.
 8 Q. And you would agree with me that Claim 1 as it's
 9 written here actually covers the embodiment we were just
 10 looking at, Figure 1?
 11 A. It covers Figure 1. It covers 7 and 8, too.
 12 Q. Let's take it in pieces.
 13 A. Okay.
 14 Q. First, you would agree with me this covers Claim 1?
 15 A. Yes.
 16 Q. And your testimony is that Claim 1 covers also
 17 Figures 7 and 8?
 18 A. Covers Figures 7 and 8. And I think it actually
 19 covers Figure 5, too, but I had to go back and look.
 20 Q. Now, first of all, would you agree with me that, in
 21 the Roos '198 patent, there isn't any discussion or
 22 suggestion that the fluid that is used with Figure 1,
 23 that device is any different than the fluid that is used
 24 with any of the other devices? Would you agree with me
 25 on that?

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1 A. I don't believe there is any differentiation of the
 2 fluid.
 3 Q. Right. So the way that the fluid is described in
 4 this reference, same fluid for Figure 1, Figure 2, Figure
 5 7, Figure 8; correct?
 6 A. That's correct.
 7 Q. All right. Now, I believe you testified here just
 8 now that you believe that this claim, Claim 1, also covers
 9 Figures 7 and 8; is that correct?
 10 A. That's correct.
 11 MR. BOBROW: Now, why don't we put Figures 7
 12 and 8 up on the board?
 13 BY MR. BOBROW:
 14 Q. Now, for Figures 7 and 8 to fall within the scope of
 15 Claim 1, this neutral electrode, right there, right here,
 16 would have to be located within the endoscope body;
 17 correct?
 18 A. That's correct.
 19 Q. And you recall that I took your deposition probably
 20 about two months ago; right?
 21 A. Oh, yes. That was fun.
 22 Q. And back at that time, when I did take your
 23 deposition, I asked you about this issue, didn't I?
 24 A. Yes, you did.
 25 Q. And I asked you whether or not, back at that time,

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1 whether or not you agreed with me that Claim 1 didn't
 2 cover Figures 7 and 8; correct?
 3 A. Yes.
 4 Q. And you were under oath at that time; right?
 5 A. Sure was.
 6 Q. Just like now?
 7 A. Yes.
 8 Q. And back at that time, you had also studied the
 9 Roos '198 patent before you testified?
 10 A. Yes.
 11 Q. The Roos '198 patent wasn't something I'd showed
 12 you that day and asked you questions about?
 13 A. I studied it intensely.
 14 Q. Right. And when I asked you for the first time
 15 about whether or not Claim 1 covered Figures 7 and 8, you
 16 told me under oath, you didn't?
 17 A. That's right.
 18 Q. You remember that very well?
 19 A. That's right. Because I corrected it.
 20 Q. Right. You corrected it after lunch, didn't you?
 21 A. Yes, I did.
 22 Q. You corrected it after you had lunch with Smith &
 23 Nephew's lawyers?
 24 A. I actually corrected it because I looked at the
 25 diagram again.

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1 Q. Please answer my question.
 2 A. I did have conversation after lunch, yes, and with
 3 lunch.
 4 Q. And that was Mr. MacFerrin, Smith & Nephew's attorney?
 5 A. Yes.
 6 Q. And Mr. MacFerrin, during your deposition, was also
 7 acting as your lawyer; right?
 8 A. Yes.
 9 Q. You were represented by the very same lawyers that
 10 are representing Smith & Nephew here in court today; isn't
 11 that right?
 12 A. Yes.
 13 Q. And you had been retained or you had retained that
 14 firm and you considered there to be an attorney/client
 15 privilege between discussions that you had with Smith &
 16 Nephew's lawyers; correct?
 17 A. Yes.
 18 Q. And I asked you some questions during the
 19 deposition and you refused to answer some of them based
 20 upon the fact there was an attorney/client relationship?
 21 MR. MARSDEN: Objection. This is improper
 22 questioning about assertions of the attorney-client
 23 privilege.
 24 THE COURT: Where are we going with this, Mr.
 25 Bobrow?

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1 MR. BOBROW: I believe it goes to the
 2 credibility of the advise of the witness.
 3 THE COURT: Because he didn't answer questions
 4 at a deposition?
 5 MR. BOBROW: Based upon his relationship with
 6 the Smith & Nephew's lawyers.
 7 MR. MARSDEN: Based upon privilege.
 8 THE COURT: And what was the last question that
 9 you asked?
 10 MR. BOBROW: The last question I believe was
 11 that he had refused to answer questions I had asked him at
 12 the deposition based upon the attorney/client relationship
 13 that he had with his lawyers.
 14 THE COURT: All right. That's an appropriate
 15 question, but then you need to move on.
 16 THE WITNESS: Where were we?
 17 BY MR. BOBROW:
 18 Q. I just asked the question, you refused to answer
 19 some questions that I asked you during your deposition
 20 based upon the attorney/client relationship with the same
 21 lawyers that are representing you as Smith & Nephew?
 22 A. Yes.
 23 Q. And you're not paying and haven't paid the Smith &
 24 Nephew's lawyers any money for their services, have you?
 25 A. No, I have not.

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1 Q. You understand that the time that they've spent with
 2 you has been reimbursed or compensated by Smith & Nephew;
 3 right?
 4 A. I certainly understand they're being reimbursed by
 5 Smith & Nephew.
 6 Q. Now, not only did you testify when I asked you in
 7 your deposition that these Figures 7 and 8 aren't covered
 8 by Claim 1 the first time I asked you, but after lunch,
 9 you did come in and you said your testimony was now
 10 different, that you believed it was covered by Claim 1;
 11 right?
 12 A. I made a mistake, yes, and I corrected it.
 13 Q. And isn't it true also that Smith & Nephew's lawyer
 14 during that lunch break pointed out that mistake to you?
 15 A. Yes, he did.
 16 Q. Right. And during that lunch, Mr. MacFerrin was
 17 the one who said, Hey, I think that this was wrong with
 18 respect to Figure 7, it is covered by Claim 1 and let's
 19 go through it; right?
 20 A. I don't think it was exactly that way. I think
 21 basically he asked me to refer back to my report, remember
 22 what I said in my report.
 23 Q. Well, let's look at that because in your report,
 24 you also talked about whether Claim 1 covers Figure 7;
 25 correct?

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1 A. Yes.
 2 Q. And in your report, you addressed the question of
 3 whether or not this neutral electrode, right here, and
 4 right here, whether that neutral electrode is an electrode
 5 that is within the endoscope body; correct?
 6 A. Yes.
 7 Q. And that was a report that you prepared prior to
 8 the deposition back in I believe it was late March; right?
 9 A. Are you referring to the report or the deposition?
 10 Q. I'm sorry that I was unclear. Let me try to restate
 11 it. The report that you prepared where you discuss Figure
 12 7, that report was prepared before I took your deposition;
 13 right?
 14 A. Yes.
 15 Q. All right. And even before I took your deposition,
 16 you also signed a declaration about your report, didn't
 17 you?
 18 A. Oh, yes. Yes.
 19 Q. And you declared under the penalties of perjury that
 20 you believed what you said in your report was true?
 21 A. Right.
 22 Q. And that was a report that you had prepared prior to
 23 your deposition; right?
 24 A. Right.
 25 Q. And, obviously, prior to the lunch that you had with

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1 Mr. MacFerrin during the middle of the deposition; correct?
 2 A. Correct.
 3 Q. All right. Now, I have your report in that white
 4 binder, and I direct your attention, please, to Page 18
 5 of your report. This is your expert report of February
 6 17, 2003.
 7 Do you have that, sir?
 8 A. Yes.
 9 Q. And in the middle of page 18, you address in your
 10 report the question of whether Claim 1 covers Figures 7
 11 and 8; right?
 12 A. Yes.
 13 Q. And when you wrote your report, let's just -- when
 14 you wrote your report, what you wrote was, quote, it is
 15 particularly important to note that in connection with
 16 the endoscope shown in the Roos '198 patent at Figures 7
 17 and 8, there is no plastic cover and the neutral electrode
 18 is on the outside of the endoscope, not arranged within it.
 19 Correct? That's the sentence you wrote in
 20 your report of February 17 of 2003; correct?
 21 A. Yes, that's in the report.
 22 Q. Right. And what you just wrote there, not arranged
 23 within it, those were your words; correct?
 24 A. Yes.
 25 Q. You wrote those words yourself; right?

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1 A. Yes.
 2 Q. And you wrote those words to describe Figures 7 and
 3 8; right?
 4 A. That's right.
 5 Q. Now, in connection with your work on this matter, I
 6 take it that you have also reviewed --
 7 A. Excuse me. Can I put this away?
 8 Q. Sure.
 9 (Pause.)
 10 BY MR. BOBROW:
 11 Q. You have also reviewed another patent to Mr. Roos;
 12 correct?
 13 A. The '667? Is that the one are you talking about?
 14 Q. Exactly. You reviewed that reference, the Roos
 15 '667 patent, in connection with your work on this matter;
 16 right?
 17 A. Yes, I did.
 18 Q. And you, in fact, considered this reference at the
 19 time that you wrote your report; correct?
 20 A. Yes.
 21 Q. All right.
 22 MR. BOBROW: Your Honor, may I approach?
 23 THE COURT: Yes, you may.
 24 (Document passed forward.)
 25

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1 BY MR. BOBROW:
 2 Q. Sir, I have had handed you PX-605, which is a patent
 3 to Roos, Eberhard Roos from Germany, U.S. Patent Number
 4 4,706,667.
 5 Do you see that?
 6 A. Yes.
 7 Q. And this is the Roos patent that you considered in
 8 connection with your work on this matter; is that right?
 9 A. It looks like it's the patent. Yes. Excuse me.
 10 MR. BOBROW: Pardon me, Dr. Taylor.
 11 Your Honor, I move PX-605 into evidence.
 12 THE COURT: Any objection?
 13 MR. MARSDEN: No objection.
 14 THE COURT: All right. Thank you.
 15 THE DEPUTY CLERK: So marked.
 16 *** (Plaintiff's Exhibit No. 605 was received into
 17 evidence.)
 18 BY MR. BOBROW:
 19 Q. Now, the '667 patent was issued to Eberhard Roos;
 20 right?
 21 A. Yes.
 22 ---
 23
 24
 25

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1
 2 Q. He is the same man who is on the Roos '198 patent
 3 that you talked about earlier on your direct examination;
 4 correct?
 5 A. Yes, he is.
 6 Q. And he is the same man who is the Roos in the
 7 Elsasser and Roos article; right?
 8 A. Yes, he is.
 9 Q. And this patent is dated in, issued in November 1987;
 10 correct?
 11 A. Yes.
 12 Q. In this patent, the '667 patent, Mr. Roos actually
 13 talks a bit about the German application that was the
 14 predecessor, or sometimes it is called the parent
 15 application, to what ended up issuing as the Roos '198
 16 patent; correct?
 17 A. Yes. You are talking about -- do you have a
 18 specific reference?
 19 Q. Sure. Why don't we bring up Column 1 of the '667
 20 patent, beginning at Line 14, going down to Line 29.
 21 Perhaps we can highlight that paragraph.
 22 You will see at the top there it refers to a
 23 known electrosurgical high-frequency cutting instrument of
 24 this kind. Then it gives a number that begins DE-OS. And
 25 it goes on there in there; right?

1 A. Yes.
 2 Q. And the DE stands for Germany; right?
 3 A. Deutsch, yes.
 4 Q. Exactly. What is being referred to here in the
 5 '667 patent, when it refers to that No. 25 21 719, that
 6 is actually the German parent application to the Roos
 7 '198 patent; right?
 8 A. That's correct. At least that's my understanding,
 9 anyway.
 10 Q. In fact, on the '198 patent, that number, 25 21 719,
 11 appears right on the front, doesn't it?
 12 A. It does.
 13 Q. Here, in the '667 patent, in this paragraph, Mr.
 14 Roos is talking about one of the instruments that is
 15 described here in the '198 patent; correct?
 16 A. You are talking about the paragraph that starts at
 17 Line 14, going down?
 18 Q. Exactly. And he is talking there, is he not, of
 19 at least Figure 1 of the '198 patent?
 20 A. He is talking about -- I am not sure which one he
 21 is referring to, he is talking about one of the
 22 instruments in that application.
 23 Q. Right. And he says there that the neutral electrode
 24 is admittedly arranged in the immediate vicinity of the
 25 cutting loop. It is, however, so separated from the tissue

1 by a plastic cover or by its arrangement in an endoscope
 2 that it can only enter into electrical contact with the
 3 cutting electrode electrolytically via the secretion which
 4 is present during the cutting process.
 5 You see what I am referring to there?
 6 A. Yes.
 7 MR. BOBROW: Why don't we put up Figure 1 of
 8 the '198 patent to Roos? Paragraph. If we can put it up
 9 on the same screen... If not, just put up the '198
 10 BY MR. BOBROW:
 11 Q. There we have Figure 1. You can see in Figure 1, can
 12 you not, there is this sort of shadow right there, that's
 13 the plastic cover; right? This portion that sticks out
 14 over this endoscope; right?
 15 A. The one that is labeled 11?
 16 Q. I think it's labeled 18, right there. That's the
 17 plastic cover; right?
 18 A. Yes.
 19 Q. And what we just read in the Roos '667 patent, the
 20 later patent, it's talking there about an electrode that
 21 is separated from the tissue by a plastic cover; right?
 22 A. Sorry. Say that again?
 23 Q. In the '667 patent, it talks about a cutting
 24 electrode that is separated from the tissue by a plastic
 25 cover?

1 A. Yes.
 2 Q. So it is pretty clear, is it not, that at the very
 3 least, in the '667 patent, Mr. Roos is talking about Figure
 4 1; correct?
 5 A. Well, he certainly could be. Certainly, the Figure
 6 1 that is in the '198 patent may be the figure that he is
 7 discussing here -- or the configuration, I should say, that
 8 he is discussing in the '667. He didn't specifically call
 9 it out. So we are surmising here, I guess, aren't we?
 10 Q. Given that there is the plastic over that embodiment
 11 and there isn't plastic over any other one, wouldn't you
 12 agree that what he is talking about there is Figure 1?
 13 A. Most likely. But I can't confirm it. It's most
 14 likely the case.
 15 Q. Fair enough. So here, for this embodiment -- this is
 16 a bipolar embodiment; right?
 17 A. That's my understanding, yes.
 18 Q. This is an embodiment that Mr. Roos in his '198 patent
 19 said was used with washing liquid; correct?
 20 A. Yes.
 21 Q. Those are the words that Mr. Roos used in the '198
 22 patent that you talked about on your direct examination?
 23 A. That's correct.
 24 Q. And if we can go back to the '667 patent and
 25 highlight that language, what Mr. Roos is saying there

1 in this patent is that using this device as it was
 2 designed, that the return electrode and the treatment
 3 electrode can only enter into electrical contact with
 4 the cutting electrode electrolytically via the secretion
 5 which is present during this cutting process.
 6 Right? That's what he says?
 7 A. That's what he says.
 8 Q. Wouldn't you agree with me, sir, that if there were
 9 saline or Lactated Ringer's that were present in that
 10 fluid, in that washing liquid as he describes, one would
 11 not need secretions from the body to make that fluid
 12 electrically conductive so as to electrically connect
 13 the treatment electrode with the neutral electrode? The
 14 liquid would already be conductive and secretions wouldn't
 15 be needed; isn't that right?
 16 A. And that's actually one of the reasons why this
 17 particular passage in '667 is confusing, because of the
 18 fact that we know that at least one configuration of Roos
 19 works, clinically works, because he couldn't have
 20 conducted 32 procedures without being able to resect
 21 tissue. And he did resect -- let me finish, please. He
 22 did resect tissue using washing liquid.
 23 So that's one of the reasons why this
 24 particular passage is confusing to me.
 25 Q. Well, let's back up a little bit then, because you

1 also testified earlier about the Roos and Elsasser article;
 2 correct?
 3 A. Yes.
 4 Q. And the reduce and Elsasser article talks about some
 5 surgeries that were performed; right?
 6 A. Correct.
 7 Q. And in the Roos and Elsasser article, the instrument
 8 that was used was essentially the instrument from Figures
 9 7 and 8 of the '198 patent; right? That's the one that was
 10 used to perform the surgery?
 11 A. That configuration was the one that was used to
 12 perform the surgeries. They also tried another
 13 configuration, and I have forgotten which figure it
 14 refers to in the patent, that worked but not as well.
 15 Q. But the one in reference to that you said was used
 16 in surgery, that is Figures 7 and 8 in the '198 patent?
 17 That's the one that is described?
 18 A. Absolutely.
 19 Q. Not Figure 1, correct, but they describe Figures 7
 20 and 8?
 21 A. Okay.
 22 Q. So my questions have to do right now with what is
 23 described here for Figure 1 and this language here in
 24 '667.
 25 Now, wouldn't you agree with me, sir, that if

1 the liquid used with Figure 1 were electrically conductive
 2 fluid when it was introduced into the surgical site, that
 3 secretions into the fluid would not be necessary in order
 4 to make it electrically conductive so as to electrically
 5 couple the active and the return electrode together?
 6 Wouldn't you agree with that?
 7 A. I would agree with you. But once again, it's
 8 confusing, because I think you have already established,
 9 in the course of your examination on me, that the washing
 10 liquid that was used in '198 is the same washing liquid
 11 throughout; right? And, therefore, if the washing liquid
 12 that was used -- that was used throughout all the
 13 different configurations, if the washing liquid was
 14 successful in Figures 7 and 8, clinically, then it must
 15 have been electrically conductive fluid. There is a
 16 logical connection there.
 17 Q. Well, that's what you are saying now. But isn't
 18 it true, sir, that electrical current can flow through
 19 electrically nonconductive fluids? Isn't that true?
 20 A. Yes, it can.
 21 Q. And isn't it also true that if an electrically
 22 nonconductive fluid were introduced into the surgical site,
 23 that you would need secretions from the body in order to
 24 make the fluid conductive so as to maintain a good
 25 electrical connection, electrolytic connection between the

1 treatment electrode and the neutral electrode? Isn't that
 2 true?
 3 A. Explain to me the logic again?
 4 Q. I am simply saying, sir, that if electrically
 5 nonconductive fluid were introduced, if that was
 6 introduced into the body, then in order to electrically
 7 connect and have a good electrical connection between the
 8 treatment electrode and the neutral electrode, you would
 9 need to have secretions from the body in order to make
 10 that fluid electrically conductive?
 11 A. In which case the fluid would be electrically
 12 conductive, right.
 13 Q. I am simply saying if you introduce a nonconductive
 14 fluid and there are secretions into the fluid, then you
 15 would need those secretions to have an electrolytic
 16 connection between the treatment electrode and the neutral
 17 electrode; right?
 18 A. I follow your logic. And once again --
 19 Q. Can you please answer the question?
 20 A. The answer is yes. I follow your logic, but it's
 21 confusing. That's all.
 22 Q. But I just want it to be clear that your answer to
 23 my question is if you introduce an electrically
 24 nonconductive fluid, you would need secretions from the
 25 body to couple the treatment electrode to the return

1 electrode. Is that a true statement?
 2 A. I think the answer is yes. But I still think it's
 3 confusing.
 4 Q. All right. Now, let's see if we can go through the
 5 rest of this paragraph and see if there is any more
 6 clarity here, because it also says, in this paragraph in
 7 Column 1, that because of this problem, that the device
 8 was relying upon tissue discretions, it says that it was
 9 difficult to maintain the current intensity required for
 10 trouble-free cutting in a required, precisely defined
 11 manner at the cutting electrode.
 12 Do you see that?
 13 A. Yes.
 14 Q. And the import of that is that the fluid that was
 15 being used with this Roos '198 patent, Figure 1, was that
 16 the fluid wasn't sufficiently conductive to be able to do
 17 trouble-free cutting; correct?
 18 A. One of the problems I am having with this is, this
 19 particular paragraph doesn't even reference any fluid at
 20 all. So I am wondering if this device wasn't used or
 21 intended to be used for open surgery.
 22 Q. Well, that is not how it's described in the '198
 23 patent, is it? In the '198 patent it says that Figure 1
 24 is used with washing liquid; right?
 25 A. The thing is, if you read the first sentence, in a

1 known electrosurgical high-frequency cutting instrument
 2 of this kind, does that mean it is exactly the same or
 3 does that mean it is sort of similar?
 4 Q. In that description he cites specifically to the
 5 parent application to the '198 patent; right?
 6 A. I agree with you on that.
 7 Q. In the '198 patent, every single device that is
 8 described in there is designed for use with fluid;
 9 correct?
 10 A. Yes, it is.
 11 Q. And in every single one of those, every single
 12 embodiment in the Roos '198 patent is described as being
 13 used with some type of washing liquid; correct?
 14 A. It is.
 15 Q. All right. Now, wouldn't you agree with me that
 16 what Mr. Roos is saying here in his patent, when he is
 17 describing the parent application to the '198 patent, he
 18 is saying here that when you use this instrument that
 19 there was not sufficient discretion from the body to make
 20 the fluid sufficiently conductive so that you could get
 21 trouble-free cutting? Isn't that the import of this
 22 paragraph?
 23 A. He is saying that. But there is no reference to any
 24 other fluid.
 25 Q. But that is the import of this paragraph; correct?

1 A. Yes.
 2 Q. All right. Now, I have another question about the
 3 Roos '198 patent.
 4 If we could put that back up and take the '667
 5 patent down...
 6 In the '198 patent, there are of course a large
 7 number of figures and we have gone through a couple of those
 8 already; correct?
 9 A. Right.
 10 Q. I think earlier you had put up on the overhead
 11 Figures 7 and 8 when you were going through your direct
 12 examination; correct?
 13 A. Yes, I did.
 14 Q. And one of the things that you said was that in the
 15 '198 patent that there is a disclosure of a connector;
 16 correct?
 17 A. Yes.
 18 Q. And you said that the connector was located, the
 19 language of the claim says that the connector is near the
 20 proximal end of the shaft; right?
 21 A. Yes.
 22 Q. And so it's your testimony here today that the
 23 figures of the '198 patent show there is a connector near
 24 the proximal end of the shaft; is that right?
 25 A. Yes.

1 Q. And so I take it what that means is that you have
 2 been able to review the Roos '198 patent and you have been
 3 able to locate somewhere in those figures some discussion
 4 of the location of where the connector is to connect back
 5 to the generator; right?
 6 A. Well, there is a connector. There has to be.
 7 Q. I am not asking you that question. I am saying
 8 that you have been able to review the '198 patent and you
 9 have been able to discern some description in there of
 10 the location of the connector. Not that there is one.
 11 But the specific location of it; right?
 12 A. There is not a specific reference to a location of
 13 the connector.
 14 Q. All right. So here, when you marked on this board
 15 that the limitation was met, that the connector is near
 16 the proximal end of the shaft, the Roos '198 doesn't say
 17 where the connector is; correct?
 18 A. The patent does not say -- the patent does not say
 19 explicitly where the connector is located.
 20 Q. All right. Now, since we are on the subject of Mr.
 21 Roos --
 22 A. You do realize that all resectoscopes have connectors
 23 at the back end of the resectoscope.
 24 Q. I don't realize that. In all events, in the '198
 25 patent, there is no discussion of where the connector is;

1 correct?
 2 A. That's correct, yes.
 3 Q. When you said there is that discussion, that wasn't
 4 true, was it?
 5 A. No, but then again --
 6 Q. There is nothing in the '198 patent that says that;
 7 correct?
 8 A. There is nothing in the '198 patent that says it
 9 explicitly. But there are no resectoscopes on the market
 10 that don't have a connector at the end, on the back of
 11 the resectoscope.
 12 Q. In the market, you said?
 13 A. In the market.
 14 Q. Why don't we turn, then, to DTX-59-A and B. This is
 15 the Roos and Elsasser article. Perhaps we can put up the
 16 German language original. Do you have that, sir?
 17 A. Yes.
 18 Q. Why don't we go to Figure 3.
 19 Now, if we can highlight Figure 3, please.
 20 Here in the Roos and Elsasser article, in the first part of
 21 the article, once again, there is a discussion of a
 22 monopolar TURP procedure; correct?
 23 A. You are asking me if there is a discussion of
 24 conventional TURP?
 25 Q. Monopolar?

1 A. Yes, there is.
 2 Q. And Figure 3 is one of the figures that Roos and
 3 Elsasser used to describe that conventional monopolar
 4 procedure; correct?
 5 A. I am just reading the English version of this.
 6 Q. Fair enough. I am, too.
 7 A. Yes, it is.
 8 Q. And so what is being shown here in Figure 3 is a
 9 resectoscope that is being inserted into the body;
 10 correct?
 11 A. Well, I believe what is being shown here, you have
 12 got the resectoscope there. This represents the bladder.
 13 And this represents the prostate.
 14 Q. So right here, that region that I am circling now,
 15 which is cross-hatched at about a 45-degree angle, that
 16 area there is the prostate; is that right?
 17 A. That is correct.
 18 Q. And that's tissue?
 19 A. Yes, us men would consider it to be tissue.
 20 Q. Fair enough. And so here, this is the tip of the
 21 resectoscope; right?
 22 A. Yes.
 23 Q. The part that I am circling there. And this little
 24 loop here, that is the treatment electrode; correct?
 25 A. That's the cutting loop, yes.

1 Q. And these lines here that go back to the
 2 resectoscope, those are current flux lines; correct?
 3 A. Yes.
 4 Q. And what is being depicted here is current flux
 5 lines between this loop and the flux lines going back to
 6 essentially a metal portion of this resectoscope; right?
 7 A. That's right.
 8 Q. And you already said that this is a monopolar
 9 embodiment; correct?
 10 A. For conventional -- yes.
 11 Q. What is depicted here is monopolar; right?
 12 A. Right.
 13 Q. There is no return electrode there, is there?
 14 A. Right.
 15 Q. What this is then showing is current flow through
 16 what must have been electrically nonconductive fluid
 17 because that is the fluid that was used in monopolar
 18 electrosurgery; correct?
 19 A. Actually, this diagram is not entirely correct,
 20 because what actually happens is you have current flux
 21 lines that flow back to almost all parts of the body,
 22 including at the endoscope.
 23 Q. But this is showing current flow through what must
 24 have been a nonconductive fluid because nonconductive
 25 fluids were used in monopolar TURP procedures; right?

1 A. It does show current flow. Like I said, it is not
 2 entirely correct.
 3 Q. But let's talk about the part that is correct. I
 4 think it's correct, isn't it, that this fluid that the tip
 5 of this device is in would have been essentially something
 6 like glycine or some similar electrically nonconductive
 7 fluid. You wouldn't in a monopolar device using saline
 8 or Ringer's lactate?
 9 A. The Europeans favor mannitol. But it could have been
 10 glycine.
 11 Q. In all events, it could have been glycine; right?
 12 A. That's correct.
 13 Q. Now, similar to the '198 patent, the Roos article
 14 doesn't use the word saline; correct?
 15 A. It uses washing liquid or washing fluid, something to
 16 that effect.
 17 Q. I think it's to that effect. The words are a little
 18 bit different. But he doesn't use saline; correct?
 19 A. He does not use saline.
 20 Q. He doesn't use Ringer Lactate or Lactated Ringer's?
 21 A. Correct.
 22 Q. I think what he does say, if you look at the English
 23 translation at Page 2, it's described as irrigation liquid;
 24 correct? About the middle of the page, sir.
 25 A. Yes. The irrigation liquid.

1 Q. And so that irrigation liquid would have been glycine
 2 or mannitol or some electrically nonconductive fluid;
 3 right?
 4 A. I think at this point, isn't he talking about his
 5 invention, the actual --
 6 Q. Well, this is a discussion of Figures 2, 3 and 4.
 7 And so we are talking here about a conventional approach;
 8 correct?
 9 A. Oh, I am sorry. Yes, you are right.
 10 Q. Fair enough.
 11 Now, just to anticipate maybe where you were
 12 going, if you turn to page and look at Page 4, I believe
 13 here he is talking about the bipolar embodiments; right?
 14 This is the beginning of that discussion?
 15 A. Yes, that's right.
 16 Q. And in Paragraph No. 1, at the very end of that
 17 sentence, he talks about the fluid that is used. Do you
 18 see that?
 19 A. Yes.
 20 Q. And he calls it irrigation liquid; right?
 21 A. Yes.
 22 Q. And those are the same words that he used to describe
 23 the fluid that was used for the monopolar embodiment on
 24 the previous page; correct?
 25 A. Yes. Not the same fluid, but yes.

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1 Q. He describes them using the exact same words,
 2 doesn't he?
 3 A. He uses the exact same words, yes. But that doesn't
 4 necessarily mean it's the same exact fluid.
 5 Q. The same words are used; right?
 6 A. Yes.
 7 Q. Now, let's go back to the previous page.
 8 A. Are we on Page 3 now?
 9 Q. I am sorry. I believe we are on Page 2. Again,
 10 this is the monopolar embodiment, so we know that it would
 11 be mannitol or glycine or some similar fluid; correct?
 12 A. That's right.
 13 Q. Now, if you look at the English language text for
 14 Figure 3 that we were looking at earlier, do you have
 15 that, at the very bottom of Page 2?
 16 A. Right.
 17 Q. And in that description, Mr. Roos and Mr. Elsasser
 18 are describing that current flows directly from the
 19 cutting loop to those parts of the resectoscope projecting
 20 into the irrigation fluid. Do you see that? That's in
 21 the text at the very bottom of Page 2.
 22 A. Yes.
 23 Q. So here in the article, Elsasser and Roos are talking
 24 about current flow in the monopolar embodiment; right?
 25 From the cutting loop back to the resectoscope; correct?

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1 A. Yes.
 2 Q. Let me shift gears and ask you some questions about
 3 the Doss '007 patent. Do you have that, sir? That's
 4 DTX-17.
 5 A. I have it in front of me, yes. Yes, I do.
 6 Q. And the Doss patent is one of the patents that you
 7 talked about on your direct examination with respect to
 8 the '536 patent; correct?
 9 A. Yes.
 10 Q. And the Doss patent is a patent that was actually
 11 cited during the prosecution of the '536 patent itself;
 12 right?
 13 A. I will take your word for it. There were a lot of
 14 patents that were cited and I don't have that in front
 15 of me. So I will take your word for it.
 16 Q. Why don't we actually show it.
 17 MR. BOBROW: why don't we pull up JTX-17
 18 BY MR. BOBROW:
 19 Q. And if you look in the U.S. patent document section,
 20 if you highlight that, you will see, I believe it's the
 21 fifth one down, it says, 4,381,007 to Doss.
 22 Do you see that?
 23 A. It is verified, you are right.
 24 Q. And so the document that you were describing earlier
 25 as the Doss patent, that patent was considered by the

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1 Patent Office in relation to the prosecution of the ' 536
 2 patent?
 3 A. That's correct.
 4 Q. And the '536 patent and its claims issued over this
 5 Doss patent; right?
 6 A. That's correct.
 7 Q. And the Doss patent also was given to the Patent
 8 Office in connection with the re-examination of the 536
 9 patent; correct?
 10 A. Once again, there were a lot of patents that were
 11 considered.
 12 Can you show me that, just so we can clarify
 13 it?
 14 Q. Maybe we will get to that a little later. Why don't
 15 we talk about what is actually in the Doss patent at this
 16 point?
 17 A. Okay.
 18 Q. Now, in the Doss patent, why --
 19 MR. BOBROW: why don't we put up Figures 7 and
 20 8?
 21 BY MR. BOBROW:
 22 Q. I think those were the figures that you had up
 23 earlier.
 24 In this patent, this was the figure that you
 25 had up earlier, right, just without the colors?

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1 A. Yes.
 2 Q. And now, in the text of this patent, the Doss patent,
 3 in the text of it, there is no description of any of the
 4 electrodes that are shown in this embodiment.
 5 They are never described as being a return
 6 electrode; correct?
 7 A. We specifically mentioned those words are not
 8 specifically used, return electrode?
 9 Q. That's correct.
 10 A. Yes.
 11 Q. Return electrode is not a term that is used here,
 12 is it, in the Doss '007 patent?
 13 A. Just hold on a second.
 14 I don't believe it's used.
 15 Q. Right. In fact, if you look at Column 4, it says,
 16 tubular electrodes 34 and 36, for example? There are
 17 other places, as well. But in each case where it
 18 describes the electrodes it calls them electrodes. It
 19 doesn't call them, for example, a return electrode;
 20 correct?
 21 A. No, it does not.
 22 Q. Now, in the various embodiments of the '007 patent,
 23 would you agree that each of the electrodes in this
 24 configuration is designed in a way that it will have a
 25 high current density at the tip?

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1 A. No, I would not.
 2 Q. All right. So just to be clear, your testimony is --
 3 let me ask it specifically again, just so it is clear.
 4 Would you agree with me that each of the electrodes in
 5 the figures of the Doss patent is designed in a way that
 6 will have a high current density? Do you disagree with
 7 that?
 8 A. When you say high, are you saying that both
 9 electrodes have high current densities. Is that your
 10 question?

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 2 Q. Each of the electrodes is designed in a way that
 3 will have a high current density. That's the question.
 4 A. I think the answer may be yes, but I think one of
 5 the electrodes will have a higher current density than the
 6 other.
 7 Q. That's not my question, sir.
 8 A. Okay. I understand.
 9 Q. My question is in this patent, for each embodiment,
 10 in each of the figures, is each of the electrodes designed
 11 in a way that will have a high current density?
 12 A. I'm not sure I agree with that.
 13 Q. Well, you recall I asked you about the Doss patent
 14 at your deposition, don't you?
 15 A. Yes.
 16 Q. And you had reviewed and studied the Doss patent
 17 before the deposition; right?
 18 A. Yes.
 19 Q. And again, the Doss patent was a reference that you
 20 talked about in your report; correct?
 21 A. Yes.
 22 Q. All right. Now, if you would please turn to Page 481
 23 of your deposition... That is in a white binder.
 24 A. Which day?
 25 Q. Pardon me?

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1 MR. BOBROW: Oh, no. Please don't.
 2 I apologize, your Honor. I didn't know that
 3 was going to be put up.
 4 THE COURT: Okay.
 5 BY MR. BOBROW:
 6 Q. This is in the second tab, Taylor deposition, March
 7 28, 2003. And this is Page 481.
 8 Do you have that sir?
 9 A. Yes.
 10 Q. And at Page 481, I asked you the following question
 11 and you gave the following answer.
 12 "Question: If you look at the figures in text
 13 of the Doss '007, would you agree that each of the
 14 electrodes in the embodiments described is designed in a
 15 way that it will have a high current density?"
 16 And in response to my question, you answered in
 17 your deposition:
 18 "Answer: Yes."
 19 Is that correct?
 20 A. Yes.
 21 Q. Now, in the devices in Doss, there are a number of
 22 them that are depicted; correct? Probably seven or eight
 23 figures; correct?
 24 A. There are a number of figures, yes.
 25 Q. And would you agree with me that in each of the

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1 embodiments, the current density of one of the electrodes
 2 is substantially the same as the current density of the
 3 other electrode or electrodes in that configuration?
 4 MR. BOBROW: Why don't we put Figure 7 back
 5 up?
 6 THE WITNESS: Can you -- are you going to put
 7 the figure back up?
 8 BY MR. BOBROW:
 9 Q. Well, actually, why don't you just answer the
 10 question, sir? Would you agree with me that each of the
 11 electrodes has substantially the same current density as
 12 the other electrode for any given one of the devices that
 13 is used or described in that patent?
 14 A. I don't think that's correct.
 15 Q. All right. Well, remember I talked to you about
 16 this in your deposition as well; correct?
 17 A. Right.
 18 Q. And you answered my question at that time under oath,
 19 didn't you?
 20 A. Yes, and I think I misunderstood your question, but
 21 that's --
 22 Q. All right. Well, we can get to that in just a
 23 minute. If you take a look, please, at Page 482 of your
 24 deposition.
 25 Do you have that, sir?

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1 A. Yes, I do.

2 Q. And at that time, I asked you the following questions
3 and you gave the following answer:

4 "Question: And in each of the embodiments
5 shown, would you agree that the current density in each of
6 the electrodes is substantially the same as each of the
7 other electrodes in the embodiment?"

8 And there was an objection by Mr. MacFerrin and
9 you gave the answer:

10 "Answer: Does that mean from one embodiment
11 to another or just within the same embodiment?"

12 "Question: Good question. Within the same
13 embodiment is what I meant, that the electrodes had
14 substantially the same current density?"

15 "Answer: It would appear that that is
16 correct."

17 That's the testimony you gave back on March
18 28th, 2003; correct?

19 A. That is testimony, and it is also a mistake.

20 Q. So you believe your testimony back then was mistaken;
21 is that correct?

22 A. I made an error, yes.

23 Q. Did you correct that mistake?

24 A. No, I was under the impression I could not correct
25 testimonial mistakes. I could only correct typographical

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1 errors or grammatical errors.

2 MR. BOBROW: Let's put Figure 7 up, okay?

3 BY MR. BOBROW:

4 Q. Now, here in this figure, this is the one you had up
5 earlier; right?

6 A. Yes, it is.

7 Q. And there are here at the tip of the device some
8 lines there. Do you see those?

9 A. Yes.

10 Q. Some dashed lines. And that's designed to represent
11 a current flux line; correct?

12 A. The dashed lines represent current flux, yes.

13 Q. Right. And would you agree here that this is
14 showing the current flux between these two electrodes;
15 right?

16 A. Yes.

17 Q. All right. And would you also agree that each of
18 the electrodes as shown here is designed to cause a tissue
19 effect, in this case in the eye?

20 A. Well, that's sort of goes to the heart of why I
21 think there is an error on my part.

22 Q. Well, but I would like you to answer my question,
23 please?

24 A. Okay. Repeat your question. I'm sorry. Repeat your
25 question.

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1 Q. Yes.

2 A. If you would, please.

3 Q. I was simply asking if each electrode in this probe
4 design is designed to cause a tissue effect. That's my
5 question.

6 MR. MARSDEN: Your Honor, objection. This goes
7 to an issue that dealt with claim construction. An issue
8 which your Honor made a ruling.

9 THE COURT: Well, why don't we take our lunch
10 early because I have to think about that one.

11 All right. Ladies and gentlemen, we'll take
12 our lunch, a half-hour, and I'll just remind you not to
13 discuss the case among yourselves.

14 (At this point the jury then left the
15 courtroom, and the following occurred without the presence
16 of the jury.)

17 THE COURT: All right. You may step down, sir.

18 Let's have the question again and the objection.

19 MR. BOBROW: I believe that the question was
20 simply whether each of the electrodes in the probe of the
21 Roos patent is designed to cause a tissue effect. And I
22 believe that that is quite relevant, your Honor, to the
23 claim construction here and to whether or not this device
24 discloses an active electrode and return electrode and
25 that's where the testimony is going.

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1 MR. MARSDEN: Right, that is where the
2 testimony is going. And they requested a claim
3 construction that the return electrode could not have a
4 tissue effect and your Honor rejected that construction,
5 so that's not a basis on which to say this is not a
6 return electrode. What your Honor ruled was that you look
7 at the current density, so that line of questioning was
8 appropriate, but the line of questioning regarding tissue
9 effect is not.

10 MR. BOBROW: But I believe the construction
11 does talk about the active electrode stimulating the
12 tissue so that is where this goes. I'm asking him whether
13 or not each of the electrodes has that tissue effect such
14 that you would have tissue stimulation. It's directly
15 relevant, your Honor.

16 THE COURT: So which claim construction are
17 you talking about?

18 MR. BOBROW: This has to do with the definition
19 of an active electrode and the return electrode. And the
20 definition of active electrode involves tissue stimulation.

21 MR. MARSDEN: It's 8 and 9, your Honor.

22 MR. BOBROW: And so I'm simply trying to
23 understand and get testimony from this witness about the
24 tissue stimulation effects that the different electrodes
25 have in this embodiment.

1 THE COURT: All right. Well, certainly the
2 definition of active electrode is a stimulating electrode,
3 but the definition of a return electrode doesn't say
4 stimulate, it just says it has a large area of contact to
5 avoid a low current density. The only question is
6 whether this, the question you are asking, is misleading
7 because it is maybe inconsistent with what I've said.
8 MR. BOBROW: But, your Honor, respectfully, I
9 am certainly trying not to be misleading. I believe we
10 are entitled to argue to the jury -- pardon me. I believe
11 that I should be allowed to argue to the jury. I request
12 the opportunity to argue to the jury that both of these
13 electrodes are active electrodes and that both of them
14 have that tissue stimulation effect, that both of them
15 have a high current density, that both of them have sharp
16 edges and the like which would make them tissue treatment
17 or tissue stimulation electrodes.
18 THE COURT: Well, if you are saying there is
19 no difference between the two, I mean I do believe that
20 under this definition there has to be a difference between
21 the active and the return. If you are saying and your
22 point is that in the Roos prior-art reference there is no
23 difference between the two, then that is an appropriate
24 line of cross.
25 MR. BOBROW: And that's what I'm trying to

1 establish by the testimony that both of these have a
2 tissue effect. I think you heard, your Honor, in the
3 course of the testimony that, for example, the accused
4 devices are designed in a way that the return electrode
5 is very benign, that it doesn't arc, that it's not
6 designed to remove tissue or what-have-you because of its
7 size and otherwise.
8 And it's ArthroCare's position that both of
9 these electrodes are active, that both of them have a
10 tissue effect, have high current density and stimulate the
11 tissue. That's where we're going with this. I believe
12 it's a fair line of questioning.
13 MR. MARSDEN: The tissue effect is not part
14 of the definition of return electrode, and I think the
15 argument there is no return electrode in this particular
16 prior-art reference and because it does, in fact, have a
17 larger area of contact and a lower current density, it
18 does meet the Court's definition of return electrode.
19 THE COURT: Well, that's argument.
20 MR. BOBROW: That's argument.
21 THE COURT: I think that is argument.
22 I'm working the jury instructions and verdict
23 form. I apologize if I'm not keeping up to speed with
24 you all, but I think it's a fair line of questioning. All
25 right.

1 MR. MARSDEN: Thank you.
2 THE COURT: Should we address the other issue?
3 MR. HEBERT: It's an issue Mr. Blumenfeld has.
4 THE COURT: Why don't we do that.
5 MR. BLUMENFELD: Your Honor, it's an issue I
6 raised this morning that Smith & Nephew advised us last
7 night that they intend to use with Mr. Raffle this
8 afternoon, the Ethicon license agreement and their antitrust
9 counterclaim. And when I asked Mr. Hebert this morning in
10 the hall whether he still intended to do that, he said yes,
11 because I had opened the door to that on my cross-
12 examination of Mr. Sparks. If I opened the door on the
13 Ethicon license and the antitrust counterclaim, I missed
14 it, and I guess it's to Mr. Hebert to explain how I did
15 that.
16 THE COURT: And what relevance it has in the
17 first instance.
18 MR. HEBERT: What this goes to, this is raised
19 in one of the motions in limine and ArthroCare moved in
20 limine to keep out evidence of the antitrust issues. Your
21 Honor conditionally granted that and said -- this is Item
22 No. 7 in motions in limine. It was granted so long as
23 ArthroCare does not introduce evidence regarding the
24 Ethicon license. And then the ruling goes on to deal with
25 the issue about the harmful effects which are talked about

1 here.
2 And Mr. Blumenfeld did get into this in cross-
3 examination of Mr. Sparks when he is asking him about a
4 Smith & Nephew document which talks about competition and
5 he directs him to that and he directs him to the portion
6 that discusses that Mitek and Stryker -- now, Mitek is a
7 division of Ethicon, so when it talks about Mitek, there
8 is no dispute about this, it's talking about Ethicon as
9 well. It's one and the same -- are paying royalties in
10 return for licensing the ArthroCare patents.
11 So that is what he was asking Mr. Sparks about
12 in his cross-examination. He was asking him if he knew
13 about the ArthroCare patents that were being discussed in
14 regard to that licensing point and document.
15 MR. BLUMENFELD: Your Honor, I have a
16 transcript. What I asked him, this is the question:
17 "Question: Under exceptive, at the top, if you
18 can highlight, in that section there is a reference to,
19 right in the middle, to key ArthroCare patents and I
20 highlighted the three words 'key ArthroCare patents.' Do
21 you see? It's the third line down.
22 "Answer: In that section?
23 "Question: At the top of the page.
24 "Answer: Right. I have got it.
25 "Question: Do you know what key ArthroCare

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1 patents were, what key ArthroCare patents were that Smith &
2 Nephew was referring to?"

3 That was my question and it had nothing to do
4 with licenses. I didn't ask about licenses. I haven't
5 asked anyone about licenses.

6 MR. HEBERT: But at the same time he asked the
7 question, he broadcast the marketing plan and highlighted
8 the portion of the marketing plan that talks about the
9 Mitek and Stryker paying royalties to ArthroCare in terms
10 of the licensing.

11 So that would be what we say would open the
12 door.

13 THE COURT: And what is the relevance of this
14 evidence in the first place, given the fact you have so
15 little time to present evidence in the second place?

16 MR. HEBERT: To undercut any suggestion that
17 the patents are strong because they're licensed. They're
18 licensed because of this very unusual relationship that
19 ArthroCare and Ethicon have entered into which gives rise
20 to the antitrust claim as opposed to any strength in the
21 patents.

22 It would only be a couple questions, two or
23 three questions.

24 THE COURT: Yes, but it's such a subtle point.
25 I don't believe that it's appropriate.

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1 All right. Let's take some time.

2 MS. BOYD: Your Honor, we would like to read
3 an Interrogatory response sometime before closing our case,
4 Interrogatory Response No. 7. We have an agreement, I
5 believe, from the other side.

6 THE COURT: Interrogatory Response No. 7?

7 MR. BOBROW: No objection.

8 THE COURT: All right.

9 MS. BOYD: Thank you.

10 (Luncheon recess taken at 1:10 p.m.)
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AFTERNOON SESSION

(Proceedings resumed at 1:30 p.m.)

6 THE COURT: All right. Let's bring the jury
7 in.

8 (At this point the jury entered the courtroom
9 and took their seats in the box.)

10 THE COURT: Mr. Bobrow.

11 MR. BOBROW: Thank you, your Honor. Good
12 afternoon, ladies and gentlemen.

13 BY MR. BOBROW:

14 Q. Good afternoon, Dr. Taylor.

15 A. Good afternoon.

16 Q. I believe that at the close of our session before
17 lunch, I had asked you a question, and there was an
18 objection to that. I think that issue has now been resolved.

19 Let me go back to that question. We were
20 talking about the Doss '007 patent; correct?

21 A. Correct.

22 Q. And I had asked you some questions, for example,
23 about Figure 7 of the Doss '007 patent. Do you recall,
24 that was the context for our discussion?

25 A. Yes.

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1 Q. And I asked you a question before lunch, and this is
2 the question I would now like you to answer: Is it true
3 that in the Doss '007 patent, that each electrode in each
4 of the probes is designed to cause a tissue effect, in
5 this particular case in the tissue of the eye?

6 A. Would you mind putting back the figures, the two
7 figures?

8 Thank you.

9 Q. So again, my question, sir, simply is, is each
10 electrode designed to cause a tissue effect?

11 A. Yes.

12 Q. Now, in this figure, we had talked about these
13 current flux lines before lunch.

14 Do you recall that?

15 A. Yes.

16 Q. And here -- and it's probably hard, given how shaky
17 I am with my pointer -- do you see that number 102?

18 A. Yes.

19 Q. And there is a region here right underneath this
20 electrode where it appears that the current flux lines
21 are not shown. Do you see that? Right in this region
22 here. Just above 102, it appears it is not showing a
23 current flux line in that region; correct?

24 A. That's correct, yes.

25 Q. Instead it is showing these flux lines going out

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1 this way, from here in this case the right to the left,
2 and here from the left to the right.

3 Do you see what I am talking about there?

4 A. Yes.

5 Q. Now, imagine, if you would, instead of pointing down
6 in this fashion, you sort of looked at it end on and you
7 looked at those current lines end on. Do you have that in
8 mind now?

9 A. Yes.

10 Q. And if the current lines were as they are depicted
11 here, going from this electrode to here and from this
12 electrode to here, essentially, those current flux lines
13 would look sort of like a donut; right?

14 In other words, you have a hole in the middle,
15 where there weren't current flux lines, then you would
16 have some current flux lines in sort of a donut shape.
17 Is that fair?

18 A. Yes. I am not sure exactly how the donut would look.
19 It might not look like a regular donut we are familiar
20 with. A toroid of some sort.

21 Q. And a toroid is basically just a ring; correct?

22 A. It's a three-dimensional ring, yes.

23 Q. It is sort of like a washer that you might use with
24 a nut and a bolt; it's got a hole in the middle and there
25 is sort of a ring with some mass around it?

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1 A. That's right. It's sort of a Thalman (phonetic)
2 washer.

3 Q. Why don't we take a look, then, at the Doss007
4 patent. Specifically Column 5?

5 A. Which one is that again?

6 Q. The DTX number is 17.

7 A. 17.

8 Q. Okay. Do you have that, sir?

9 A. Which one was it again?

10 Q. Column 5. The paragraph that I have interest in,
11 actually, starts around Line 27. It begins, Figures 7
12 and 8.

13 MR. BOBROW: Chris, do you have that?

14 THE WITNESS: Okay, I see it.

15 BY MR. BOBROW:

16 Q. All right. And here, this part of the Doss '007
17 patent is talking about the figure that you had up in
18 direct examination and the figure, in fact, that we just
19 had up and were talking about with these donut or toroid-
20 shaped lines; correct?

21 A. That's correct.

22 Q. If you take a look at about Line 43, there is a
23 sentence that says, quote, An advantage of this particular
24 electrode configuration is that a ring or torus-shaped
25 treatment region can be realized, since electric current

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1 flows essentially in a torus-shaped volume under and
2 between electrodes 72 and 74.

3 Do you see what I am referring to there?

4 A. Yes.

5 Q. Now, when it is referring there to a torus-shaped
6 volume, that is referring to the volume of tissue that
7 is being treated in this case by the electrosurgical
8 energy of this device; right?

9 A. That's what it would imply, yes.

10 Q. And the Doss patent is generally describing an
11 electrosurgical device that is designed to use this
12 current to provide some heating within the corneal and
13 other tissues of the eye; correct? It is supposed to
14 provide some deep heating, essentially?

15 A. Heating. I am not sure I would characterize it as
16 deep. It is designed to shape the cornea.

17 Q. So what this is saying then -- if we could back to
18 Figure 7 -- is that both of these electrodes here, which
19 it describes as electrodes 72 and 74, in each of these
20 regions, one to the left and one to the right, you will
21 have as a result of the current flow between those
22 electrodes a region of tissue that has been warmed or
23 heated and thereby treated within the eye, in this torus
24 shaped fashion; is that right?

25 A. Correct.

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1 Q. Now, on the direct examination, you had said that
2 this Doss patent anticipates Claim 45 and -- and the
3 dependent claims with respect to the '536 patent; correct?

4 A. Yes.

5 Q. And one of the limitations of Claim 45 of the '536
6 patent, and thus a limitation in all of the claims that
7 depend from it, is the limitation that provides that you
8 have a connector near the proximal end of the shaft.

9 Do you recall that?

10 A. Right.

11 Q. And the proximal end of the shaft is sort of the
12 back part of the shaft, not the tip of the device that
13 you would be inserting in towards the tissue treatment
14 area, but removed from that towards the back; correct?

15 A. Yes.

16 Q. And here in the Doss '007 patent, would you agree
17 with me that there is no disclosure of where the connector
18 is located, in other words, there is nothing that tells
19 you where the connector is located with respect to the
20 shaft?

21 A. Hold on a second.

22 I believe that's correct. There is no
23 specific mention of the location of that.
24
25

1
2 Q. Okay. Now, you had also mentioned that you believe
3 that the Doss '007 patent anticipated some of the claims
4 of the '592 patent.

5 Do you recall that?

6 A. Yes.

7 Q. And I think that one of those claims was Claim 21 of
8 the '592, which talks about a voltage in the range of
9 from 500 volts to 1400 volts peak to peak; is that right?

10 A. Yes, that's the language I remember. Yes.

11 Q. And it's your testimony that the Doss '007 patent
12 necessarily discloses a voltage in the range of 500
13 volts peak to peak. Is that true?

14 A. I think it does disclose that range, yes.

15 Q. And the portion of the patent you base that
16 testimony on was a passage at the very beginning of the
17 text of the patent that talks about the voltage being
18 between about 20 and 200 volts RMS; correct?

19 A. That's correct.

20 Q. What did you when you did your calculation to go
21 from an RMS - that stands for roots means square, does it
22 not?

23 A. Sure does.

24 Q. So to go from the root means square voltage to the
25 peak to peak voltage, you multiply the 200 that is set

1 A. However, it could be used with a sine wave
2 generator.

3 Q. But it could be used with a square wave generator?

4 A. Could be.

5 Q. And square wave generators are known in the
6 electrosurgical art, aren't they?

7 A. They are but not necessarily practiced.

8 Q. In fact, one of the references, the Slager reference
9 actually used a square wave generator?

10 A. Yes, it did.

11 Q. That was in the electrosurgical context; right?

12 A. Yes.

13 Q. So in terms of what is actually disclosed in the
14 Doss patent, we don't know whether it was a sine wave or
15 a square wave or something else. True?

16 A. True.

17 Q. Now, if you are calculating the peak-to-peak voltage
18 from the root-means-square voltage, if the waveform in
19 Doss were a square wave, when you go from 200 volts RMS
20 to peak to peak, that's 400, isn't it?

21 A. Actually, if you actually use the correct formula of
22 the root-means-square calculation, which it's an
23 integrations calculus, it depends whether or not the
24 period of the square wave is equal.

25 But if you make the assumption -- let me

1 forth in the page by 2.83 and that gets your north
2 someplace of about 568 volt peaks to peak; right?

3 A. Roughly.

4 Q. Now, in terms of calculating the peak to peak
5 voltage, isn't you true that you need to know the waveform
6 that the generator is producing?

7 A. Yes, you do.

8 Q. You need to know whether it's a sine wave, whether
9 it's a square wave or some other waveform; is that correct?

10 A. That's correct.

11 Q. And there is nothing in the Doss patent that says
12 that a sine wave is used with this generator; correct?

13 A. That's correct.

14 Q. So we don't know whether there is a sine wave here
15 or a square wave or some other waveform; right?

16 A. You're correct. But, to my knowledge, there are no
17 commercially-available square wave generators.

18 Q. But you don't know what Mr. Doss may have been
19 working with in his lab or what you have when he was
20 writing this application, do you?

21 A. No.

22 Q. And whether it's commercially available or not isn't
23 the test, is it?

24 A. No, it's not the test.

25 Q. All right.

1 finish -- if you make the assumption that is an equal
2 period, I think that formula is correct. But, frankly,
3 I haven't done the math.

4 Q. Okay. But it's your best understanding here that
5 if you have a square wave where the waveform is symmetric
6 and you go from RMS to peak to peak and it's a square
7 wave, then the Doss patent would be disclosing
8 approximately 400 volts peak volts peak to peak; right?

9 A. Yes, according to your formula. Now, like I'd said,
10 I haven't done the math, but I'll presume that you have and
11 that you're correct.

12 Q. Now, you have a background in electrical engineering;
13 is that right?

14 A. Yes.

15 Q. Now, let me ask you now a few questions about the
16 Pao '499 patent. And this was another patent that you
17 discussed this morning on your direct examination with
18 respect to the '536 patent.

19 Do you have that, sir?

20 A. Yes, I have it.

21 Q. Now, the Pao patent, '499 patent, which is DTX-21,
22 this was one of the patents that was also in front of the
23 Patent Office during the prosecution of the '536 patent;
24 correct?

25 MR. BOBROW: Why don't we call that up, Chris?

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1 THE WITNESS: Yes.
 2 BY MR. BOBROW:
 3 Q. All right. And if you take a look down there maybe ten
 4 items down, you see 4,674,499, Pao?
 5 A. Yes.
 6 Q. And that's DTX-21?
 7 A. Yes, it is.
 8 Q. And this same patent also was before the Patent
 9 Office in connection with the re-examination -- is that
 10 right -- of the '536 patent?
 11 A. I believe so, yes.
 12 Q. And with respect to the '536 patent, of course, the
 13 Patent Office granted ArthroCare's '536 patent over the
 14 Pao '499 patent; right?
 15 A. Yes. And that's probably one of the reasons why
 16 we're here today.
 17 Q. Now, as far as the Pao patent, I believe that you
 18 had shown earlier a couple of figures from the Pao patent.
 19 Why don't we pull up in the patent the figure that I think
 20 you had up, which I think was Figure 9.
 21 MR. BOBROW: Can you call that up, please,
 22 Chris?
 23 And why don't you highlight Figure 9 on that
 24 page?
 25

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1 BY MR. BOBROW:
 2 Q. All right. And is that the figure, sir, obviously
 3 with colors added that you were using during your direct
 4 examination?
 5 A. It was one of the figures, yes.
 6 Q. And actually, the Pao '499 patent describes a number
 7 of different device configurations, doesn't it?
 8 A. It does.
 9 Q. And it looks like there are 12, 13, 14, some odd
 10 number of figures. There is a fair number. But would you
 11 agree with me, sir, that the instruments that are described
 12 here in the Pao patent all have what is called a coaxial
 13 configuration?
 14 A. In terms of the electrode configuration?
 15 Q. Yes.
 16 A. Yes.
 17 Q. By coaxial, we know they're saying out certain tube
 18 and within that tube is another one of the electrodes;
 19 correct?
 20 A. That's correct.
 21 Q. So the outer electrode serves -- I'm sorry -- the
 22 outer tube served as an electrode and the inner one does
 23 as well?
 24 A. Yes.
 25 Q. And we call that coaxial in the electrosurgical area;

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1 correct?
 2 A. Yes.
 3 Q. If you would, please, let's take a look at Column 9
 4 of the '499 patent and specifically there is a paragraph
 5 that begins about Line 48 and runs down to about 63.
 6 MR. BOBROW: Chris, if you could highlight that,
 7 please...
 8 BY MR. BOBROW:
 9 Q. All right. And we have the text up. I'm sorry, sir.
 10 Do you have that page?
 11 A. I'm sorry. You said Column 8 or 9?
 12 Q. 9, I believe, is where we are. And we're at --
 13 A. Oh, yes. Okay. I'm sorry.
 14 Q. No problem. So that paragraph begins, quote, The
 15 coaxial bipolar probes of the present invention are used
 16 generally as follows.
 17 Do you see what I'm referring to there?
 18 A. Yes.
 19 Q. And so what is being described here is the use of
 20 the various probes, and there are a number of them, but
 21 the various probes are coaxial in this patent; right?
 22 A. Yes.
 23 Q. And as you move down in this paragraph, about Line
 24 58, there is a sentence that says, quote, The end of the
 25 probe region is placed against the tissue causing the

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1 first ends of the axial and outer electrodes respectively
 2 to come into contact with the tissue. Electrical current
 3 then flows through the tissue between the axial and outer
 4 electrodes.
 5 Do you see that, sir?
 6 A. Yes.
 7 Q. Now, here in this passage, when it is talking about
 8 the, first of all, the axial electrode, that's talking
 9 about the active electrode; is that right?
 10 A. Yes.
 11 Q. And we're referring here to the outer electrodes.
 12 In your view, that would be the reference to the return
 13 electrode here. The outer one of the electrodes in this
 14 coaxial configuration; is that right?
 15 A. That's my view, yes.
 16 Q. And here in this text, where it's describing the
 17 operation of the coaxial probes, it says that, in effect,
 18 then the axial and the outer electrodes come into contact
 19 with the tissue; right?
 20 A. Yes.
 21 Q. And so, if you're interpreting the outer electrodes
 22 as being a return, that means there the return electrode
 23 as described in this paragraph is in contact with the
 24 tissue; right?
 25 A. Yes. And this is one description how it could be

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1 used, but there are other descriptions where the outer
 2 electrode and return electrode does not contact tissue.
 3 Q. We can come to that; but here, this is actually
 4 describing how these are devices are used. That's up at
 5 Line 48. It says are used generally as follows; right?
 6 A. But it doesn't say exclusively used, but it does say
 7 used generally as follows.
 8 Q. And the way it's generally used is with both
 9 electrodes contacting the tissue?
 10 A. I'm not sure I would go there, but that's -- that is
 11 one way of it being used.
 12 Q. All right. And then it says the electrical current
 13 then flows through the tissue between the axial and the
 14 outer electrodes; right?
 15 A. Yes.
 16 Q. And it says it then flows immediately after saying
 17 that both the active and the return are in contact with
 18 the tissue; correct?
 19 A. In this description of its use, yes.
 20 Q. So in this description of its use, what it's
 21 essentially saying is that you put the active and the
 22 return in contact with tissue and then the current then
 23 will flow between those two electrodes through the tissue;
 24 right?
 25 A. And this is one way, yes. The answer to your

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1 question is yes, and this is one way you use the device.
 2 It's not the only way.
 3 Q. All right. Now let's take a look, if we might, at
 4 Column 3 of the same patent.
 5 And if you look at Column 3 at about Line 11,
 6 going to about Line 15...
 7 Do you see what I'm referring to?
 8 A. Does that start with, The probe region?
 9 Q. Yes, The probe region.
 10 Do you see that?
 11 A. Yes.
 12 Q. And the probe region in these devices is talking
 13 about the end of the devices, right, where the active
 14 and return electrodes are?
 15 A. I think in this particular patent, they're actually
 16 referring to the entire probe. So the entire metallic
 17 part of the shaft going from the distal end up to where
 18 the handle spot is.
 19 I think that's what they mean, but I could be
 20 wrong.
 21 Q. But around Lines 11 to 15, there is, once again, a
 22 reference to tissue contact being made.
 23 Do you see what I'm referring to there?
 24 A. Lines 11 to --
 25 Q. About Line 15.

1 A. Yes.
 2 Q. And now if we go over to Column 8, at about Line 53,
 3 there is a discussion there about Figure 12.
 4 A. What column? What line?
 5 Q. Column 8, Line 53 going down to about 60.
 6 And perhaps -- do you have that language, sir?
 7 A. The preferred probe? That one? Yes.
 8 Q. Right. And here in the description of Figure 12,
 9 it talks about inserting the probe through a small limbal
 10 incision in the cornea and that it's placed in firm
 11 contact with the nucleus 300, as shown in Figure 12.
 12 Do you see that?
 13 A. Yes.
 14 Can I look at the figure for a second?
 15 Q. Yes?
 16 MR. BOBROW: Why don't we put Figure 12 up,
 17 please?
 18 BY MR. BOBROW:
 19 Q. Now, Figure 12 is a diagram of the human eye; right?
 20 A. Well, yes. Part of it, yes.
 21 Q. Sure. And over here, from, going from right to
 22 left, that's the probe; right?
 23 A. Right.
 24 Q. And here, this circle labeled 300, what is that?
 25 A. That's the nucleus of the eye -- nucleus of the lens,

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1 I should say.
 2 Q. Okay. And this device is shown to be inserted
 3 within the volume of the eye. Is that true?
 4 A. Yes.
 5 Q. What is the nucleus made of?
 6 A. I can't tell you the exact tissue description, but
 7 it's tissue, probably collagen and some other stuff.
 8 Q. So the nucleus of the eye is a form of tissue;
 9 correct?
 10 A. Yes.
 11 Q. And tip of this probe here, the reason it's shown in
 12 a dashed phantom way like that is because it's being
 13 inserted into a solid object; right?
 14 A. Yes.
 15 Q. And that solid object in this case is tissue?
 16 A. Yes.
 17 Q. Now, let me turn, if I might, to another reference --
 18 that you had talked about a bit earlier today, which is the
 19 Slager reference, which is DTX-65.
 20 A. I have it.
 21 Q. Do you have that, sir?
 22 A. Yes.
 23 Q. And I believe that earlier today you had testified
 24 that various claims of the '882 patent and the '592
 25 patent were anticipated by the Slager reference; is that

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1 correct?
 2 A. Yes, I did.
 3 Q. Okay. And you didn't say that Slager was relevant
 4 to the '536, but that it was relevant to '882 and to '592?
 5 A. That's correct, yes.
 6 Q. Now, in the Slager article, there are two tests that
 7 are being described here; right? One being done in vitro
 8 and one being done essentially in vivo in a pig; is that
 9 right?
 10 A. Yes.
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 2 Q. And the portions of this article that you were saying
 3 were relevant to the '882 and the '592 patent related to
 4 the in-vitro test; correct? Not to the test on the pig?
 5 A. You said the in-vitro test?
 6 Q. I did.
 7 A. Yes.
 8 Q. Okay. The in vitro means what in this article?
 9 A. In vitro means it's outside the body, generally in a
 10 dish preparation of some sort. I guess it's the opposite
 11 of in vivo, which is inside the body.
 12 Q. So the tests that were being done here, when they
 13 described the tests as being in vitro, those are outside
 14 a patient's body; correct?
 15 A. Outside anybody's body, any animal's body.
 16 Q. Or human being?
 17 A. Well, I hope animals.
 18 Q. Fair enough. For the context that brings us here,
 19 what is being described here as in vitro is something that
 20 is not done in a living human patient; correct?
 21 A. That's correct.
 22 Q. Instead it is typically done in some sort of dish,
 23 bowl, in a laboratory; right?
 24 A. In some preparation or another, yes, a dish.
 25 Q. What is being described here in the Slager article

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1 is that some pieces of aortic tissue from an aorta, from
 2 a cadaver were taken and were put into some sort of a
 3 dish; correct?
 4 A. Yes.
 5 Q. Then I think that you mentioned earlier that there
 6 was some saline that was administered and then put into
 7 that same dish; correct?
 8 A. Yes.
 9 Q. Now, there is no indication, is there, as to how
 10 the saline got into the dish; right?
 11 A. Well, it has to be poured in. It doesn't just
 12 magically appear. It is not specifically said in the
 13 article that somebody poured in or delivered to the dish
 14 the saline.
 15 Q. And certainly, there is nothing in here that says
 16 that the fluid was supplied to the dish through the
 17 electrode that was put in contact with the tissue; right?
 18 A. That's correct.
 19 Q. And in terms of describing the setup for this Slager
 20 reference, where you have a dish, you have some tissue in
 21 the dish, you have some fluid that somehow got there, and
 22 then you have an electrode that gets put onto the tissue,
 23 then you apply energy, supply it from a generator, you
 24 would agree with me, wouldn't you, that that is describing
 25 an electrosurgical system?

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1 A. I am sorry. Can you repeat the question?
 2 Q. Sure. What I am asking, sir, is in this experiment,
 3 where you have a dish, you have some tissue in the dish,
 4 you have saline that has been put into the dish, you bring
 5 an electrode in contact with the tissue, and you apply
 6 energy in a generator, that is describing an
 7 electrosurgical system. True?
 8 A. Yes.
 9 Q. And it's describing an electrosurgical system even
 10 though we don't have any idea how the fluid got into the
 11 dish; correct?
 12 A. That's right.
 13 Q. And it's an electrosurgical system even though the
 14 fluid didn't come in through the electrode that is
 15 described here in Slager; correct?
 16 A. Yes.
 17 Q. Now, in this Slager patent -- I am sorry, it is not
 18 a patent, it is a paper. In the Slager paper, there is
 19 another experiment that is described as we had mentioned
 20 that is in a -- that was done in a pig; correct?
 21 A. Yes.
 22 Q. And they call that the in vivo test; right?
 23 A. Yes.
 24 Q. And in that particular test, the article says that
 25 there was a subcutaneous needle, ten centimeters long,

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1 Q. Yes.
 2 A. Most likely you would, yes.
 3 Q. Now, you also had mentioned that the Slager article
 4 talks about suction. I think this was in reference to
 5 Claim 54 of the '882 patent that has in it this
 6 requirement that there be evacuation of fluid; correct?
 7 A. Yes.
 8 Q. And if you take a look at the last page of the
 9 article, the second paragraph down, over on the left-hand
 10 side, it says one of the areas deserving further attention.
 11 Do you see that?
 12 A. Yes, I do.
 13 Q. And in this part of the article, it is talking about
 14 bubbles being generated when this device is used; right?
 15 A. Yes.
 16 Q. And so it says that one could look into using a,
 17 quote, suction technique, do you see that, to solve the
 18 problem of the bubbles; right?
 19 A. Yes.
 20 Q. And in terms of this suction technique, the suction
 21 technique that is described here, it doesn't say where
 22 the suction lumen would be that is performing the suction;
 23 right?
 24 A. It does not.
 25 Q. It doesn't even say what it is that is going to be

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1 used to suck away the bubbles, does it?
 2 A. No.
 3 Q. So we don't know from this description whether the
 4 suction would be taking place through a lumen that is
 5 adjacent to an electrode, do we?
 6 A. No, we don't.
 7 Q. Now, I had some questions for you, also, about the
 8 Manwaring patent. Actually, let's stay on Slager for
 9 just a minute, because I think I forgot to ask you a
 10 question. To do that, I think I am going to need to put
 11 up one of the claims from the '592 patent. Here at the
 12 very top, we have Claim 23, and this says a method for
 13 applying electrical energy to a target site on the body
 14 structure that is on or within a patient's body.
 15 Do you see that?
 16 A. Yes.
 17 Q. And it looks like that box over there was checked
 18 in black, do you see what I am referring to?
 19 A. Yes.
 20 Q. Now, would you agree with me that in the Slager
 21 article, in the in vitro test we were talking about, the
 22 energy was being applied to aortic tissue that had been
 23 taken from a cadaver a couple of days before; is that
 24 right?
 25 A. I am not sure about the time. It was taken from a

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1 cadaver.
 2 Q. And the energy wasn't being applied to a patient,
 3 was it?
 4 A. Well, from the perspective of a patient being
 5 referred to as someone that is alive, that's correct.
 6 Q. And so in terms of the tissue, there was a cadaver,
 7 the tissue was taken from the cadaver, placed into a dish;
 8 right? And then energy was applied to it there. It wasn't
 9 on an animal or a human being or what-have-you at the time;
 10 right?
 11 A. Right, yes. The tissue was not living tissue. It
 12 was human tissue, but it wasn't living tissue.
 13 Q. It wasn't living tissue and it wasn't on the patient's
 14 body when the energy was applied; correct?
 15 A. That's true. The reason I am hesitating is, the
 16 aorta is part of your body.
 17 Q. I am not saying it's not tissue. My question is,
 18 when the energy was applied, it wasn't on a patient's body.
 19 Is that true?
 20 A. That's true.
 21 Q. Now let's take a look at the '882 patent. You had
 22 mentioned that the Slager article is also relevant to
 23 Claim 1 of the '882 patent; right?
 24 A. Yes.
 25 Q. And again here, we have the Slager article has a

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1 checkmark by it next to this language from Claim 1;
 2 correct?
 3 A. Yes.
 4 Q. And the language there is a method for applying
 5 energy to a target site on a patient body structure
 6 comprising.
 7 Do you see that?
 8 A. Yes.
 9 Q. And once again, the tissue to which the energy was
 10 applied in the Slager article was no longer part of a
 11 living human being; correct?
 12 A. Correct.
 13 Q. The tissue at that point in time was dead; right?
 14 A. Correct.
 15 Q. And so there wasn't any application of energy to a
 16 patient, was there?
 17 A. No.
 18 Q. Did you hear Mr. Marsden's opening statement?
 19 A. Yes. But that's been some time ago.
 20 Q. But do you recall that Mr. Marsden was suggesting
 21 that Smith & Nephew didn't infringe the method claims
 22 itself because it was in the business of making and
 23 selling these devices, not using them; correct?
 24 A. That's correct.
 25 Q. And not using them on patients; right?

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1 A. That's correct.
 2 Q. And so he was saying that they didn't, Smith &
 3 Nephew didn't infringe these method claims because they
 4 didn't perform the surgeries themselves on patients'
 5 bodies; right?
 6 A. That's correct.
 7 Q. Would you agree with him that if you are not using
 8 the device on a patient's body, that you are not
 9 infringing Claim 1 of the '882 patent or the method claims
 10 of the '592 patent?
 11 A. Yes.
 12 Q. Now, since we have the '882 up, let me ask you some
 13 questions about the Manwaring reference. This is the
 14 '138 patent. And I apologize, sir, I believe that's
 15 DTX-46.
 16 A. I have it.
 17 Q. Now, as far as the Manwaring patent goes, once
 18 again, in connection with your work as an expert in this
 19 matter, when you prepared your expert report, you didn't
 20 perform tests using the Manwaring device to see whether
 21 or not it emitted photons in the ultraviolet light;
 22 correct?
 23 A. That's correct.
 24 Q. Now, when you were analyzing the Saphyre bipolar
 25 ablation probes, I take it that you also didn't do a test

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1 back at that time to determine whether or not those
 2 emitted UV light, either, did you?
 3 A. When you say analyzing, are we talking about the
 4 experiments I did?
 5 Q. Your use of the device prior to the time you
 6 submitted your expert report, you didn't look at whether
 7 those devices did or didn't emit ultraviolet photon either.
 8 Is that true?
 9 A. That's correct, yes.
 10 Q. Now, taking a look here at the Manwaring '138 patent,
 11 why don't we pull up Figure 5?
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1
 2 Q. (Continuing) And Figure 5 is a closeup of the tip of
 3 the Manwaring device; correct?
 4 A. Yes.
 5 Q. And there is a little region there that, here, where
 6 the tip, it says it's in a fluid-filled medium; is that
 7 right?
 8 A. Yes.
 9 Q. And then here, Item 36, we have the tip of an
 10 electrode; correct?
 11 A. Yes.
 12 Q. And then over here, it says tissue over to the right-
 13 hand side; correct?
 14 A. Yes.
 15 Q. Now, in column 7 of this patent, there is a
 16 discussion about using an embodiment of this device where
 17 fluid is not delivered through the device to the tissue;
 18 correct?
 19 That's at Column 7 around Line 19?
 20 A. Oh. Column 7 says -- okay. Column 7, Line 19.
 21 Q. Right. That says if the source of pressurized fluid
 22 as illustrated in Figure 2 were omitted; correct?
 23 A. Yes.
 24 Q. Now we're talking about fluid not being delivered
 25 to the region of the body that is being treated here;

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1 right? We're not affirmatively delivering the fluid?
 2 A. That's right.
 3 Q. And so it says for this device to work, you need to
 4 essentially suck some of the fluid, it might be the
 5 cerebral spinal fluid, that's in the working field into
 6 the tip of the device; correct?
 7 A. Yes.
 8 Q. And when you suck that fluid into the tip of the
 9 device, that fluid is going to be in the vicinity of the
 10 tip of the electrode.
 11 MR. BOBROW: If we can put up Figure 5 again...
 12 BY MR. BOBROW:
 13 Q. Right. So here we have Figure 5, and if some fluid
 14 is drawn in, the fluid is going to be in this region here,
 15 right next to this No. 36 of the probe; right?
 16 A. Yes.
 17 Q. And the fluid that is going to be brought into the
 18 tip of that tube is going to be in the vicinity of the
 19 tissue, if that you are trying to treat this tissue here
 20 that is shown here in Figure 5; right?
 21 A. Yes. But presumably it could also be from areas
 22 that are outside of that specific location.
 23 Q. Right. But you are not going to take the fluid
 24 from this region at the tip and suck all of the fluid way
 25 over here, way up into the device and leave no fluid down

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1 at the tip, are you? You're going to suck fluid in, so
 2 that electrode tip has some fluid in contact with it;
 3 right?
 4 A. Oh, yes.
 5 Q. And that fluid that you suck in, there is going to
 6 be some fluid right there at the tip of the device and
 7 right there on the tissue and you are going to apply
 8 energy to that; right?
 9 A. Let me see if I understand what you are saying.
 10 Are you saying there will be fluid inside this space here?
 11 Q. Yes.
 12 A. Is that what you are saying?
 13 Q. At the very tip of the device, when you suck some
 14 of the fluid in, you will have fluid at the very tip of the
 15 device?
 16 A. Yes.
 17 Q. And then you will apply some energy to that; right?
 18 A. Yes, when you operate the device. Yes.
 19 Q. Right. And then when you apply the energy, you get
 20 sparking; right?
 21 A. Yes.
 22 Q. And then what this patent tells you is that you get
 23 the sparking and that sparking then leads to the
 24 vaporization of the fluid; correct?
 25 A. In this particular -- yes. Yes.

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1 Q. All right. Now, you had mentioned before that you
 2 had some question, and I think it was your opinion that
 3 if this claim, the '882 patent, if it's valid, then you
 4 had, it was your opinion that it wasn't enabled; right?
 5 I think you offered that opinion this morning on your
 6 direct examination? Or did I get that wrong?
 7 A. Without getting into the legal terms here, if that
 8 patent is valid, it applies to a lot of other devices
 9 that are process devices.
 10 Q. Okay. Now, in connection with your work on this
 11 matter, how many hours have you spent on this matter up
 12 through today?
 13 A. Up through today?
 14 Q. Sure.
 15 A. It's between three and four hundred.
 16 Q. And all of those three and four hundred hours were
 17 compensated at \$150 an hour?
 18 A. That's correct.
 19 Q. And you've been paid by Smith & Nephew for your work;
 20 is that correct?
 21 A. That's correct.
 22 Q. Now, in connection with your three and four hundred
 23 hours of work you spent on this matter, did you attempt to
 24 build a device that would embody Claim 1 of the '882
 25 patent? Did you try to build it?

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1 A. Since the Codman ME 2 device essentially practices
 2 Dr. Manwaring's patent, I didn't have to. I could buy one.
 3 Q. But you didn't buy one?
 4 A. No.
 5 Q. So I'm asking you, sir, whether you built one?
 6 A. Oh. No.
 7 Q. Okay. You didn't try to build a device that -- using
 8 the specification and the like, try to build a device that
 9 would be consistent with the teachings of the patent?
 10 That's all I'm asking.
 11 A. Yes, but let me be clear. We're talking about
 12 building a device that would practice the corrected Claim
 13 1?
 14 Q. Good question. The answer is yes. Did you attempt
 15 to build the device that would practice the corrected
 16 Claim 1 at the time you were doing your work, on your
 17 expert report? Did you build such a device?
 18 A. No. Because I already developed devices that meet
 19 that.
 20 Q. But you didn't try to build one yourself?
 21 A. I got one sitting on my shelf on my bookcase at
 22 home.
 23 Q. You didn't build one, sir? Could you answer the
 24 question?
 25 THE COURT: Please just answer the question.

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1 THE WITNESS: No, I did not.
 2 I thought I already answered the question.
 3 BY MR. BOBROW:
 4 Q. So now, as far as the teachings of the '882 patent
 5 go, would you agree with me there is a discussion in the
 6 '882 patent of some of the preferred ways of trying to
 7 practice Claim 1 of the '882 patent?
 8 A. Yes.
 9 Q. Would you agree with me there are preferred voltage
 10 ranges that are set forth?
 11 A. Do you mind if I go back to the patent?
 12 Q. Please.
 13 A. Yes.
 14 Q. And in addition to preferred voltage ranges, there
 15 are preferred materials with instruction for the electrode;
 16 correct? The active electrode?
 17 A. Yes.
 18 Q. If you take a look, sir, at the bottom of Column 16?
 19 A. I found it, yes.
 20 Q. And it says, it refers to metals like titanium and
 21 platinum.
 22 Do you see that?
 23 A. Yes.
 24 Q. And this also gives preferred frequencies; correct?
 25 A. Yes, it does.

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- 1 Q. And that's at Column 13; right?
- 2 A. Yes.
- 3 Q. And the voltage range, the preferred ones are also
- 4 set forth in Column 13, aren't they?
- 5 A. Yes.
- 6 Q. There is also a preferred fluid that is supplied
- 7 and that's in Column 12, right, at around Line 38.
- 8 A. Yes.
- 9 Q. And it also provides preferred power levels; right?
- 10 A. Can you direct me there so I don't --
- 11 Q. I can. I'm sorry. This is at the top of Column 14.
- 12 There is a range preferred power levels.
- 13 A. Yes.
- 14 Q. And also there are preferred contact surface area
- 15 values for the active electrode in Column 15; right?
- 16 A. Yes.
- 17 Q. And there are preferred distances from the tissue
- 18 that are set forth at the bottom of Column 15; right?
- 19 A. Yes.
- 20 Q. Now, in connection with your work in this field of
- 21 electrosurgery, I think you testified that you had a
- 22 couple of patents that had issued to you. I think you
- 23 said five?
- 24 A. Five total, two in electrosurgery.
- 25 Q. And in connection with the patents that you have

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- 1 been involved in writing, I take it it's true that when
- 2 you were writing those patents, you would say what you
- 3 believe to be a preferred way of practicing the inventions
- 4 that you had come up with, right?
- 5 A. That's correct.
- 6 Q. And did you that so that could give some guidance
- 7 to people who were reading the patent once the patent
- 8 expired how to duplicate the device; right?
- 9 A. Right.
- 10 Q. And it's your expectation, isn't it, that a person
- 11 of skill in the art in looking at a patent would look at
- 12 what the patent itself, the preferred ranges, the preferred
- 13 materials, the preferred voltages and the rest to try to
- 14 figure out how to practice the invention; correct?
- 15 A. I would expect they would use that as their starting
- 16 point, yes.
- 17 Q. Now, sir, I heard your testimony earlier and you
- 18 had mentioned that you had actually used some of the
- 19 accused products at the Smith & Nephew, I think it's called
- 20 a bioskills lab; is that right?
- 21 A. Yes.
- 22 Q. And where is that? That's in Massachusetts?
- 23 A. Yes, Massachusetts. Mansfield.
- 24 Q. And you went out to that facility and had a chance
- 25 to use the accused -- the products, the use of which use

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- 1 infringes the patents; correct?
- 2 A. Yes, the accused products. Yes.
- 3 Q. Fair enough. And in terms of the use of that, you
- 4 were being assisted in your use by a laboratory manager;
- 5 correct?
- 6 A. Yes.
- 7 Q. There was somebody from there from Smith & Nephew
- 8 who was assisting you with the setup of the experiment
- 9 and the operation of the devices; correct?
- 10 A. That's correct.
- 11 Q. And you had a chance to use, at a very minimum, the
- 12 Saphyre; correct?
- 13 A. I used all three products, but I did use the Saphyre.
- 14 Q. And when did you these tests, there were recordings
- 15 made of what was going on inside of this cadaver shoulder
- 16 where the experiments were taking place; right?
- 17 A. That's correct.
- 18 Q. And that was done through some sort of a scope;
- 19 correct?
- 20 A. Well --
- 21 Q. There was a little video camera?
- 22 A. Yes. There was a little video camera that was
- 23 attached to the scope and that did the recording.
- 24 Q. When you did the recordings, those were actually
- 25 permanently recorded onto a CD; correct?

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- 1 A. Yes.
- 2 Q. And you ended up saving that data and producing it
- 3 in connection with this case; correct?
- 4 A. Yes.
- 5 Q. And in forming your opinion about how the devices
- 6 work, you actually considered that information in
- 7 determining whether or not there was or wasn't
- 8 infringement by the accused products; right?
- 9 A. Yes.
- 10 MR. BOBROW: May I approach, your Honor?
- 11 THE COURT: Yes, you may.
- 12 BY MR. BOBROW:
- 13 Q. I'm simply showing you, and I know you can't look
- 14 inside of a CD, so I apologize in advance, but there was
- 15 a CD that was produced to us with this production number
- 16 SN10765. It's since been labeled PX-104 and it was
- 17 represented to us that this was a set of recordings of
- 18 some of the work that you did on the cadaver. I'll simply
- 19 have to make that representation to you because I obviously
- 20 can't show it to you unless we put it up on the screen.
- 21 MR. BOBROW: I would move this CD into evidence.
- 22 MR. MARSDEN: Your Honor, we'll object to its
- 23 being moved into evidence. If he intends to use it for
- 24 impeachment, that is one matter, but it's not appropriate
- 25 to move into evidence with our expert witness.

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1 THE COURT: Well, I'm not sure about that, but
 2 the problem is we don't generally -- this is, the exhibit
 3 is a test that the witness performed?
 4 MR. BOBROW: That's correct.
 5 THE COURT: I guess my problem is if this
 6 witness isn't the kind of witness who typically uses these
 7 products, I'm not sure what the relevance is or if the
 8 relevance is not waived by prejudice -- without knowing
 9 what this is, I'm not sure what why it should come in.
 10 Maybe we should have a sidebar.

11
 12 (Sidebar conference, out of the hearing of the
 13 jury, as follows.)

14 MR. BOBROW: This is a videotape that this
 15 witness took so that he could understand how the devices
 16 operate. And it records that. He was being assisted by
 17 somebody from Smith & Nephew at the time and so, given
 18 that, what I would like to be able to show just one clip
 19 that he used to show how he used the device and how he
 20 operated it and how the device functioned inside of the
 21 tissue.

22 Now, Dr. Choti was allowed on his direct
 23 examination to show tapes of the ones that he actually
 24 prepared. He is not an arthroscopic surgeon either, but
 25 what it does, it gives the jury a good sense of what the

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1 shoulder space is like and how the devices fit inside the
 2 shoulder.

3 THE COURT: Well, is this for -- I can't
 4 remember whether those were introduced. What is the
 5 relevance? Illuminate me here.

6 MR. BOBROW: What I want to try to show, the
 7 devices can be used and are designed in a way such that
 8 the return electrode doesn't need to be contacting the
 9 tissue while it's inside the patient's body. So here I
 10 want to show one clip where there are times when it's
 11 not in contact and essentially he was able to observe
 12 there are times when it was not in contact.

13 THE COURT: Tell me something. All the clips
 14 we've seen for purposes of infringement, were those actual
 15 surgeries or were those just people playing with them?

16 MR. BOBROW: Well, we have seen two types. We
 17 saw Dr. Choti, and that was inside of a cadaver. And then
 18 we've also seen some that were actually on live patients
 19 where there was blood present. So that was either on an
 20 animal or that was on a human being, but something where
 21 blood was flowing. There is no blood flowing here.

22 THE COURT: Let's hear about Dr. Choti's clips,
 23 because I can't remember which ones those are.

24 MR. MARSDEN: Your Honor, I was trying to get
 25 assistance on that myself. I'm not sure that I was in the

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1 courtroom when it was played, but apparently he did play
 2 some tapes of tests.

3 MS. MacFERRIN: He did not play any on direct,
 4 but on cross played the tape of the experiment.

5 MR. BOBROW: There was a Control RF experiment
 6 from Dr. Choti that your Honor allowed to be played on
 7 cross-examination to show how the Control RF device
 8 interfaced with the tissue, its relationship to the
 9 tissue was, and this is an identical situation except
 10 it's this witness and a different product.

11 THE COURT: And whose witness was Dr. Choti?
 12 I can't even remember.

13 MR. BOBROW: Dr. Choti was an expert for Smith &
 14 Nephew.

15 MR. MARSDEN: So apparently on cross there,
 16 they used one of his clips.

17 MR. BOBROW: That's right.

18 MR. MARSDEN: I don't know that that makes it
 19 right to do it again. I don't think it's particularly
 20 helpful, particularly if you have a selected clip. There
 21 is a lot of other clips.

22 MR. BOBROW: I apologize.

23 MR. MARSDEN: The jury has seen it in use or
 24 in sales videos, which is an important consideration for
 25 whether there is infringement. That's how we tell doctors

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1 how it should be used. That's how we tell salespeople to
 2 show doctors how it should be used. And that would be the
 3 relevance.

4 MR. BOBROW: If I may make one more comment...

5 Dr. Choti testified that, on his direct
 6 examination, the shoulder, the cadaver was actually very
 7 much akin to a living shoulder. In other words, that it
 8 hasn't been obliterated, that it hasn't been damaged, but
 9 it was very much like a regular human shoulder. So I'd
 10 like to show this to show indeed there are lots of spaces
 11 in the shoulder where there are lots of room and that a
 12 surgeon can manipulate the device in a way and a person
 13 can manipulate the person in a way such that the return
 14 doesn't contact.

15 MR. MARSDEN: Your Honor, if they wanted to
 16 do that, they could have had their expert do the experiment.

17 MR. BOBROW: No. We tried to have our expert
 18 look at these tapes and testify about that, but that was
 19 precluded.

20 MR. JOHNSTON: Your Honor?

21 THE COURT: It's precluded by whom?

22 MR. BOBROW: By your Honor. Yes, you ruled
 23 that since it wasn't in his expert report, he couldn't
 24 talk about that. So I'd like to have the person who
 25 actually generated this tape talk about it.

1 THE COURT: So you were saying Dr. Choti
2 couldn't talk about it?
3 MR. BOBROW: No, Dr. Goldberg. I'm sorry.
4 There are too many witnesses. Dr. Goldberg couldn't talk
5 about it. Couldn't talk about Dr. Choti's or Dr. Taylor's.
6 I'd like to ask Dr. Taylor about Dr. Taylor's video.

7 MR. JOHNSTON: Tom Johnston.
8 There is one other difference. They did not
9 do the test on the same shoulder because they're done
10 weeks apart, and I believe that Dr. Taylor's shoulder had
11 been scoped several times. Not as representative as Dr.
12 Choti's.

13 THE COURT: Was there any objection to Dr.
14 Choti's being used? Like there is now?

15 MR. BOBROW: No, there wasn't. It was
16 admitted into evidence without objection.

17 THE COURT: Well, I guess if I didn't rule on
18 this issue before, my reaction to this issue is that this
19 is an engineer playing with a dead body and it can't
20 possibly be used for purposes of infringement. I mean I
21 just think it's not appropriate. So the objection is
22 sustained.

23 MR. MARSDEN: Thank you, your Honor.

24 MR. BOBROW: Thank you, your Honor.
25 (End of sidebar conference.)

1 ---
2 MR. BOBROW: Ladies and gentlemen, I apologize
3 for the delay.

4 Why don't we move on to another exhibit?
5 May I approach, your Honor?

6 THE COURT: Yes, you may.

7 BY MR. BOBROW:

8 Q. Let me show you PX-324. PX-324 is already in
9 evidence, sir.

10 A. Okay.

11 Q. And PX-324 is called Competitive Selling, ArthroCare
12 with the name Rob Griffin.

13 Do you see that?

14 A. Yes.
15 ---
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1
2 Q. And you have seen this document before, haven't you?
3 A. I think I have seen parts of it.
4 Q. Okay. And if you turn to Page ORA65076, you can see
5 that this page talks about S&N ablation probes.

6 Do you see that?

7 A. Yes.

8 Q. One of those probes is the Saphyre bipolar ablation
9 probe; correct?

10 A. Yes.

11 Q. And S&N stands for Smith & Nephew; right?

12 A. Yes.

13 Q. And if you go a little bit further into the document,
14 at ORA65090, there is a document there called Managing
15 Surgeon Expectations.

16 Do you see that?

17 A. Yes.

18 Q. And this is talking about Saphyre suction probes;
19 right?

20 A. Just let me read it for a second.

21 Yes.

22 Q. And the Saphyre suction probes are designed so that,
23 for example, they will clear bubbles that are generated
24 when the devices are used in these arthroscopic surgeries;
25 correct?

1 A. Bubbles and other debris, yes.

2 Q. But including bubbles; right?

3 A. Including bubbles, yes.

4 Q. The second bullet point here says, quote, During
5 use keep the electrode level with the target tissue for
6 optimal evacuation of bubbles.

7 Do you see that?

8 A. Yes.

9 Q. And when it says level there, that Saphyre probe
10 actually has a flat active electrode face; correct?

11 A. Yes, it does.

12 Q. And it says -- what I am pointing to here with my
13 finger to PX-544, this is the active electrode tip; right?

14 A. Yes, it is.

15 Q. Way down here?

16 A. Yes.

17 Q. And that would then be presented to the tissue such
18 as this; correct? It says to hold it flat; right?

19 A. That's what I would infer, yes.

20 Q. And you have inspected these probes before; correct?

21 A. Oh, yes.

22 Q. And when you look at these probes, you can see that
23 the return electrode is actually recessed somewhat from
24 the plane of the face of the active electrode; right?

25 A. Slightly, yes.

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- 1 Q. So if I were to hold this active electrode on that
2 desk, that glass-top desk right there, and I held that
3 active electrode flat, parallel to the desk, the return
4 electrode wouldn't touch it, would it?
5 A. No, it wouldn't.
6 Q. Because it's recessed somewhat; correct?
7 A. I am presuming you are holding the probe, the shaft,
8 parallel.
9 Q. That's right.
10 A. Okay.
11 Q. Now, if you take a look, also, at Page ORA65095,
12 again, it's talking about managing surgeon expectations.
13 And what is depicted there is the tip of one of these
14 Saphyre probes; correct?
15 A. Yes.
16 Q. And you can see there that the very tip of the probe
17 bends down at sort of a right angle so that the -- where
18 those little lightning bolts and bubbles are, that is the
19 active electrode face; right?
20 A. Yes.
21 Q. And here, the active electrode face is shown being
22 parallel to the tip; right? That is what is being
23 depicted there?
24 A. Yes.
25 Q. And the return electrode, as we are looking at this

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- 1 figure, would be off and to the left; correct?
2 A. Yes.
3 Q. That is where the return electrodes would be?
4 A. Yes.
5 Q. And you can see here, blown up somewhat, that,
6 indeed, the return electrode in that portion of the shaft
7 is recessed from the tissue that the active electrode
8 faces, touching there; right?
9 A. In this cross-section, that's correct, yes.
10 Q. And there is an arrow pointing to the very tip of
11 the device, and the very tip of the device has those two
12 points, do you see them, on the left and the right?
13 A. Yes.
14 Q. And that's intended to depict that the active
15 electrode tip is in contact with the tissue, right, at
16 those tips?
17 A. Well, if you actually take a look at the Saphyre
18 active electrode, it's got four little points that stick
19 up. I think that's what that is depicting.
20 Q. So those two little sharp points on either side,
21 those are in contact there with the tissue; right?
22 A. Yes.
23 Q. And then near the face of the active electrode, or
24 it looks like it's little lightning bolts and some bubbles;
25 right?

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- 1 A. That's correct.
2 Q. In describing that it says, quote, Tight seal between
3 probe and tissue causes steam bubbles to form under
4 electrode which allows an arc to be created and ablation
5 to occur.
6 Do you see that?
7 A. Yes.
8 Q. And do you understand that that is, indeed, how the
9 Saphyre bipolar ablation probes work when they are in
10 operation?
11 A. I think the answer to your question is yes. They
12 sort of omit the step that you got to apply energy to it
13 to get to the arc and so forth. But I think the idea is
14 it forms a steam layer and eventually an arc is generated
15 and that ablates the tissue.
16 Q. Now, all of these devices that have been accused of
17 infringement, all of them require an electrically
18 conductive fluid to work; right?
19 A. Yes.
20 Q. And you did some tests, didn't you, when you were
21 working on and looking at these various devices; right?
22 A. Are you talking about the experiments with the
23 cadaver shoulder?
24 Q. Those and others; right?
25 A. Those are the best tests that I did, yes.

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- 1 Q. You also did some tests in distilled water, didn't
2 you?
3 A. Yes.
4 Q. And distilled water is not an electrically conductive
5 fluid, is it?
6 A. No.
7 Q. And you tested the Saphyre device, for example, in
8 distilled water, didn't you?
9 A. Yes.
10 Q. And it didn't work, did it?
11 A. No, it did not.
12 Q. And you tried it in, you tried to use the Control
13 RF --
14 A. Can I make just one comment?
15 Even though I know I said distilled water, it
16 could also have been deionized distilled water. That is
17 a little different than regular distilled water.
18 Nonetheless, it didn't work.
19 Q. And both of those, deionized or distilled, they are
20 both electrically nonconductive, they would be categorized
21 as such in this field; correct?
22 A. Yes.
23 Q. And when you put the Control RF in this
24 nonconductive fluid, it also didn't work, did it?
25 A. That's correct.

1 Q. So these devices, to work, require the presence of
 2 an electrically conductive fluid; right?
 3 A. Yes.
 4 Q. And all of these devices work by creating a current
 5 flow path between the active and the return through an
 6 electrically conductive fluid; right?
 7 A. And the tissue.
 8 Q. And when these devices are used by doctors, they are
 9 always used with an electrically conductive fluid; correct?
 10 A. Yes. The instructions for use specifically say that.
 11 Q. And in terms of arthroscopic procedures, those are
 12 the procedures these devices are designed for; right?
 13 A. Correct.
 14 Q. When those procedures are done, there is always
 15 electrically conductive fluid inside the joint space;
 16 correct?
 17 A. Yes.
 18 Q. And these devices are used in that electrically
 19 conductive fluid; right?
 20 A. Yes.
 21 Q. And they need that electrically conductive fluid in
 22 order to work and treat the tissue inside of those joint
 23 spaces; right?
 24 A. Yes.
 25 Q. And if you didn't have the fluid in there, the

1 electrically conductive fluid in there, that was
 2 administered to the knee or the shoulder, the devices
 3 wouldn't work, would they?
 4 A. Well, in the case of the RF portion it does,
 5 because you are talking about whether or not other
 6 devices --
 7 Q. Right?
 8 A. In the case of other devices, when activated, it
 9 would work, you certainly would have electrically
 10 conductive fluid in the joint space, since arthroscopy is
 11 always used with electrically conductive fluid, you would
 12 need that.
 13 Q. Even in the case of the ElectroBlade, you heard Ms.
 14 Drucker testify yesterday that the most popular mode of
 15 this operation of this ElectroBlade device is the
 16 simultaneous cutting and coag mode; right?
 17 A. That's correct.
 18 Q. By simultaneous cutting and coag, that means that
 19 the RF is on; correct?
 20 A. Yes.
 21 Are we finished with this so I can put it away?
 22 Q. Yes, Dr. Taylor.
 23 Dr. Taylor, I believe that I finished my line
 24 of questions and I appreciate your time. Thank you.
 25 THE WITNESS: Thank you.

1 THE COURT: Redirect.
 2 REDIRECT EXAMINATION
 3 BY MR. MARSDEN:
 4 Q. Good afternoon, Dr. Taylor.
 5 A. Good afternoon.
 6 Q. Just a few questions. First of all, was there
 7 anything in Mr. Bobrow's questioning of you here on cross
 8 that has caused you to change or reconsider any of the
 9 opinions that you offered during your direct testimony?
 10 A. No.
 11 Q. Just to follow up on one of the last points that Mr.
 12 Bobrow made about holding the device level, I guess we
 13 could take any of these devices and hold them level, I
 14 think you talked about it in reference, for example, to
 15 a desktop.
 16 Do you remember that question?
 17 A. Yes.
 18 Q. Is there any part of the inside of a joint that
 19 looks like the top of a desktop?
 20 A. Not to my knowledge.
 21 Q. Does it make sense to talk about keeping something
 22 parallel in the context of a joint?
 23 A. No.
 24 Q. I wanted to return to a couple of other points that
 25 Mr. Bobrow raised just briefly. First, he talked a little

1 bit about the Doss patent.
 2 Do you recall that?
 3 A. Yes.
 4 Q. In particular, he was asking you about the two
 5 electrodes in the Doss patent?
 6 A. Right.
 7 Q. Do you remember that?
 8 A. Yes.
 9 Q. I think the point of his question was, he was trying
 10 to suggest to you there may not be a return electrode in
 11 the Doss patent.
 12 Did you understand that?
 13 A. I think that was the line of reasoning, yes.
 14 Q. Did the Court give us a definition of return
 15 electrode?
 16 A. Yes.
 17 MR. MARSDEN: Can we pull up, please, 675, *
 18 Gary? If you could go to Paragraph 9, please... And blow
 19 up Paragraph 9, please.
 20 BY MR. MARSDEN:
 21 Q. Did you use the Court's definition of return electrode
 22 in determining whether or not the Doss reference had a
 23 return electrode?
 24 A. Yes.
 25 Q. And what is the critical element of the Court's

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1 definition of whether or not something constitutes a return
 2 electrode?
 3 A. The critical element is an electrode having a larger
 4 area of contact than an active electrode, thus affording a
 5 lower current density.
 6 Q. And when you reviewed the Doss patent, did you find
 7 such an electrode?
 8 A. Yes. The outer electrode is -- just look at the
 9 geometry --
 10 MR. MARSDEN: Can we pull up DDTX-458 again,
 11 Gary?
 12 BY MR. MARSDEN:
 13 Q. That is the Doss reference. Does that help answer
 14 the question?
 15 A. Yes. In this geometry, the structure that is in
 16 yellow, cross-hatched yellow is the return electrode. And
 17 if you look at the sort of bottom-end view here, the
 18 active electrode is in red. The return electrode is there.
 19 And just on the basis of plane geometry if you assume both
 20 electrodes have the same thickness, the outer electrode
 21 will have more surface area.
 22 Q. And does that outer electrode meet the Court's
 23 definition of a return electrode?
 24 A. I believe it does.
 25 Q. Turning to another subject, Mr. Bobrow asked you

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1 some questions about a correction you made during your
 2 deposition.
 3 Do you recall that?
 4 A. Yes.
 5 Q. When you realized you had made a mistake at your
 6 deposition, what did you think was the right thing to do?
 7 A. Well, based on the instructions I got -- my
 8 understanding was I can correct grammatical errors, I
 9 could correct typos. But I couldn't correct my deposition
 10 until I got to trial.
 11 Q. There was another question that dealt with a lunch
 12 break and realizing over the lunch break that you had
 13 made an error in some of your earlier testimony.
 14 Do you recall that?
 15 A. Yes.
 16 Q. When you realized that and you went into the
 17 deposition after the lunch break, what did you think was
 18 the right thing to do?
 19 A. Basically, we told Mr. Bobrow about the error.
 20 Q. Did you answer all of Mr. Bobrow's questions about
 21 the error?
 22 A. Yes, I did.
 23 Q. Did you answer them here again in court today?
 24 A. Yes.
 25 Q. Is there anything about that error or changing that

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1 error or correcting that error that changes any of your
 2 opinions that you have offered here today?
 3 A. No.
 4 Q. Moving to another topic, Mr. Bobrow spent some time
 5 with you in connection with the Slager reference, talking
 6 about the fact that this was done in a dish with tissue
 7 that had been taken from an aorta.
 8 Do you recall that?
 9 A. Yes.
 10 Q. Were you here when Mr. Eggers testified -- I guess
 11 it was at the end of last week -- about how he reduced his
 12 invention to practice?
 13 A. Yes, I was.
 14 Q. How did he do it?
 15 A. He did it in, I don't know whether he used a chicken,
 16 but he did it in a Petri dish or dish. I don't think he
 17 said Petri, but in a dish.
 18 Q. That was the same invention that you were talking
 19 about five minutes ago?
 20 A. Same methodology, basically using tissue in vitro.
 21 Q. The last topic, Dr. Taylor. You were asked early on
 22 in your cross-examination a lot of questions about the
 23 Roos reference and electrically conductive fluid.
 24 Do you recall that?
 25 A. Yes.

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1 Q. You were asked a bunch of questions about another
 2 patent to Mr. Roos, the '667 patent.
 3 Do you recall that?
 4 A. Yes.
 5 Q. You knew about the Roos '667 patent, didn't you?
 6 A. Yes, I did.
 7 Q. You considered it before you rendered your opinions
 8 here today?
 9 A. Yes, I did.
 10 Q. Was there anything in the '667 patent that caused you
 11 to reconsider whether or not the teachings of the Roos '198
 12 patent anticipate the '536 patent?
 13 A. No, there isn't.
 14 Q. Is there anything that Mr. Bobrow brought out during
 15 your cross-examination that has caused you to reconsider
 16 that?
 17 A. No.
 18 Q. Has the Court defined the term electrically conductive
 19 fluid for us?
 20 A. Yes.
 21 MR. MARSDEN: Can we pull up DX-675?
 22 BY MR. MARSDEN:
 23 Q. This time look at Paragraph 5. The Court has
 24 defined electrically conductive fluid to mean any fluid
 25 that facilitates the passage of electrical current;

1 correct?
 2 A. That's correct.
 3 Q. And did you use that definition in rendering your
 4 opinions here today?
 5 A. Yes.
 6 Q. Did you find electrically conductive fluid as defined
 7 by the Court in the Roos '198 patent?
 8 A. Yes.
 9 MR. MARSDEN: Can we call up DDTX-444 again,
 10 please?
 11 BY MR. MARSDEN:
 12 Q. I think Mr. Bobrow asked you, in fact, about Claim 1
 13 of the '198 patent. Where do you find a fluid that
 14 facilitates electrical current in the '198, Claim 1?
 15 A. If you look in the language of Claim 1, the last
 16 couple of lines, with liquid to provide electrical
 17 conductance between said electrodes.
 18 Q. Do you believe that is consistent with the Court's
 19 construction?
 20 A. I believe it is.
 21 Q. We also saw this during Mr. Sparks' demonstration of
 22 the equipment earlier today. You understood that this was
 23 the electrically conductive fluid that was used in the
 24 typical procedure?
 25 A. Yes, I presume that's normal saline or lactated

1 Ringer's.
 2 MR. MARSDEN: May I approach, your Honor?
 3 THE COURT: Yes.
 4 BY MR. MARSDEN:
 5 Q. Let me hand that up. I would ask you to look at the
 6 labeling on the top. Can you tell me how it describes
 7 that fluid?
 8 A. Well, it says .9 percent sodium chloride irrigation.
 9 Q. It says irrigation?
 10 A. Irrigation.
 11 Q. So it's calling that an irrigation fluid?
 12 A. That's correct.
 13 Q. Does it use the term electrically conducting fluid?
 14 A. I don't see that anywhere on this label.
 15 Q. Does the fact that it calls it irrigation fluid make
 16 it not electrically conductive fluid?
 17 A. No.
 18 Q. That fluid, is that electrically conductive fluid?
 19 A. Yes.
 20 MR. MARSDEN: No further questions.
 21 THE COURT: All right. You may step down.
 22 Thank you very much.
 23 THE WITNESS: Thank you, ma'am.
 24 (Witness excused)
 25

1 THE COURT: Ladies and gentlemen, we will
 2 recess for the evening. You will be getting the case
 3 tomorrow at some point during the day. I will remind
 4 you that during the evening recess you are not to talk
 5 among yourselves or with anyone else, nor are you to
 6 listen to anything touching on the case. Do not perform
 7 any independent investigation.
 8 Have a safe trip home, a pleasant evening.
 9 And we will see you tomorrow morning at 9:30.
 10 (At this point the jury then left the
 11 courtroom, and the following occurred without the presence
 12 of the jury.)
 13 THE COURT: Leave E-mail addresses with John
 14 here so that we can E-mail you our verdict form and final
 15 proposed jury instructions.
 16 We are going to have to meet tomorrow morning.
 17 I have an 8:30 hearing, but it shouldn't take more than a
 18 few minutes. Why don't you get here about 8:45, so we can
 19 be sure to be ready to go at 9:30.
 20 Thank you, counsel.
 21 (Court recessed at 3:00 p.m., to reconvene on
 22 Friday, May 9, 2003, at 8:45 a.m.)
 23 ---
 24
 25

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